Lincoln Co. v. Stewart-Warner Corp. 

# INDEX TO SUBJECT MATTER.

Porter I at 1 at 2	Page
Respondent's brief (in opposition to our Petition for	
Writ of Certiorari) feigns non-existent dispute of	
facts	1
"Headed" grease-cup or so-called "nipple" (the only	
defendant's accused device in the case at bar) was	
conceded by the Circuit Court of Appeals in the	
case at bar to be an old "headed" grease-cup or	
"nipple"	4
The Rogers v. Alemite case (298 U. S. 415)	-
Respondent's beclouding strategy is the same as that	. 6
unsuccessfully used by it in Adams v. Bassick	
(285 U. S. 531) and Rogers v. Alemite (298 U. S.	_
415) and consists of the remoted at the second	
415) and consists of the repeated cry that "this	
Court is asked to decide questions de novo''	6 -
Respondent urged upon the Circuit Court of Appeals	
in the case at bar that this Court's decision in	0
the case of Rogers v. Alemite (298 U. S. 415) was	
erroneous, illogical and difficult to understand.	7
The conflict between the Circuit Court of Appeals for	
the Eighth Circuit in the Jiffy case, and the Cir-	
cuit Court of Appeals for the Seventh Court	
the case at bar	11
Respondent's own counsel urged upon the Cir-	
cuit Court of Appeals in the case at bar the	
necessity for a conflict with the Eighth Cir-	
cuit in the Jiffy, case, if the decision is to be	
for respondent, and also urged error in the	
Eighth Circuit decision	11
Conclusion	13
,,	Market Comments

# Supreme Court of the United States.

No. 608. October Term, 1937.

# LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner.

V8.

# STEWART-WARNER CORPORATION, Plaintiff-Respondent.

# PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent's brief (in opposition to our Petition for Writ of Certiorari) feigns non-existent dispute of facts.

We would not reply to respondent's brief except for the fact that respondent's brief seeks to avoid a review of this case by this Court, by an attempt to becloud the questions presented by our petition, partly by the discussion of generalities on non-issues (while failing to traverse any of the questions presented by the petition), and partly by attempting to mislead this Court to conclude that the questions submitted by the petition involve issues of fact. But that is not the case, since every alleged issue of fact feigned by respondent, involves nothing more than respondent's ingenious selection of terminology or phraseology differing from that used by petitioner to set forth the facts. Re-

spondent attempts to make it appear as though the facts were in dispute, whereas respondent has merely attempted to becloud the matter by differences in phraseology or nomenclature.

For each of the Argument Points II, III and IV of our Brief heretofore filed, we have assumed (for the purposes of argument) that Butler did invent a new and patentable coupler adapted for coupling a pump to a "headed" greasecup (or to a "nipple"), and that Butler's coupler worked differently from, and worked better than, the prior-art couplers.

There is no dispute as to the fact that lubricant-dispensing pumps or "grease-guns" and couplers and grease-cups had long been "combined" (or used conjointly). That is the precise "combination" which this Court considered in Rogers v. Alemite, 298 U. S. 415.

Nor is there any dispute that "headed" type greasecups were old and had been "combined" (that is, used with) head-engaging type couplers and grease-guns, as in the Seng patent for instance (R. pp. 541 to 544).

Respondent's only feigned dispute of facts is that

while we have assumed for our Argument Points II, III and IV that Butler's head-engaging coupler was new, different and inventive, and that it coupled onto a "headed" grease-cup (or "nipple") in a way different from that in which the prior-art head-engaging couplers coupled onto "headed" grease-cups (or "nipples");

respondent has devised the ingenious scheme of calling the old "combination" (or conjoint use) of a pump, coupler and grease-cup, a "system", and then arguing that Butler was the first one to devise a "system" (of pump, coupler and grease-cup) in which the coupler worked thus-and-so.

The term "system" is just a convenient euphemism resorted to by respondent throughout its vast campaign of patent litigation under the patent herc in suit, as well as under its many other so-called "combination" patents

(each of which claims a so-called "combination" of pump, coupler and grease-cup, in which the novelty, if any, is solely in the coupler)

an old combination of pump, coupler and grease-cup each and every time an allegedly new grease-delivery nozzle or coupler is invented, and to disguise the further simple fact that for each and every one of the many alleged coupler inventions of respondent's huge pool of so-called "combination" patents, it is in reality asserting a monopoly of old grease-cups and old pumps usable with the assertedly improved coupler of each patent.

This is the catch phrase which respondent succeeded in having the trial court adopt in its opinion and findings of fact and conclusions of law.

As stated, however, for the purposes of our Argument Points II, III and IV, we have assumed (without conceding)

<sup>\*</sup>Contrary to respondent's repeated representations to the Court of Appeals for the Seventh Circuit in the case at bar, and contrary to its representations to this Court to the effect that the District Court prepared its own findings and conclusions, the trial court's findings and conclusions were practically a verbatim copy of the findings of fact and conclusions of law drafted by respondent's counsel, Mr. Williams, and submitted by him to the trial court prior to the trial court's opinion and findings and conclusions.

that Butler's coupler grips better and seals better and differently from the prior-art head-engaging couplers.

All that respondent's feigned dispute of facts resolves itself into is respondent's argument that as Butler's coupler is new and different, therefore the "system" (of pump, coupler and grease-cup) is also new and different. This is just another way of saying that if Butler's coupler is new, then the "combination" (or use) therewith of the other customary devices (such as an old "headed" grease-cup or an old pump) must also be new. Obviously, however, novelty in such "combination" or "system" is present only in the sense that the old grease pump and old grease-cup were never coupled by a Butler coupler until Butler made his alleged coupler invention. In other words, respondent's entire feigned dispute of facts amounts to nothing more than respondent's attempt to conceal, by an excess of verbiage, that while Butler's asserted invention (if any) is in the internal construction or mechanism of a coupler, respondent nevertheless contends for a monopoly of old headed greasecups usable therewith. This is precisely the question around which each of Argument Points II, III and IV centers, and by no amount of argument can respondent convert this into a question of fact because it represents a pure question of law.

"Headed" grease-cup or so-called "nipple" (the only defendant's accused device in the case at bar) was conceded by the Circuit Court of Appeals in the case at bar to be an old headed "nipple".

The Circuit Court of Appeals in the case at bar has clearly pointed out in its opinion that the "headed" grease-cup or so-called "nipple" is in and of itself old and unpatentable:—

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old." (Emphasis supplied.)

(91 Fed 2d 763; R. p. 637)

With this finding by the Circuit Court of Appeals in the case at bar, there is no possible dispute of facts on our Argument Points II, III and IV.

For Argument Points II, III and IV of our brief, we have assumed (without conceding) that Butler's presumably new coupler coupled the old pump and old "headed" grease-cup (or "nipple") differently and better than they had ever before been coupled by the prior-art couplers.

The question of law still remains the same, however, namely, whether one who invents a presumably better coupler, that is, a coupler which will couple the old grease-pump and old grease-cup better than they had ever been coupled before, may also have a monopoly on the old grease-cup and old grease-pump which are to be so coupled by (or used with) the presumably new coupler.

In Argument Points II, III and IV, we have successively pointed out each of three different legal reasons why the inventor of a presumably different and better (and patentable) coupler which may be used for coupling an old grease-pump to an old grease-cup, better than they had ever been coupled before by the prior-art couplers, should not be permitted to have a monopoly of the old grease-pump or the old grease-cup which are so to be used with (and presumably better coupled by) the patentee's presumably better coupler.

#### Bogers v. Alemite, 298 U. S. 415

In our Argument Point II (which covers our certiorari ground No. 2) we have relied upon this Court's decision in Rogers v. Alemite where, as in the case at bar, Gullborg was presumed to have invented a different and better coupler (of the "bayonet" type) and then claimed the so-called ""combination" or "system" of old pump, new coupler and old grease-cup. In the Rogers v. Alemite case, respondent also urged upon this Court that not only was the compler new, but the entire "combination" or "system" was likewise new because the old pump and old grease-cup had never before been coupled by Gullborg's new, different and better coupler. This Court in that case assumed that Gullborg's coupler was new, different and better and did comple the old grease-pump and the old grease-cup in a way different from and better than they had ever been coupled before by the prior-art couplers. Nevertheless, this Court held that respondent was not entitled to a momopely of the old grease-cup and old grease-pump which was to be coupled by Gullborg's different and better. coupler.

This certainly involves no questions of fact in the case at bar, because we have assumed for purposes of Argument Point II (without conceding) that Butler's coupler is different from and better than the prior-art couplers and works differently, that is, it grips better and seals better than the prior-art couplers.

Respondent's beclouding strategy is the same as that unsuccessfully used by it in Adams v. Bassick (285 U. S. 531) and Rogers v. Alemite (298 U. S. 415) and consists of the repeated cry that "this court is asked to decide questione de novo."

<sup>• (</sup>in claims 1 to 6 and 8 & 10)

Respondent's attempt to avoid a review of this case by this Court involves the same beclouding strategy employed by it in opposing the petition for writ of certiorari before this Court in the case of Adams Grease Gun Corp. v. Bassick Mfg. Co. (No. 649, October Term 1931) where, as here, respondent's cry was that the questions presented by the petition required a de novo consideration by this Court of the underlying facts.

This Court granted the petition for writ of certiorari in the Adams v. Bassick case (285 U. S. 531) on precisely the same grounds which constitute our certiorari ground No. 4, which are covered by our Argument Point IV, although in the Bassick v. Adams case there was then no actual conflict with respect to the same patent. In that case, respondent after unsuccessfully opposing the petition for writ of certiorari, preferred to settle with the Adams Grease Gun Corporation the day before the case came up for hearing before this Court and caused the Adams Grease Gun Corporation to withdraw its appeal.

The same beclouding strategy through which respondent attempts to avoid a review of this case by this Court was also relied upon by it in its brief before this Court in Rogers v. Alemite (No. 31, October Term 1935) where, as here, it again sought to avoid a discussion of the real issues by contending (as it does in the case at bar) that

"this Court is asked to decide these questions de novo etc."

2) Page 9 of respondent's brief in Rogers v. Alemite No. 31 October Term 1935 (298 U. S. 415).

<sup>1)</sup> the respondent in that case and the respondent in the case at bar are the same, insofar as Bassick Mfg. Co. (more recently re-named as the Alemite Corporation) was and is a wholly ewned subsidiary of the Stewart-Warner Corporation.

Respondent urged upon the Circuit Court of Appeals in the case at bar that this Court's decision in the case of Rogers v. Alemite (298 U. S. 415) was erroneous, illogical and difficult to understand.

While respondent in the case at bar tries to distract this Court's attention from the real and vital conflict existing between the decision of the lower courts in the case at bar and the decision of this Court in the Rogers v. Alemite case (298 U. S. 415), respondent did not hesitate to urge upon the lower courts in the case at bar (as openly as the bounds of propriety might permit it to do so) that this Court's opinion in the Rogers v. Alemite case was erroneous.

Thus, on pages 63 and 64 of his brief in the Court of Appeals for the Seventh Circuit in the case at bar, respondent's counsel (Mr. Williams) said:—

"It was of course Mr. Kalish himself who bundled together the many cases of license by implication,—in other words, license by virtue of estoppels arising out of the patentee's conduct, and cases holding certain claims of certain patents to be invalid on the score of aggregation, and cases holding certain restrictive clauses of certain license contracts to be violative of the anti-trust laws. In a foot-note to his opinion, Mr. Justice Roberts cited this grist of distinctive and wholly unrelated cases in support of his negative answer to his question,

'whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element.' (Citation 298 U. S. at p. 425.)

"We have found it quite impossible to reconcile the long list of diverse cases cited by the Supreme Court, with any logical understanding of or answer to the question formulated by Mr. Justice Roberts, or with his answer to it." (Emphasis supplied.)

Again on page 65 of his brief, respondent's counsel (Mr. Williams) further said to the Circuit Court of Appeals (in the case at bar):—

"It would seem clear that the real ground of the decision was double patenting,"—the simple proposition that an inventor is not entitled to two separate patents upon one and the same invention. (Nevertheless, it was in this connection that Mr. Kalish's grist of unclassified and disparate cases were listed, without comment or analysis, in an accompanying foot-note.)"

"The only difficulty in understanding and applying the decision of the Supreme Court in the Rogers case results from the comment which the Court made relative to the Berliner patent No. 534,543, which was involved in the Leeds & Catlin case. The Court said that

'There the patent was a pioneer patent, and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination.'" (Emphasis supplied.)

It was responsive to this type of argument that the trial court in the case at bar characterized this Court's opinion in the Rogers v. Alemite case as "startling" and that the Circuit Court of Appeals in the case at bar characterized

<sup>1) 15</sup> F. Supp. 571, 577, first line of last paragraph in left column.

this Court's ruling in the Rogers v. Alemite case as a "novel proposition".2)

Respondent further urged upon the Court of Appeals for the Seventh Circuit in the case at bar (on pages 66 and 67) of its brief:—

"We believe that these matters deserve the careful attention of this Court because, if the decision of the Supreme Court in the Rogers case means what counsel for the appellant would have it mean, then certainly there has been a revolution in all of the patent law as understood and applied by this and every other Federal Court throughout the entire history of the patent system.

"An examination of our compilation of the opinions of this Court will convince your Honors that if the Supreme Court really intended on May 18, 1936 to overturn all of the law of the Leeds & Catlin cases, it would be highly desirable in the interests of everyone concerned, to give the Supreme Court an opportunity to make that intention far more clear and definite than it has been made in and by its decision in the Hollingshead and Rogers cases, 298 U. S. 415 (80 L. Ed. 782)." (Emphasis supplied.)

Thus, while respondent seeks to distract this Court's attention from the clear-cut and unmistakable conflict with this Court's own opinion in the Rogers v. Alemite case, respondent clearly urged upon the Circuit Court of Appeals for the Seventh Circuit in the case at bar

that this Court's decision in the Rogers v. Alemite case was erroneous and that such error was induced

<sup>2) 91</sup> Fed (2d) 757, 761, next to the last paragraph in left column.

by allegedly unrelated authorities relied upon by us and cited by Mr. Justice Roberts in the last footnote forming part of this Court's opinion; and

should not follow this Court's ruling in the Rogers v. Alemite case but that instead this Court be merely given another opportunity to make itself clear and definite (before its decision in the Hollingshead and Rogers cases is to be followed).

The Conflict between the Circuit Court of Appeals for the Eighth Circuit in the Jiffy Case and the Circuit Court of Appeals in the Seventh Circuit in the case at bar.

In our brief we have quoted in the Appendix II, pages 5a to 8a inclusive, statements of respondent's counsel, Mr. Williams, to the Circuit Court of Appeals in the case at bar, to the effect that in order for Circuit Court of Appeals to decide this case in favor of respondent, it was necessary for the Circuit Court of Appeals for the Seventh Circuit "to reach a different conclusion" from that reached by the Circuit Court of Appeals for the Eighth Circuit with respect to the same patent.

Respondent's brief does not deny what respondent clearly admitted to the Circuit Court of Appeals in the case at bar, namely, that a decision for respondent must inevitably conflict with the decision of the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case. It does so conflict. To secure this conflict, respondent throughout its brief to the Circuit Court of Appeals for the Seventh Circuit argued the alleged error of the Eighth Circuit in the Jiffy case:

"the decision of the Eighth Circuit Court of Appeals was based upon such an untenable and impossible un-

derstanding of the physical construction of the Butler device" 2)

"Judge Lindley gave ample reasons, although not all of the reasons, which might have been given for disregarding the dictum as well as irrelevant holdings of the Eighth Circuit Court of Appeals in the Jiffy case" 3)

"the Eighth Circuit Court of Appeals adopted a fantastic contention advanced by the Jiffy Company's expert to the effect that the spring fingers must for some unknown reason extend the full length of the tubular extension 42"4)

"the Eighth Circuit Court of Appeals reached its conclusions as a result of an erroneous and untenable misconception of the structure and mode of operation of the device illustrated and described in the Butler patent in suit" 5)

A reading of the excerpts from respondent's briefs addressed to the Court of Appeals for the Eighth Circuit in the Jiffy case, which we have quoted on pages 1a to 4a of Appendix I annexed to our Brief heretofore filed in this Court, clearly shows that respondent not only placed its own "Alemite Hydraulic" coupler in issue in the Jiffy case to show "commercial success", but also in the distinct (though unsuccessful) effort to get the courts in the Jiffy case to give the coupler part of the Butler claim-language.

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<sup>2)</sup> Page 8 of respondent's brief in the Circuit Court of Appeals for the Seventh Circuit in the case at bar.

<sup>3)</sup> Respondent's brief, page 8, in the Circuit Court of Appeals for the Seventh Circuit in the case at bar.

<sup>4)</sup> Respondent's brief, page 23 in the Seventh Circuit Court of Appeals.

<sup>5)</sup> Respondent's brief, page 25, in the Seventh Circuit Court of Appeals.

a broad enough interpretation to cover the Jiffy coupler which respondent urged was substantially identical with respondent's own "Alemite Hydraulic" coupler.

These facts, plus the fact that the coupler part of the claim-language of Butler claims 1 and 2 are indistinguishable, as illustrated on pages 13 and 14 of our Brief heretofore filed, can leave no doubt that the decision of the Circuit Court of Appeals for the Seventh Circuit in the case at bar is definitely in conflict with the decision of the Court of Appeals for the Eighth Circuit in the Jiffy case, with respect to the scope of the Butler patent.

#### CONCLUSION.

In conclusion, we respectfully submit that not only is there present here a distinct and definite conflict between the Court of Appeals for the Eighth Circuit and the Court of Appeals for the Seventh Circuit, with respect to the scope of the same patent here in suit (which conflict was admitted by respondent's counsel before the Court of Appeals for the Seventh Circuit\*), but there is also present here a definite and unmistakable failure on the part of lower courts to follow a clearly controlling decision of this Court (Rogers v. Alemite, 298 U. S. 415).

It is earnestly urged that the Petition for Writ of Certiorari be granted.

Respectfully submitted,

LEONARD L. KALISH,
DELOS G. HAYNES,
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Counsel for Petitioner.

\*See pages 5a to 8a of Appendix II annexed to our Brief heretofore filed on November 29, 1937.

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# Supreme Court of the United States

No. 608.

October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

Brief for Petitioner.

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PAGE

# INDEX OF SUBJECT MATTER.

	Page
Opinions of the Courts Below	2
Jurisdiction	9
Statement5	to 43
Respondent Was Recently Before This Court on the	10 10
Same Question	5
Lubricating Equipment	5 to 9
Grease-cups or fittings or nipples	5
Pumps or compressors or grease-guns	6
Couplers or nozzles	Stop
The Charge of Infringement	to 1.1
This suit was originally based on petitioner's	10 14
coupler device alone, and not upon peti-	
tioner's now-accused grease-cup	9
Infringement charge not on Petitioner's Couplers	10
Dimensions—Interchangeability	10
Butler Patent in Suit and Prior Art	0.42
Chart showing headed nipples in prior art Facing	~ 16
The so-called "combination" of grease-cup, pump	5 10
and coupler16 t	0.17
Butler claim 2 analyzed and quoted	19
Fundamental question of law in the case at bar.	21
The confusing dual-use of the word "combina-	
tion"	. 09
The essence of respondent's position. 2	0 04
Butler's alleged improvement in the internal con-	)-44
struction or mechanism of the coupler24 to	. 07
Chart showing Butler in relation to prior art, and	) 41
devices in Jiffy suit and in suit at barFacing	00
The coupler-parts of Butler claims 1 and 2, in	20
parallel columns	20
20 10	OU

INDEX OF SUBJECT MATTER—Continued.
Page
The factual situation is exactly parallel and the
legal situation is precisely the same in the
case at bar as in Rogers v. Alemite33 to 39
Stewart-Warner v. Jiffy
Specification of Errors
Summary of Argument
<b>Statutes</b>
Argument of Point I
Petitioner's old and unpatented grease-cup cannot
possibly constitute contributory infringement
as charged, because respondent's own com-
mercial "Alemite-Hydraulic" coupler (in
conjoint use with which petitioner's old
grease-cup is charged contributorily to in-
fringe) is not in fact the Butler coupler be-
cause not "according to the drawing or speci-
fications on which the claim in suit read" as
expressly held by the Circuit Court of Ap-
peals for the Eighth Circuit in respondent's
earlier suit against Jiffy Lubricator Co. (81
Fed 2d 786, 788;—with which the decision
of the Court of Appeals in the case at bar is
therefore in direct conflict.
Chart of adjudicationsFacing 52
Argument of Point II
A patentee may not monopolize what he did not
contribute. Specifically, a patentee may not
re-monopolize en ald etyle grosse en en the

#### INDEX OF SUBJECT MATTER-Continued.

Page

.78 to 83

basis of an asserted improvement of a hose-coupler usable therewith (Rogers v. Alemite, 298 U. S. 415, 425).

The absolute parallelism between the facts of the case at bar and the facts involved in Rogers v. Alemite.

### Argument of Point III

Butler claim in suit invalid as drawn to (or because claiming) an old and exhausted combination of grease-cup, pump and coupler;—whereas patentee's improvement, if any, is merely in the coupler.

### Argument of Point IV ......83 to 89

- a) Respondent may not restrict the use of assertedly Butler-improved couplers of its own manufacture, to the exclusion of grease-cups manufactured by petitioner;—or, respondent may not impose as a condition of sale of its couplers that the purchasers thereof shall not use same with old grease-cups manufactured or sold by petitioner.
- b) Purchasers of respondent's assertedly Butlerimproved couplers are impliedly licensed to use same with any old and unpatented grease-cup including those of petitioner.

# INDEX OF SUBJECT MATTER—Continued.

Page

#### Appendix I

Excerpts from plaintiff-respondent's brief addressed to the Circuit Court of Appeals for the Eighth Circuit in Stewart-Warner v. Jiffy Lubricator Co. (81 Fed 2d 786) showing more fully what plaintiff-respondent did urge upon that court as to the scope of the Butler patent here in suit......1a to 4a

#### Appendix II

# TABLE OF CASES CITED.

	Page
Adams v. Bassick, 285 U. S. 531	4
Alemite v. Lubrair (C. C. A. 1), 62 Fed. 2d 899	79
Alemite v. Rogers (see Rogers v. Alemite).	
Bassick v. Auto Equipment Co. (C. C. A. 7), 13 Fed.	
2d. 463	5. 36
Bassick v. Adams (C. C. A. 2), 52 Fed. 2d. 36	5, 36
Bassick v. Hollingshead (see Rogers v. Alemite).	, 00
Carbice v. American Patents Corp., 283 U. S. 27,	
4, 58, 60, 61, 8	6, 87
Concrete Appliances Co. v. Gomery, 269 U. S. 177	4
Dernell Potato Products Co. v. Snelling (C. C. A. 2),	4 -
38 Fed. 2d 788	55
Edison Electric Light Co. v. Peninsular Light Co. (C.	
C. A. 6), 101 Fed. 831	6, 88
General Electric Co. v. Ohio Brass Co. (C. C. A. 3),	-,
277 Fed. 917	2, 85
Germantown Trust Co., 57 Fed. 2d 365 U.S. Ct. of	-,
Customs & Patent Appeals)	79
Gypsy Oil Co. v. Escoe, 275 U. S. 498	4
Harvey-Hubbell v. General Electric, 267 Fed. 56486	6. 87
Heald v. Rice, 104 U. S. 737	2, 85
Hollingshead v. Bassick (C. C. A. 6), 73 Fed. 2d., 543.	7
International Business Machines Corp. v. U. S., 298	1
U. S. 131	87
I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429.	4
Kodell Electric v. Warren Telechron (C. C. A. 6), 62	
Fed. 2d 692	79

# TABLE OF CASES CITED-Continued.

Page
Langen v. Warren Axe & Tool Co., 184 Fed. 720 79, 85
Larkin v. Bassick (C. C. A. 7), 19 Fed. 2d., 9447, 35, 36
Leeds & Catlin v. Victor, 231 U.S. 301 and 32537, 58, 59, 61
Leitch v. Barber, 302 U.S. —
Lyman v. Bassick (C. C. A. 6), 18 Fed. 2d. 297, 35, 36
Lincoln v. Stewart-Warner (the case at bar):
In U. S. District Court:
On final hearing, 15 F. Supp. 571
On motion for rehearing, 16 F. Supp. 788 3
On motion for supersedeas, 31 U.S. Pat. Q.
195
In C. C. A. 7, 91 Fed. 2d 757,
2, 15, 16, 34, 35, 38, 39, 44, 45, 46, 56, 65, 66,
74-78, 88, 89, and Chart facing page 26, and
Appendix pages 5a-8a.
Certiorari granted by this Court, 302 U.S 1
Milburn v. Davis-Bournonville, 270 U.S. 390 4
Morgan Envelope Co. v. Albany, 152 U. S. 425 86
Popular Mechanics v. Brown (C. C. A. 7), 245 Fed.
859, 860 52
Radio Corp. v. Lord (C. C. A. 3), 28 Fed. 2d 257, cer-
tiorari denied 278 U.S. 648
Ratican, 36 App. D. C. 95 79
Rogers v. Alemite, 298 U. S. 415,
2, 4-7, 11-17, 21, 24, 28, 32-39, 43-46, 58, 61-75, 77-80,
84-86, 89, and Charts facing 26 and 52
In U. S. District Court, 5 F. Supp. 94035, 36
In C. C. A. 3, 74 Fed. 2d 1019

#### TABLE OF CASES CITED—Continued.

Pogo.
Page
Stewart-Warner v. Lincoln (the case at bar) (see
Lincoln v. Stewart-Warner).
Stewart-Warner v. Jiffy (C. C. A. 8), 81 Fed. 2d 786;
certiorari denied 299 U. S. 554,
2, 8, 9, 19, 25, 26, 28, 30, 38-45, 47, 51-56, 63, 64,
73, 74, 89, and Charts facing 26 and 52,
and Appendix pages 1a-4a.
Stewart-Warner v. Rogers and Universal (15 F. Supp.
410)
Thomson-Houston v. Illinois Telephone Construction
Co. (C. C. A. 7), 152 Fed. 631
Troy Wagon v. Ohio Trailer, 274 Fed. 612 85
Underwood v. Gerber, 149 U. S. 224
United Shoe Mach. Corp. v. U. S., 258 U. S. 451 87
Wagner v. Webster, 144 Fed. 405, 40986, 87
Wall Pump Co. v. Gardner (C. C. A. 7), 28 Fed. 2d 334. 85
2
STATUTES.
U. S. Code, Title 28, Sec. 347
U. S. Code, Title 35, Sec. 31 (U. S. R. S. 4886) 4, 49
U. S. Code, Title 35, Sec. 33 (U. S. R. S. 4888),
23, 48, 50, 79, 83
Section 3 of Clayton Act (38 Stat. L. 731)48, 49, 50, 83, 84

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PAGE

# Supreme Court of the United States.

No. 608. October Term, 1937.

# LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

VS.

# STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

#### BRIEF FOR PETITIONER.

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

This is a suit for the alleged "contributory" infringement of Butler patent No. 1,593,791. The suit is before this Court on a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit. (302 U.S. .)

The Circuit Court of Appeals held that the sale by petitioner of an old grease-cup, constituted "contributory" infringement of the patent in suit, even though the patent in suit is based upon an alleged improvement in an entirely different device, to wit, an alleged improvement in a coupler. The patent in suit, while based upon an alleged improvement in the internal construction or mechanism of a coupler, claims the allegedly improved coupler in so-called "combination" with the old grease-cup and the old pump with which the allegedly improved coupler is intended to be used.

Petitioner is **not** charged with having manufactured or sold **any** couplers (or pumps) in infringement of the patent in suit.

The Circuit Court of Appeals held that the sale by petitioner of an old grease-cup for use with an allegedly improved coupler (and an old pump) made by respondent assertedly in accordance with its Butler patent in suit, constituted "contributory" infringement of the patent. In this holding, the decision of the Circuit Court of Appeals is irreconcilably in conflict with the decision of this Court on Gullborg claims 1 to 10 in the recent case of Rogers v. Alemite (298 U. S. 415).

The Circuit Court of Appeals also held that, while Butler's allegedly improved coupler construction is barely distinguishable from the coupler constructions of the priorart, the coupler-part of Butler's claim-language may nevertheless be given a broad enough interpretation to cover the specifically different coupler construction of respondent's commercial Alemite HYDRAULIC coupler (with which petitioner's grease-cup is charged "contributorily" to infringe). In this holding, the decision of the Circuit Court of Appeals is in direct conflict with the decision of the Court of Appeals for the Eighth Circuit in the case of Stewart-Warner Corp. v. Jiffy Lubricator Co. (81 Fed. 2d, 786;—certiorari denied 299 U. S. 554) as to the scope of Butler's coupler invention.

### OPINIONS OF THE COURTS BELOW.

The opinion of the Circuit Court of Appeals for the Seventh Circuit on the appeal in the case at bar, is reported at 91 Fed 2d 757 (and is also in the Transcript of Record herein on pages 638 to 644). The order of said Court on the petition for rehearing is unreported but is reproduced in the Transcript of Record herein (R p 719).

The opinion of the District Court is reported at 15 F. Supp. 571, and is also reproduced in the Transcript of the Record herein on pages 603 to 620, inclusive.

Subsequently, the District Court also filed a second opinion on the denial of defendant's petition for rehearing in the trial court. This second opinion is reported at 16 F. Supp. 788. As defendant took no appeal therefrom, and as indeed no appeal lies from such denial of the petition for rehearing, the Transcript of Record before the Court of Appeals for the Seventh Circuit and likewise the Transcript of Record filed herewith, contains

neither the additional and newly discovered evidence which formed the basis, inter alia, of defendant's petition for rehearing in the trial Court,

nor the opinion of the trial Court denying such petition for rehearing.

Likewise, the Transcript of Record does not include the further oral statements of the trial Court on the denial of defendant's motion for supersedeas, as defendant took no appeal from such denial of supersedeas. These latter oral remarks of the trial Court are not reported in the Federal Reporter system, although they are reported at 31 U.S. P. Q. 195.

#### JURISDICTION.

The grounds on which the jurisdiction of this Court is invoked, are:

1. The date of the judgment to be reviewed was June 29, 1937 (R p 645 for the judgment and R p 628-644 for the opinion). Petitioner duly filed a timely petition for rehearing in the Circuit Court of Appeals (R pp 647-178), but the same was denied. The date of the order denying the petition for rehearing is September 15th, 1937.

- 2. The judgment was rendered in a suit in equity brought under the patent statutes to determine the issues of validity and infringement of letters patent for invention issued by virtue of Sec. 4886 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 31).
- 3. The statute under which jurisdiction is invoked is Sec. 240 (A) of the Judicial Code (U. S. C. Title 28, Sec. 347), as amended by the Act of February 13, 1935.
  - 4. Cases sustaining jurisdiction are:—

Gypsy Oil Co. v. Escoe, 275 U. S. 498

(on timeliness of petition for writ of certiorari);

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429;

Rogers v. Alemite, 298 U. S. 415;

Bassick v. Hollingshead, 298 U. S. 415

(conflict as to scope or infringement of same patent);

Concrete Appliances Co. v. Gomery, 269 U. S. 177 (conflict as to validity of same patent);

Alexander Milburn v. Davis-Bournonville, 270 U. S. 390 (conflict on same question of patent law);

Carbice v. American Patents Development, 283 U.S. 27;

Adams Grease Gun Corp. v. Bassick Mfg. Co., 285 U. S. 531; Rogers v. Alemite, 298 U. S. 415;

Leitch v. Barber, 302 U. S.

(conflict with applicable decisions of this Court).

# STATEMENT.

# Respondent Was Recently Before This Court on the Same Question.

Respondent was recently before this Court in two other cases-presenting precisely parallel facts and the same legal situation as in the case at bar, to wit, the cases of:

Bassick Mfg. Co. v. Hollingshead Co., Rogers et al. v. Alemite Corporation, 298 U. S. 415.

The Alemite Corporation (formerly known as the Bassick Mfg. Co.) was and is a wholly-owned subsidiary and predecessor in business of the respondent Stewart-Warner Corporation. Formerly the Stewart-Warner Corporation conducted the lubricating-equipment branch of its business and held its many similar patents in the name of its said subsidiary, but more recently in its own name.

# LUBRICATING EQUIPMENT Grease-cups—Pumps—Couplers.

Petitioner and respondent are both engaged in the sale of lubricating equipment for the lubrication of bearings of automobiles and other machinery comprising three separate and distinct classes or kinds of equipment or devices, to wit:

a) Grease-cups. These are generally permanently attached to the bearings of machine to be lubricated (such as the automobile, industrial machinery, farming machinery, etc.) and which grease-cups

<sup>\*</sup>Just as were both parties in Rogers v. Alemite, 298 U. S. 415.

are sometimes referred to as "fittings" or "nipples" (and also called by many other names both in the Butler patent in suit as well as in the priorart patents). This fluid-receiving member is variously called by many names, but when it is used to receive lubricant, it is sometimes referred to as a grease-cup and sometimes as a "nipple" or "fitting" or "lubricant-receiving member" or "lubricant receptacle", etc. The Gullborg patent (adjudicated by this Court in Rogers v. Alemite, 298 U. S. 415) calls the same grease-cup by many different names in various parts of the specification and claims. Sometimes it is even referred to as a "coupling element".

#### and

b) Pumps for pumping lubricant. The pumps are sometimes referred to as the "compressor" and sometimes as the "grease-gun". Pumps vary in size and construction over a wide range. Some are small hand-operated pumps and some are larger pumps operated by compressed air and some are electrically operated.

#### and

c) Couplers or nozzles for making temporary, fluidtight connection between the discharge hose or connection between the discharge hose or conduit of the pump on one hand and the grease-cup on the other hand.

The term "coupler" and the term "nozzle" are often used interchangeably, but are sometimes used to distinguish between two specifically different kinds of connectors generally used for making a temporary fluid-tight connection between a pump and a grease-cup.

Thus the term "coupler" is sometimes used to designate the type of connector device which grips or hooks onto, or mechanically interlocks with, the grease-cup, as for instance

- the bayonet type coupler of Gullborg patent No. 1,307,734 (R pp 534-539 and also 298 U. S. 415), and
- the various multi-jawed "chuck" type couplers having radially movable locking or gripping jaws, as that of the Seng patent No. 1,322,357 (R pp 542-544), and as that of the Newton patent No. 1,118,876 (R pp 502-505), and
- the various other fixed-jaw type head-engaging couplers, as for instance that of the Dupre patent No. 927,337 (R. pp. 494-499), and that of the Winkley patent No. Re 14,667 (R pp 526-532, and also adjudicated in Lyman et al. v. Bassick, 18 Fed 2d, 29).

The term "nozzle", on the other hand, is sometimes used to designate the kind of connector (for making connection between pump and grease-cup) which is held in contact with the grease-cup only by pushing the device manually up against the grease-cup (while in use) and which type of connector is sometimes referred to as a "push-contact" nozzle;—as for instance that of the Zerk patent No. 1,475,-980 (R pp 546-555, and also adjudicated in Larkin v. Bassick, 19 Fed 2d 944, and shown at 19 Fed 2d 946, and also adjudicated in Hollingshead v. Bassick, 73 Fed 2d 543).

The use of the terms "coupler" and "nozzle" has not been uniform. Indeed, petitioner sold both the "gripping" type connector, as well as the "push-contact" type connector and has designated both (in its catalogues) as a "nozzle".

Thus, petitioner's "Model ND5" nozzle (which constituted the only defendant's accused device charged under the Butler patent when this suit was originally filed, as shown by bill of particulars on Record page 11) is a multi-jawed "chuck" type coupler for gripping a grease-cup and is similar to the Jiffy coupler which the Court of Appeals for the Eighth Circuit held did not infringe the Butler patent (81 Fed 2d 786). This petitioner's multi-jawed "chuck" type coupler catalogued by it as its "Model ND5 Nozzle" is shown in the second picture on Record page 411, and is also shown (in two forms differing in detail) in Figures 1 and 5 of the Barks patent No. 1,966,278 (R pp 578-582).

Petitioner also sells a "push-contact" type nozzle for making connection with the same grease-cups. This device is catalogued as its KLEENSEAL "nozzle" and is shown schematically at the top of Record page 397 and is further described on Record page 401 in connection with petitioner's grease-guns and is further illustrated in the uppermost picture on Record page 411 and is further shown on Record pages 413 and 415 and is further illustrated in colored pictures on Record page 427, and is the subject of Barks patent No. 2,010,174 shown on Record pages 584-7.

Thus, both petitioner as well as respondent sell each of the aforesaid **three** separate and distinct classes of equipment or devices, namely, (a) grease-cups, (b) pumps, and (c) couplers or nozzles;—for conjoint use with each other.

- a) Petitioner's grease-cups are known in the trade as the Lincoln KLEENSEAL "fittings" (R p 397);
- b) Petitioner's pumps are referred to in the trade as the Lincoln KLEENSEAL "grease-guns" (R p 401);

- c) Petitioner's coupler devices were at first known as the LUBRIGUN "nozzles" and later as the KLEENSEAL "nozzles" (R pp 411, 415, 427)
- a) Respondent's grease-cups are known in the trade as the Alemite HYDRAULIC "fittings";
- b) Respondent's pumps are referred to in the trade as the Alemite HYDRAULIC "grease-guns" or "compressors";
- c) Respondent's couplers are known in the trade as the Alemite HYDRAULIC couplers.

# THE CHARGE OF INFRINGEMENT.

This suit was originally based on petitioner's coupler device alone, and not upon petitioner's now-accused grease-cup.

The original bill of complaint in the present suit charged infringement only of Butler claim 1 and not of the Butler claim 2 now in suit, and did not charge infringement against any grease-cup, but, as in the Jiffy suit (81 Fed 2, 786), charged infringement solely against a coupler device.

After the decision of the trial court in the Jiffy case, respondent added Butler claim 2 to the case at bar, and also added petitioner's grease-cup to the case at bar, by an amended bill of particulars (R p 14).

After the decision of the Circuit Court of Appeals for the Eighth Circuit (81 Fed 2d 786) in the same Jiffy case, respondent withdrew from the issues at bar Butler claim 1 † 1 and also withdrew the petitioner's originally accused coupler.

<sup>\*</sup>See original bill of complaint on R p 2 and original bill of particulars on R p 11.
†At the opening of the trial at bar, R. pp. 33-35.

In this suit, respondent is not charging any infringement against any of petitioner's equipment (grease-cups, pumps and couplers) when petitioner's devices are used together or with each other.

In the case at bar, defendant-petitioner is NOT charged with making or selling ANY couplers.

The sole charge of infringement in the case at bar is that petitioner has sold headed grease-cups or so-called lubricant-receiving "fittings" or "nipples" for use with

a coupler manufactured and sold by respondent allegedly under its Butler patent in suit

and an admittedly old pump also manufactured and sold by respondent (also allegedly under its Butler patent in suit).

The grease-cup part of the Butler claim-language, to wit, the part: "a headed nipple for receiving lubricant", does not distinguish defendant's accused headed grease-cup or so-called "fitting" or "nipple" from the prior-art headed grease-cups. The charge of infringement levelled at petitioner's old headed grease-cup is that of "contributory" infringement, and is based solely upon the use of petitioner's old headed grease-cup with respondent's assertedly Butler-improved coupler and with respondent's old pump.

Thus, the sole charge of infringement finally relied upon by respondent in the case at bar is that the sale of petitioner's old grease-cup for use with respondent's cou-

<sup>&</sup>lt;sup>2</sup> As for instance, from the headed grease-cup of the Seng patent No. 1,322,357 (R pp 542-4) or of the Dupre patent No. 927,337 (R pp 494-9), or of the Winkley patent No. 14,667 (R pp 526-532).

plers assertedly made by respondent under its Butler patent in suit, constituted "contributory" infringement of the Butler patent.

### DIMENSIONS—INTERCHANGEABILITY.

The Arguments Which Respondent Successfully Advanced Below Are the Same As It Unsuccessfully Advanced to This Court in Its Earlier Rogers v. Alemite Case.

In the case at bar, respondent has stressed the suggestion that petitioner's herein-accused grease-cups are specially intended by petitioner for use with respondent's allegedly Butler-improved couplers.

In the case of Rogers vs Alemite, this Court accepted respondent's identical suggestion made in that case; and nevertheless decided against respondent, on the assumption that petitioner's grease-cups in that case were intended for use with respondent's Gullborg-improved couplers.

Petitioner's (as well as respondent's) three different classes of equipment or devices (grease-cups, pumps and couplers) are each separate and independent articles or devices of general application or interchangeable use.

Because of similar dimensioning of the grease-cups of the respective parties and similar dimensioning of the couplers or nozzles of the respective parties, the petitioner's grease-guns and nozzles can be applied to and used with respondent's grease-cups for dispensing grease into said grease-cups, and, vice versa, respondent's pumps and couplers can be applied to and used with petitioner's greasecups for dispensing grease into said grease-cups.

This precise situation was present in Rogers v. Alemite, 298 U. S. 415, where (as here) both petitioner and respondent made all three classes of equipment, to wit, greasecups, pumps and couplers;—with the grease-cups and couplers similarly dimensioned so that there was complete interchangeability. In Gullborg's claims 1 to 10 (involved in Rogers v. Alemite), as here, the invention was in the internal construction or mechanism of a coupler, and the charge of contributory infringement was levelled at the otherwise old defendant's grease-cup because it was interchangeable by virtue of similar dimensions.

The Butler patent specifies no dimensions, for obviously there could have been no invention in dimensions. The patent is, indeed, entirely silent on any question of dimensions. Insofar as any dimensions or proportions may be taken from the drawings of the Butler patent in suit, by measuring or proportioning the figures of the drawings, neither the dimensions nor the proportions of the greasecups of either of the parties in the case at bar, nor the dimensions or proportions of the couplers or connecting nozzles of either of the parties are those of the Butler patent.

In other words, the scaling of the Butler patent drawings, in an effort to produce apparatus which follows the proportioning or dimensions shown in the Butler drawings, would produce apparatus which would not fit or would not be interchangeable with any apparatus (grease-cup, pump. or coupler) of either party at bar.

Thus, dimensions are no part of the Butler patent, and insofar as dimensions can be found in the Butler drawings, they are not the dimensions of the equipment of either party.

Moreover, the matter of dimensions is not material, as shown by respondent's previous unsuccessful attempt to present the same matter before this Court, in the Rogers v. Alemite suit (298 U. S. 415), wherein respondent said to this Court:

"What the defendant-petitioners did was to make a fitting and to make a compressor which, if used together could be asserted **not** to embody all of the details of any one claim of the Gullborg patent.

"All of the parts were, however, given precisely such form, size and dimensions that they could be perfeetly interchanged with and substituted for the corresponding parts of the Gullborg system as manufactured and sold by the Alemite Corporation. If it had been the real purpose and intention of Rogers and Dusenberry to have their fittings used only in combination with their compressors, they could easily have made their coupler and fitting parts a sixty-fourth of an inch larger in diameter or smaller in diameter. They could easily have made the distance from the pin to the head a sixteenth of an inch longer or a sixteenth of an inch shorter. Any of these or like departures from the exact dimensions of the Alemite equipment would have prevented interchangeability and conjoint use. In this event, however, the owner of an Alemite compressor could not 'increase his repertory' by purchasing Rogers and Dusenberry fittings. He could not have lubricated his Alemite-equipped bearings by purchasing a Rogers and Dusenberry compressor,

"What Rogers and Dusenberry wanted was the opportunity to sell their fitting parts and their compressor parts for use in combination with the other parts which were sold by the Alemite Corporation. Consequently the Rogers and Dusenberry parts were given precisely such dimensions as would insure the requisite interchangeability.

<sup>\*</sup>In quotations throughout this brief, emphasis is ours unless otherwise noted.

"The District Court decided that Rogers and Dusenberry had made all of their parts of such form and dimensions that they could be combined with the other parts of the combination as sold by the Alemite Corporation, and that they had been manufactured and sold with the expectation and intention that the purchasers would so combine them. (R p 127.)"

(Quoted from pages 6 and 7 of respondent's Brief in Rogers v. Alemite, No. 31, Oct. Term, 1935.)

This Court recognized respondent's above-quoted statement in Rogers v. Alemite, by saying:

"The petitioners did sell pin fittings (grease-cups) of the type with which a grease gun (having the improved coupler) of the description of Gullborg's could be used" (298 U. S. 423). (Parenthetical portions ours.)

This Court decided against respondent in the Rogers v. Alemite case, notwithstanding its acceptance of the facts so suggested by respondent.

## THE BUTLER PATENT IN SUIT AND THE PRIOR ART.

The Butler patent in suit is based upon an asserted improvement of the internal construction or mechanism of hose couplers of the generically old multi-jawed "chuck" type.

While also showing a grease-dispensing pump and a grease-cup with which Butler's assertedly improved multijawed "chuck" type coupler may be used, the Butler patent, on its face, claims no novelty either in pumps or in grease-cups.

The pump shown in the Butler patent is nothing more than the pump of respondent's earlier and much-litigated <sup>1</sup> Gullborg patent (R pp 534-9) and is included in the Butler claim in suit merely by the broad and all-inclusive words "a lubricant-compressor";—a term which does not distinguish Butler's pump from any other pump of the prior art, but instead comprehends both the forms of pumps of the prior-art of record, as well as the vast array of all other pumps (of varied and complex construction) devised and used before Butler and as well as since Butler.

The grease-cup shown in the Butler patent is nothing more than the headed grease-cup of the earlier Seng patent No. 1,322,357 (R pp 542-4),3 or the headed grease-cup of respondent's earlier Winkley patent No. Re 14,667 (R pp 526-532),4 or the headed grease-cup of the still earlier Dupre patent No. 927,337 (R pp 494-9)5, or the headed fluid-receiving fitting or so-called nipple of any of the other prior art patents shown on the Chart facing page 16.

The Court of Appeals for the Seventh Circuit in the case at bar clearly pointed out, in its opinion, that the headed grease-cup or so-called headed "nipple" shown in the Butler patent and included in the Butler claim in the allinclusive words "headed nipple for receiving lubricant"

<sup>&</sup>lt;sup>1</sup> Adjudicated by this Court in Rogers v. Alemite (298 U. S. 415) after respondent's sixteen-year campaign of unfounded and unwarranted patent litigation.

<sup>&</sup>lt;sup>2</sup> Because the pump shown in the Butler patent is **not** distinguishable from the pumps of the Gullborg patent (R pp 534-9), or the Seng patent (R pp 542-4), or the Winkley patent (R pp 526-532).

<sup>8</sup> Referred to by Seng as the "ball lubricator".

<sup>&#</sup>x27;Referred to in Winkley's claims as the "headed oil receptacle" or the "lubricant receptacle".

<sup>&</sup>lt;sup>8</sup> Referred to by Dupre as the "lubricant-receiving member".

was old and unpatentable—the Circuit Court of Appeals saying (at 91 Fed 2d, 763; R p 673):—

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old."

The broad and all-inclusive words "a headed nipple for receiving lubricant" (by which the old headed grease-cup is included in the Butler claim in suit) do not distinguish from any of the headed grease-cups or headed "nipples" of the prior-art, but instead, comprehend all the various forms of headed "nipples" shown before Butler (and also the various forms of headed "nipples" since Butler).

Thus, while Butler intended his allegedly improved coupler for use in coupling a grease-pump to a grease-cup, Butler clearly did not invent any pump improvement, nor did Butler invent any grease-cup improvement. Likewise, Butler was not the first to use a head-engaging, multi-jawed "chuck" type coupler for connecting a grease pump to a grease-cup. This was fully disclosed in the earlier Seng patent No. 1,322,357 (R pp 542-4), and grease-pumps had also been connected to grease-cups by many other conventional types of couplers, as in the Gullborg patent No. 1,-307,734 (R pp 534-9), and as in the prior-art even antedating said Gullborg patent, as found by this Court in Bassick v. Hollingshead, 298 U. S. 415, and as in the Winkley patent (R pp 526-532).

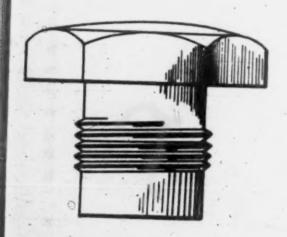
## THE SO-CALLED "COMBINATION" Of Grease-cup, Pump and Coupler.

Not only was the "combination" of grease-cup, pump and coupler old, but it was also old long prior to the Butler patent in suit to provide:—

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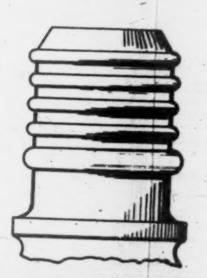
PAGE

Winkley's HEADED lubricant-receiving nipple of 1916 (R.p.528). Used by Winkley in "combination" with a compressor and coupler



Adapted to have any "head-engaging" hose coupler attached to it.

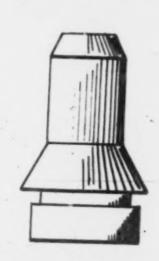
Newton's HEADED
fluid-receiving
fitting of 1914
(R.p.502)
Used by Newton
in "combination"
with a multi-jawed
fluid-actuated
"chuck-type conduit
coupler.



Adapted to have any "head-engaging" hose coupler attached to it.

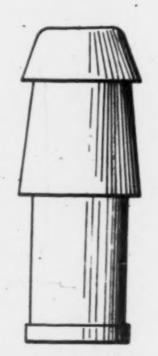
fluid-receiving
fitting of 1917.

(R. p. 516)
Used by Ulleland in
"combination" with
a multi-jawed conduit coupler interlockingly engaging
beneath the shoulder
of the head or flange
of the fitting.



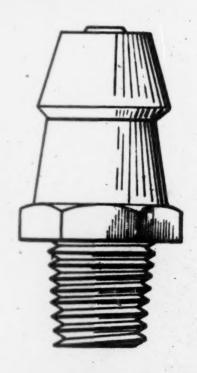
Adapted to have any "head-engaging" hose coupler attached to it

Paul's HEADED
fluid-receiving
fitting of 1897
(R. p. 480)
Used by Paul in
"combination"
with a multijawed "chuck"type conduit
coupler.



Adapted to have any "head-engaging"hose coupler attached to it.

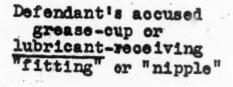
Butler's HEADED lubricantreceiving fitting or nipple
(R. p. 464)
Used by Butler not only in socalled "combination" with the
multi-jawed "chuck"-type
coupler of Butler Figure 2
and defined in the coupler
language in the Butler claims,
but also in "combination" with
the three specifically different and unclaimed multijawed "chuck"-type hose
couplers shown in Butler
Figures 3, 4 and 9.

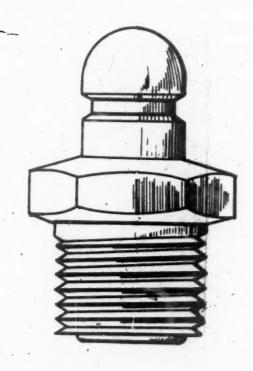


Adapted to have any "head-engaging"hose coupler attached to

## HEADED "NIPPLES" (Butler's, Petitioner's and Prior-art.)

lubricant-receiving
fitting or nipple
of 1915
(R. p. 542)
Used by Seng in
"combination" with a
lubricant-dispensing
compressor and a
multi-jawed "chuck"type hose coupler
interlockingly engaging beneath the head
of the "nipple" and
having a fluid actuated seal therein
for sealing against
the end of Seng's
nipple.



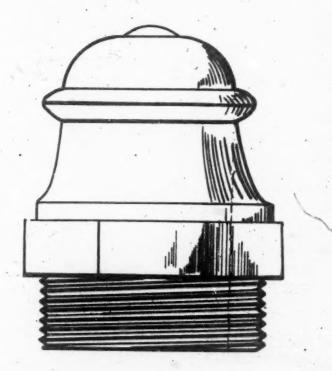


Richardson's

lubricant-receiving

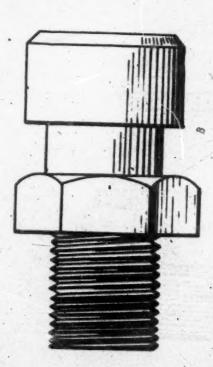
fitting or nipple
 of 1851
 (R. p. 472)

Intended by Richardson to have lubricant
put into it from the spout of an oil can.

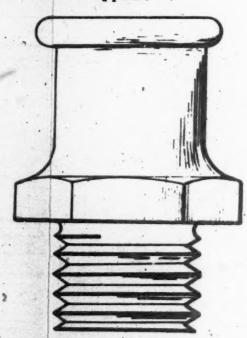


Also capable of having any "headengaging" hose coupler attached to it

Dupre's HEADED
lubricant-receiving
fitting or nipple
of 1908
(R. p. 496)
Used by Dupre in
"combination" with
a claw-type "headengaging" conduit
coupler and a
lubricant compressor



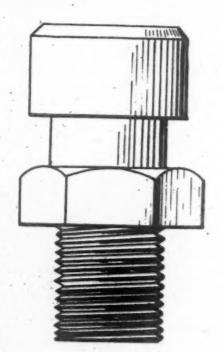
Adapted to have any "head-engaging" hose coupler attached to it

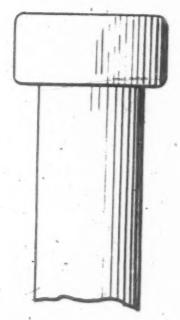


Adapted to have any "head-engaging" hose coupler attached to it

Dupre's HEADED lubricant-receiving fitting or nipple of 1908 (R. p. 496) Used by Dupre in combination" with a claw-type "head-engaging" conduit coupler and a lubricant compressor

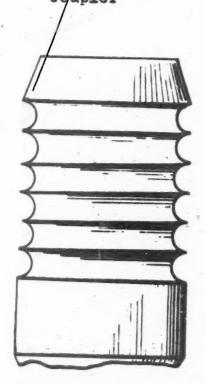
Griffin's HEADED . fluid-receiving
"fitting" "E" of
Figure 5, of 1904
(R. p. 591) Used by Oriffin with a "headengaging" claw-type conduit coupler.





Pinel's HEADED fluidreceiving fitting of 1902 (R. p./597)

Used by Finel in "com-bination" with a multi-jawed chuck-type hose coupler



Adapted to have any "head-engaging" hose coupler attached to it

Adapted to have any "head-engaging" hose coupler attached to it.

Adapted to have any "head-engaging" hose coupler attached to it

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PAGE

1) "headed" type grease-cups or so-called lubricant-receiving "fittings" or "nipples" affixed to the bearings of an automobile or other machinery,

#### and

2) a perambulatory lubricant-dispensing pump,

#### and

- 3) a multi-jawed "chuck" type coupler on the discharge end of the pump hose for making temporary and quick-attachable and quick-detachable connection between
  - a) the pump-hose or pump-conduit, on one hand,
    - b) the grease-cup or so-called "nipple"; on the other hand.

The antiquity of this so-called "combination" of (1) headed grease-cup, (2) pump and (3) "chuck" type coupler, is shown by Seng patent 1,322,357 (R. pp. 542 to 544) which discloses precisely this "combination" of grease-cup, pump and coupler. (See also Chart facing page 26.)

Thus, Butler (like Gullborg\*) allegedly invented an improved coupler. The alleged improvement was in the internal construction or mechanism of the coupler. However, instead of just claiming his coupler, Butler claimed his coupler (with its assertedly improved features specifically defined) in so-called "combination" with the old-style pump and the old-style grease-up or "nipple" with which prior-art couplers had customarily been used, as shown by the following claim analysis:

<sup>\*</sup>Gullborg patent 1,307,734, adjudicated by this Court in Rogers v. Alemite, 298 U.S. 415.

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Butler claim 2 analyzed:

Butler claim 2 quoted:

An old grease-cup.

Butler's allegedly

new and improved

coupler of Fig. 2

of drawings only.

The Court of Ap-

peals for the

Eighth Circuit held

that plaintiff-re-

spondent's com-

mercial "Alemite

Hydraulie" cou-

pler is not the cou-

pler here defined,

and that the cou-

pler here defined

was never produced

or sold by plaintiff.

(81 Fed. (2) 786.)

"The combination with" "a headed nipple for receiving lubricant.

An old pump

"a lubricant compressor having".

"a coupling member for connecting said compressor and nipple"

"comprising" (the coupler elements

1 to 5 below)

1) "a cylinder" (parts 31 & 32 in Figure 2 constituting the body or housing of the coupler).

2) "a piston (43 and 45) movable within the cylinder, and having"

3) "an aperture (48) for the discharge of lubricant thereof"

4) "an apertured sealing seat (washer 51) carried by said piston"

"for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple,"

5) "radially movable locking elements (jaws 40) carried by the cylinder coacting with the nipple and"

"actuated by said piston"

(given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).

"for compressively clutching 1 the elements upon the nipple"

"whereby the pressure of the lubricant on said piston will move the piston s to forcibly compress 1 said means (jaws 40) while the lubricant is passing through said connecting parts."

1) By the radially compressive action of the radially resilient spring-fingers (42) carried by the piston (43 & 45).

2) The piston (43 & 45 + 42) within the coupler. (Parenthetical statements ours. The numerals in parentheses identify the parts or elements similarly numbered in Figure 2 of Butler drawing.)

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PAGE

### Fundamental Question of Law in the Case at Bar.

The fundamental question of law in the case at bar (just as in the Rogers v. Alemite case, 298 U. S. 415), is whether one who allegedly invents an assertedly better coupler useful for connecting the old-style grease pump and the old-style grease-cup, can have a monopoly of the old-style grease-cup, by the simple expedient of including in his patent claim the old-style grease-cup, in so-called "combination" with his hose coupler, and then charging "contributory" infringement against the old grease-cups of others because usable with the patentee's assertedly improved coupler.

### The confusing dual-use of the word "combination"

In its repeated attempts to monopolize old pumps and old grease-cups through some alleged coupler improvement, respondent was faced with the obvious antiquity of the idea of connecting pumps to grease-cups by means of couplers. In order to overcome this obstacle, respondent resorted to the scheme of dramatizing the mere use of an allegedly improved coupler to connect the old pump with the old grease-cup, by calling such conjoint use (of these three separate and independent devices) a "combination".

In this latter sense in which the word "combination" is used, it merely signifies the conjoint use of two or more separate and distinct devices customarily used together;—as for instance, conjoint use of an electric lamp socket and an electric bulb, or the conjoint use of a fire engine and a

Gullborg patent No. 1,307,734 (R pp 534-9) litigated in over three hundred suits and adjudicated by this Court in Rogers v. Alemite (298 U. S. 415).

fire hydrant and a coupler by which fire engines and fire hydrants are customarily connected, or the conjoint use of a screw driver and a screw, or the conjoint use of a door jamb, a door and a lock. All these complementary devices are "combined" with each other in the sense that they are used conjointly with each other, and indeed they must be used with each other in order to have utility. In that sense, there is hardly a mechanical or electrical device which is not "combined" with one or more other separate, distinct and independent devices in its normal and intended use. Thus, the electric iron is "combined" with an electric plug and an electric cord and, indeed, with a pair of electric wires and an electric generator at the power house. In the same sense, an engine of an automobile is "combined" with a clutch, a gear-shift, differential, wheels and a chassis. However, the use of the word "combination" in this sense should not be confused with the use of the word "combination" in the sense where it refers to the combination of the elements which compose one allegedly new and improved device. Thus, the combination of elements which compose a new lock, should not be confused with the so-called "combination" of improved lock with the old door and door jamb, as this latter "combination" spells nothing more than the conjoint use of the improved lock with the old door and door jamb.

The lower courts in the case at bar have been confused by this dual use of the word "combination" and have confused

the combination of coupler-composing elements, that is, the combination of elements which go to make up an allegedly improved coupler (which may be patentable), and

the so-called "combination" or (or conjoint use) of the assertedly improved coupler with any old devices with which couplers are customarily used and which are customarily coupled to each other through such couplers (as for instance with an old pump and an old grease-cup).

Obviously, in this latter sense the word "combination" nerely signifies the conjoint use of two or more separate and distinct devices.

Thus, while Butler (like Gullborg in claims 1 to 10) at best only invented an improved coupler, he did not stop at merely claiming his assertedly improved coupler, that is, the possibly patentable combination of elements which go to make up or compose his assertedly improved coupler, as required by Section 4888 of the Revised Statutes, but instead (just like Gullborg), claimed his assertedly improved coupler in so-called "combination" with all old pumps and all old grease-cups with which it may be used;—which old pumps and old grease-cups merely constitute the old mechanical environment in which the patentee's assertedly improved coupler (just as the prior-art couplers) must necessarily be used.

### The Essence of Respondent's Position.

In regard to this fundamental question of law, respondent's entire position with respect to the old grease-cup

And petitioner does not admit that Butler even invented a better or different coupler or one patentable over the prior-art couplers.

<sup>2 &</sup>quot;Before any inventor or discoverer shall receive a patent for his invention or discovery, he \* \* shall file \* \* a written description \* \* so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, the improvement or combination which he claims as his invention or discovery." (U. S. C. Title 35, Section 33).

resolves itself into the proposition that respondent should have a monopoly of the old grease-cup, because the old grease-cup never had the experience of meeting a Butler coupler until there was a Butler coupler.

This Court held (298 U.S. 415) that respondent is not entitled to such a monopoly of old grease-cups.

Butler's alleged improvement in the internal construction or mechanism of a COUPLER.

Couplers are some of the most common devices, and are used for making fluid-tight connection between the fluid-delivery conduit or any fluid-supply line or pump, and some other member to which the fluid is to be supplied.

Multi-jawed "chuck" type couplers were old prior to Butler and had been used both

for connecting a grease pump to a grease-cup, as for instance in the early Seng patent No. 1,322,357 (R pp 542-4),

as well as

for connecting other fluid pumps (such as air pumps) to other receiving members or "fittings", as for instance in the early Newton patent No. 1,118,876 (R pp 502-5).

While the Butler patent in suit discloses four specifically different couplers 1 of the multi-jawed "chuck" type, the coupler-part of the Butler claim-language is readable only upon one of the four Butler couplers disclosed, to wit, that shown in Butler Figure 2. The other three Butler

Shown respectively in Figures 2, 3, 4 and 9 of the Butler drawings.

couplers (while shown and described in the patent) are not covered in any claim (presumably because they were concededly old and unpatentable multi-jawed "chuck" type couplers).

The coupler of Figure 2° of the Butler patent is merely one of a long line of multi-jawed "chuck" type couplers old in the art, as shown by the Seng patent (R pp 542-4) and the Newton patent (R pp 502-5) and the Paul patent (R pp 480-2).

The colored chart facing page 26 is divided into approximately three equal sections.

The section on the extreme left shows the Butler Figure 2 coupler and "nipple", and the Newton coupler and "nipple", and the Seng coupler and "nipple".

In the center section, we have shown the Jiffy coupler and "nipple" and respondent's own coupler and "nipple" (assertedly under the Butler patent) all of which were adjudicated (unfavorably to respondent) in Stewart-Warner v. Jiffy (81 Fed. 2d 786; C. C. A. 8).

In the right-hand section, we have shown the respondent's own coupler and petitioner's grease-cup or "nipple";—the conjoint use of which (together with an old pump) is charged to constitute the only infringement in the case at bar (the coupler and pump being sold by respondent and the grease-cup alone being sold by petitioner).

In this chart, we have colored the corresponding parts of the different couplers with the same colors.

The so-called "nipple" † is colored blue in each instance.

t which when used as a lubricant-receiving element is

the "grease-cup".

<sup>\*</sup> The only one of the four couplers shown in the Butler patent upon which the coupler-part of Butler's claim-language is readable.

The outer housing of the coupler or the coupler-body (sometimes called the "cylinder" and sometimes called the "sleeve" or the "shell") is colored green.

The plurality of circumferentially distributed and radially movable locking-jaws or gripping members are colored red.

The piston and its associated parts are colored purple in each case. In both Butler and Newton, the piston has associated with it spring fingers (marked 42 in Butler, and marked 9 in Newton) which are colored purple as a continuation of the piston. (Seng has no jaw-actuating piston, but instead has an outer jaw-actuating sleeve which has been similarly colored purple.)

It is because of the absence of these spring-fingers in both the Jiffy coupler as well as in respondent's own commercial coupler, that the Court of Appeals for the Eighth Circuit in Stewart-Warner v. Jiffy, supra, held that both the Jiffy coupler as well as respondent's own coupler were outside the scope of the coupler-part of the Butler claimlanguage.

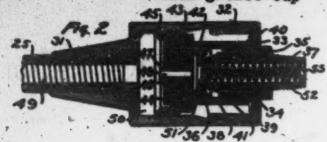
The Butler claim-language requires means "for compressively clutching" and "to forcible compress" Butler's "radially movable locking elements" (40, red) (upon the nipple" (blue). The only such means in Butler's Figure 2 coupler are the radially-resilient spring fingers 42, which supply radially resilient spring-compression to the radial actuation of the locking elements (40, red). Butler ascribes some special advantage to such spring-compression, but neither respondent's commercial coupler nor Jiffy's coupler embody this feature. In the Jiffy case the Court of Appeals for the Eighth Circuit correctly held that both Jiffy's coupler and respondent's commercial coupler lacked Butler's spring fingers.

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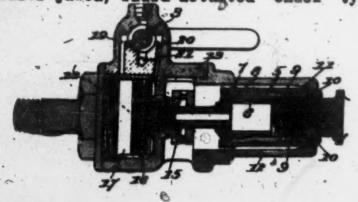
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#### BUTLER and the PRIOR-ART

SUTLER'S assertedly improved HOSE-COUPLER of the multi-jawed, fluid-actuated "chuck" type coupled to an OLD headed grease-oup



of the multi-jawed, fluid-actuated "chuck" type



SEEG'S 1915 HOSE-COUPLER for GREASE-GUNS and SEEG'S headed GREASE-CUP or "nipple" of 1915

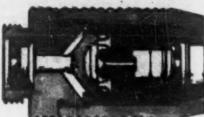


as distinguished from the "fluid-actuation" of the looking jaws in Newton and Butler although Seng's sealing member (orange) is "fluid-actuated" precisely as in Butler.

### The DEVICES before the

Circuit Court of Appeals for the Eighth Circuit in Respondent's suit against Jiffy Lubricator Co. Sl Fed 2d 786 (certiorari denied 299 U.S. 554)

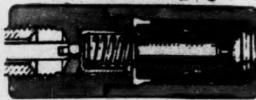
OUTSIDE the scope of Coupler Part of BUTLER claim-language



Respondent's own
"pin-fitting" type
grease-cup asserted
(in the Jiffy suit)
to be the "nipple"
of BUTLER claim 1

This is grease-cup of
Respondent's now-expired
Gullborg pat. 1,307,734
which the Court at 295 U.S. 415
held could NOT be broadly
re-monopolized under said
earlier Gullborg patent

Respondent's OWN COUPLER
("Alemite Hydraulic")
held OUTSIDE the scope
of coupler part of
BUTLER claim-language.



Respondent's OLD and unpatentable headed grease-oup



The DEVICES before the

Circuit Court of Appeals for the Seventh Circuit

IN THE CASE AT BAR: 91 Fed 2d 757

Respondent's OWN COUPLER ("Alemite Hydraulic") held WITHIH the scope of coupler part of BUTLER claim-language



Petitioner's CLD and unpatentable headed grease-oup



in THE CASE AT BAR

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The sealing means is colored orange in each case. The sealing means in both Butler, as well as Newton, as well as Seng, as well as in the Jiffy compler are all of soft resilient material such as leather or rubber or the like. Indeed the Butler coupler uses the old-fashioned cup shaped leather gasket of the Seng patent and of the Gullborg patent. Respondent's own coupler does not use a soft packing or sealing member but instead uses a hard steel plunger which, however, has been similarly colored orange.

With the interpretation of the coupler-parts of the Butler claim-language necessary to respondent's charge of infringement,\*\* the coupler-part of the Butler claim-language is fully readable upon the coupler of the Newton patent (R pp 502-5).

In the following two parallel columns, we have quoted the corresponding coupler parts of the claim-language of both Butler claims (1 and 2), and after the successive paralleled portions of the coupler-parts of Butler claims 1 and 2, we have pointed out the corresponding parts in the coupler of the Newton patent (R pp 502-5):

<sup>\*</sup>Respondent's charge of "contributory" infringement levelled at petitioner's old grease-cup is dependent, inter alia, upon giving the coupler-parts of the claim-language an interpretation readable on respondent's own commercial coupler.

The COUPLER-PARTS of the Butler Claims.

Compared and Applied to Newton's COUPLER.

Butler Claim 1.

Butler Claim 2 in Suit.

Scope adjudicated by C C A Claim held invalid at 15 F. 8 (81 Fed 2d 786). Supp. 410,

(Certiorari denied 299 U.S. on authority of 298 U.S. 415.

554.)

"a coupling for connect-... "a coupling member for coning said compressor and necting said compressor nipple," and nipple"

Newton's device is a coupling.

"the coupling compris-... "comprising" (coupler eleing" (coupler elements ments 1 to 5 below)

1 to 5 below)

1) "a cylinder" (parts 31 &. 1) "a cylinder" (parts 31 & 32 in Fig. 2 constituting the body or housing of the coupler).

1) "a cylinder" (parts 31 & 32 in Fig. 2 constituting the body or housing of the coupler.)

This is Newton's cylinder or sleeve 12.

2) "a piston (43 & 45)... 2) "a piston (43 and 45 movable within the cylinder, and having" inder, and having"

This is Newton's piston 16 to which is fastened the tubular piston rod or stem 15 and the

the tubular piston rod or stem 15 and the carrying plate 8

carrying plate 8

3) "an aperture (48) for... 3) "an aperture (48) for the discharge of lubricant therethrough, and" cant thereof"

This is the hole or small passage 18 through

Newton's piston

4) "an apertured seat"... 4) "an apertured sealing (washer 51) seat (washer 51) carried by said piston"

"for engagement with...
the end of the nipple,"

"for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple,"

This is Newton's "packing tube 5" or sealing member

COUPLER PARTS of Butler Claims (continued).

Claim 1 Claim 2

5) "means (jaws 40) car-..
ried by the cylinder"

5) adially movable locking elements (jaws 40) carried by the cylinder coacting with the nipple and

These are the outermost ends 10 of Newton's spring fingers, 9, which outermost ends serve as locking elements for engaging the head or bead of Newton's nipple 4
Newton's locking elements 10 are carried by his cylinder 12 in the same sense as they appear in respondent's commercial coupler.

"for compressively

engaging about the nipple"

"for locking said parts together against longitudinal displacement and"

"actuated by said piston". (43 & 45 + 24)

(given its radial nipplegripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45). "actuated by said piston"
(given its radial nipplegripping motion by the
radially compressive
action of the radially
resilient spring-fingers
42 carried by the piston
43 & 45).

"for compressively clutching" the elements upon the nipple"

Newton's locking elements 10 are "actuated by said piston for compressively clutching the (locking) elements upon the nipple".

\*By the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45.

### COUPLER PARTS of Butler Claims (continued).

#### Claim 1

"whereby the pressure... of the lubricant on said piston 1 will move the piston 1 to forcibly compress 2 said means (jaws 40) while the lubricant is passing through said connecting parts."

#### Claim 2

"whereby the pressure of the lubricant on said piston 1 will move the piston 1 to foreibly compress 2 said means (jaws 40) while the lubricant is passing through said connecting parts."

In Newton's coupler, too, the pressure of the fluid in the coupler moves the piston, forcibly to compress the locking jaws 10, through the radially compressive action of Newton's spring-fingers 9.

 The piston (43 & 45 + 42) within the coupler.
 By the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).

(Parenthetical statements ours. The numerals in parentheses identify the parts or elements similarly numbered in Figure 2 of Butler drawing.)

Thus, insofar as the coupler-part of Butler's claimlanguage may be given such interpretation as to be readable upon respondent's own commercial coupler, it is also readable upon the Newton coupler.

Or stating it otherwise, if the coupler-part of Butler's claim-language is given any interpretation which might distinguish the Butler coupler from the Newton coupler, then the same interpretation of Butler's claim-language will also distinguish respondent's own commercial coupler from Butler's coupler.

The Court of Appeals for the Eighth Circuit in the case of Stewart-Warner Corporation v. Jiffy (81 Fed 2d, 786) tried to save the Butler patent from invalidity over the Newton patent (and other patents) and so held that respondent's own commercial coupler, as well as the Jiffy coupler, were not in accordance with the only Butler coupler upon which the Butler claim was readable (Butler Figure 2 coupler), and held that there was no infringement. Finding no infringement, the Court could (and did) treat the question of the validity of the Butler patent more leniently—in line with the practice of some courts to hold a patent not infringed, if possible on a narrow interpretation, rather than to hold the patent invalid, notwithstanding that the broader interpretation of the claim urged by plaintiff makes it clearly readable on the prior-art.

Thus, if a narrow construction of the claim-language results in non-infringement, there is generally no need for holding the patent invalid, even though the distinctions between the prior-art and the narrowest construction of the claim-language are still very doubtful.

The only faint distinction which respondent has so far been able to advance between the coupler-part of the Butler claim language and Newton's multi-jawed and fluid-actuated "chuck" coupler, is based upon a super-added limitation of the word "end", which word at best is merely a part of a functional statement about Butler's "apertured sealing seat" in the claim. Respondent has contended that the word "end" in the Butler claim should be given a limited meaning to differentiate from Newton's tubular (apertured) sealing gasket.

Thus, while Newton's tubular (apertured) sealing gasket 5 (orange colored in Chart facing page 26) is clearly "for engagement with the end" of Newton's fluid-receiving "fitting" or "nipple" 4 (blue in Chart facing page 26), respondent has arged that the word "end" should be limited to an axially directed engagement with the end of the

"nipple" as distinguished from the engagement of the same end of the "nipple" in a radial direction as in Newton.

In Newton's coupler, just as in Butler's coupler, the locking-jaws (colored red), as well as the sealing gasket (colored orange), are fluid-actuated;—that is, the greater the pressure of the fluid in the coupler, the harder will the locking-jaws (red) and the sealing-gasket (orange) be pressed into "engagement with the end of the nipple" as stated by Butler's claim-language. The only difference is that Newton's sealing gasket (orange) is pressed into "engagement with the end of the nipple" in a radial direction, while Butler's sealing gasket (red) is pressed into "engagement with the end of the nipple" in an axial direction (with reference to the longitudinal axis of the generally tubular "nipple" and coupler).

This difference is not expressed or implied in Butler's claim-language.

Moreover, if this limitation is read into the coupler-part of Butler's claim-language in an effort to develop some real or imaginary distinction between Newton's coupler and the coupler-part of Butler's claim-language, such distinction is without patentable significance because it, at best, merely spells the substitution of Gullborg's (R pp 534-9) or Seng's (R pp 542-4) conventional axially-sealing "cupwasher" (colored orange in Chart facing page 26) in place of Newton's radially-sealing tubular washer.

Thus, the very thing (the axially-sealing washer) which was the basis of respondent's claim of invention for Gullborg's coupler (298 U. S. 415), is now attempted to be read into the coupler-part of Butler's claim-language as the sole distinction between the coupler-part of Butler's claim-language and Newton's old multi-jawed fluid-actuated "chuck" coupler.

Thus, at best, it is merely upon the substitution of Gullborg's or Seng's axially-sealing cup-washer, in place of Newton's radially-sealing tubular gasket, within the mechanism of the old multi-jawed "chuck" type couplers, that respondent bases its claim of monopoly on all headed grease-cups and all pumps which may be usable with the assertedly improved coupler.

This Court in Rogers v. Alemite, supra, held that respondent could not have a monopoly of all pumps and grease-cups usable with Gullborg's assertedly improved coupler, where that coupler was likewise claimed to be distinguished from the prior-art "bayonet" type couplers by the same axially-sealing washer.

The factual situation is exactly parallel and the legal situation is precisely the same in the case at bar as in the recent case of Rogers v. Alemite (298 U. S. 415) involving respondent's earlier Gullborg patent.

The Butler patent in suit (just like respondent's earlier Gullborg patent No. 1,307,734 which was adjudicated by this Court at 298 U. S. 415), discloses several separate and distinct mechanical devices, each complete in itself and each having a separate and independent status in the art of lubrication and constituting separate articles of commerce and manufacture;—said several separate and distinct devices having been customarily used in conjunction with each other.

The only relationship existing between said several separate and distinct devices is that each device constitutes

<sup>\*</sup>Long prior to Butler's application for the patent in suit.

the generically old environment in which the other devices are customarily used.

(It is much the same as an incandescent electric bulb or lamp is customarily used with an electric socket or vice versa; or much the same as a screw is customarily used with a screw driver, or vice versa; or much the same as a bottle-cap opener is customarily used with a bottle-cap and bottle or vice versa; or much the same as a fire engine is customarily used with a fire hydrant in the street and a hose-coupler in connection therewith; and so on ad infinitum).

The subject-matter of the Butler patent in suit is generally the same as the subject matter of respondent's earlier and much litigated Gullborg patent No. 1,307,734, to wit:

- (A) A grease-cup or so-called "fitting" or "nipple" adapted to be secured to the various bearings of an automobile or other machinery;
- (B) A separate and generally portable grease pump, compresser or so-called "grease-gun" for pumping grease under suitable pressure, and
- (C) A hose-coupler on the end of the discharge hose of the grease pump or compressor or "grease gun", for temporarily making a fluid-conducting connection between the discharge hose of the pump or compressor, on one hand, and the grease cup, fitting or nipple, on the other hand.

This was recognized by the Seventh Circuit Court when it said:

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the

patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick v. Hollingshead opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler. (91 Fed 2d 761; R. p. 633.)

Indeed, right up to the time respondent suffered the adverse decision of this Court on its earlier Gullborg patent (298 U. S. 415)

respondent had firmly relied upon the many decisions of the Courts on its earlier Gullborg patent which this Court thereafter reversed (either directly or in effect) in the cases of Bassick v. Hollingshead and Rogers v. Alemite (298 U. S. 415);

patent No. 1,307,734, and the many prior adjudications thereon favorable to it, presented cases "on all fours" with the situation under its more recent Butler patent here involved.

<sup>\*</sup>Both in the trial court in the case at bar, as well as in the trial court in its companion suits on the same Butler patent (decision is reported at 15 Fed. Supp. (410).

<sup>†</sup>Bassick v. Auto Equipment, 13 Fed 2d 463 (CCA 7). Lyman et al v. Bassick, 18 Fed 2d 29 (CCA 6). Larkin v. Bassick, 19 Fed 2d 944 (CCA 7). Bassick v. Adams, 52 Fed 2d 36 (CCA 2). Alemite v. Rogers, 5 F. Supp. 940 (D. C.). Rogers v. Alemite, 74 Fed 2d 1019 Reversed at (CCA 3).

The situation in the case at bar is in fact "on all fours" with the situation before this Court on claims 1 to 6 and 8 and 10 of Gullborg patent No. 1,307,734 in Rogers v. Alemite, 298 U. S. 415.

This Court in said case of Rogers v. Alemite (298 U. S. 415) held that a patentee could **not** thus re-monopolize the old-style grease-cup or so-called "nipple" or "fitting" under the guise of a patent predicated upon a coupler improvement. Respondent's scheme and attempt to so monopolize an old style grease-cup

by including such old style grease-cup in a patent claim in so-called "combination" with the inventor's hose coupler, and

by then charging "contributory" infringement against the old style grease-cups usable with his hose coupler,

was condemned by this Court in said recent Rogers v. Alemite case (298 U. S. 415)

The trial court in the case at bar failed to follow this Court's decision in Rogers v. Alemite (298 U. S. 415)

notwithstanding respondent's own contention before that court that the prior decisions of the courts on its earlier Gullborg patent No. 1,307,734\*\* consti-

<sup>\*\*</sup>Bassick v. Auto Equipment, 13 Fed 2d 463 (CCA 7).
Lyman et al v. Bassick, 18 Fed 2d 29 (CCA 6).
Larkin v. Bassick, 19 Fed 2d 944 (CCA 7).
Bassick v. Adams, 52 Fed 2d 36 (CCA 2).
Alemite v. Rogers, 5 F. Supp. 940 (D. C.).
Rogers v. Alemite, 74 Fed 2d 1019 Reversed at (CCA 3).

tuted controlling authorities for respondent's position under its more recent Butler patent No. 1,593,-791 here in suit

#### and

notwithstanding that respondent's controlling authorities were subsequently reversed by this Court in Rogers v. Alemite (298 U. S. 415), after respondent had so firmly relied upon such authorities in its brief to the trial court herein.

### The sole distinction relied upon by the trial court

between

the Butler patent in the case at bar

#### and

the earlier Gullborg patent in Rogers v. Alemite (298 U. S. 415)

was the supposedly greater "pioneer" character of Butler's more recent invention. The District Court said:

"The rather startling features of the Supreme Court's opinion is the announcement that the Leeds case, patent to Berliner 534,543, was a pioneer patent." (15 F. Supp. 577; R p 613.)

"The situation is not one where the language of the Supreme Court in the Gullborg case is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer." (15 F. Supp. \$79; R p 616.)

The trial court in the case at bar failed to accept this Court's recent interpretation of the Leeds & Catlin case (in Rogers v. Alemite) and expressed its disagreement by saying that Butler was a pioneer in the same sense as this Court used the word "pioneer" in Rogers v. Alemite. In so char-

acterizing Butler, the trial court disregarded the absolute parallelism between the case at bar and the case of Rogers v. Alemite, a parallelism urged upon the trial court by respondent itself, just before this Court handed down its decision in Rogers v. Alemite.

However, the Court of Appeals in the case at bar deprived Butler of the position of a "pioneer", just as did the Court of Appeals for the Eighth Circuit in the Jiffy case.

Thus, the Court of Appeals for the Eighth Circuit in the Jiffy case said:—

"Although none of these patents actually anticipates the claim of the Butler patent covering his coupler adapted for lubricating apparatus, they preclude any conclusion that his was a pioneer patent in the art of making automatic chucks." (81 Fed. 2d 792.)

The Court of Appeals for the Seventh Circuit in the case at bar in turn said:—

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick v. Hollingshead opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

"While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling." (91 Fed 2d 761; R. p. 633.)

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old."

#### (91 Fed 2d 763; R. p. 637.)

"We are not convinced that the discovery belongs to the pioneer class. It was an improvement, but not an outstanding advance. Whether that improvement was such as to justify the issuance of a patent may well be and is seriously debated."

#### (91 Fed 2d 765; R. p. 642.)

Thus, notwithstanding the fact that the Court of Appeals for the Seventh Circuit in the case at bar deprived the trial court's decision of its sole support with respect to the attempted distinction between the Gullborg patent in the Rogers v. Alemite case and the Butler patent in the case a bar;—the Court of Appeals nevertheless erroneously failed to follow the clear and unmistakable and admittedly controlling decision of this Court in the Rogers v. Alemite case.

Likewise, while clearly holding that Butler was not a pioneer and while even entertaining serious doubts as to there being any patentable invention in Butler's coupler, the Court of Appeals in the case at bar nevertheless gave the coupler-part of the Butler claim-language a broader construction than was given to it by the Court of Appeals for the Eighth Circuit, and in so doing reached a decision as to the scope of the Butler patent in conflict with that reached by the Court of Appeals for the Eighth Circuit in the Jiffy case.

#### The Decision (CCA 8) in Stewart-Warner v. Jiffy.

In the case of Stewart-Warner v. Jiffy (91 Fed 2d, 786; CCA 8) the so-called "combination" of claim 1 of the Butler patent (like claim 2 in form and substance) was not asserted against defendant's grease-cup for use with plaintiff's coupler and pump as was claim 2 in the case at bar, but it was asserted against defendant's coupler and pump for use with plaintiff's grease-cup of the old "bayonet" type manufactured by plaintiff under its older Gullborg patent 1,307,734 (which older Gullborg grease-cup or "fitting" was thus made the "nipple" of the more recent Butler patent).

Jiffy's accused coupler had dimensions to fit onto and to be usable with the old "pin-fitting" type grease-cup manufactured and sold by respondent

- under respondent's earlier Gullborg patent No. 1,307,-733, which claimed its particular form of grease-cup per se, and
- under claims 14 & 15 of respondent's earlier Gullborg patent No. 1,307,734, which claimed its particular form of grease-cup device in alleged "combination" with the admittedly old pump, old hose and old coupler of the prior art, and
- under claims 1 to 6 and 8 & 10 of the same earlier Gullborg patent No. 1,307,734, which claimed the grease-cup device generically (to include both old and new grease-cups) in alleged "combination" with an assertedly improved hose coupler and an admittedly old hose and old pump of the prior-art.

In the case at bar, the charge of contributory infringement is levelled at petitioner's old-style grease-cup or socalled "fitting" or "nipple" because usable with the assertedly Butler-invented couplers manufactured and sold by respondent.

In the Jiffy case, the charge of contributory infringement was levelled at an asserted Butler-invented coupler of Jiffy's manufacture when used with an old Gullborg "pin-fitting" type grease-cup made and sold by respondent under its now expired Gullborg patents.

Both plaintiff-respondent's assertedly Butler-invented coupler, as well as Jiffy's assertedly Butler-invented coupler are different from the only coupler (of the several couplers) disclosed in the Butler specification and drawings upon which the coupler-part of the Butler claim-language is readable (the coupler of Butler Figure 2).

Respondent urged upon both Courts in the Jiffy case that the coupler part of the Butler claim-language should be given a broad interpretation on the ground that unless given such broad interpretation, the coupler part of the Butler claim-language would not even cover respondent's own commercial form of coupler asserted by it to have been made under the Butler patent; respondent urging upon the Courts in the Jiffy case (and both Courts finding) the substantial identity between Jiffy's accused coupler and respondent's commercial coupler known as the Alemite Hydraulic coupler'.

However, both

in order to maintain necessary concordance and harmony between the coupler part of the claim-language and the applicable parts of the specification and drawings of the Butler patent upon which the claim was readable, and so to give some meaning to the otherwise vague and indefinite claim-language in order to save the Butler patent from invalidity in the Jiffy suit in view of very similar prior-art hosecouplers,

the trial court as well as the Court of Appeals for the Eighth Circuit (in the Jiffy case) construed the coupler part of the Butler claim-language in the light of Butler's specification and drawings,\* and the narrow scope so afforded the coupler part of the claim-language not only exculpated Jiffy's accused coupler, but, in the opinion of the Court of Appeals for the Eighth Circuit, equally well and definitely excluded from the scope of the Butler patent respondent's own commercial couplers assertedly made under the Butler patent. This is the very same coupler ("Alemite-Hydraulic") in conjoint use with which your petitioner's old style grease-cup or "nipple" is here charged contributorily to infringe.

Indeed, the Court of Appeals for the Eighth Circuit found that respondent's said commercial coupler was copied by respondent from Jiffy's coupler which Jiffy had submitted to respondent prior to respondent's commercialization of this type of coupler.

The appellate decision in the Jiffy suit, if followed in the case at bar, would therefore of necessity also exculpate your petitioner's herein accused grease-cup upon a further

That is, the only parts of the Butler specification and drawings upon which the Butler claim is readable. The Butler claim is clearly not readable upon anything but Figure 2 of the Butler drawings and the corresponding portions of the specification, to wit, the portions of the specification beginning in line 87 of page 2 of the Butler specification (R. p. 468), down to line 5 of page 3 of the Butler specification (R. p. 469) and lines 14 to 36 inclusive of page 3 of the Butler specification (R. p. 469).

ground of non-infringement, because the charge of contributory infringement levelled at petitioner's grease-cup at bar, is predicated and is absolutely dependent upon respondent's commercial hose-couplers being within the scope of its Butler patent.

Because of the necessarily limited scope of the coupler part of the Butler claim-language, the defendant Jiffy did not urge the further defect in the Butler claim 1, fatal to its very validity, to wit, the unwarranted inclusion therein of the admittedly old-style grease-cup and the admittedly old-style pump.

If respondent had prevailed in the Jiffy suit, it would there have had not only a monopoly of the Jiffy coupler, but also a second 17-year monopoly of the old "Alemite pinfitting" of its now expired and widely litigated Gullborg patents (298 U. S. 415); for if respondent had prevailed in the Jiffy case, then under respondent's theory of the case at bar, the manufacture and sale of the old "Alemite pinfitting" would have constituted contributory infringement of its more recent Butler patent here in suit, because such old "Alemite pin-fitting" would be usable with a hose-coupler which would then have been held to respond to the coupler part of the language of Butler claim 1.

While the Jiffy decision was on Butler claim 1 and the decision in the case at bar on Butler claim 2, the coupler parts of the language of these two claims are indistinguishable in substance, as will readily be apparent from the two parallel columns on pages 28-30 of this brief, where the coupler parts of the language of both Butler claims 1 and 2 are set out verbatim in two parallel columns.

#### SPECIFICATION OF ERRORS.

The errors which petitioner urges are the following:

1) The Court of Appeals for the Seventh Circuit erred in holding†

that the hose coupler purported to be defined in the coupler-part of the Butler claimlanguage\* is both patentably different from the prior-art couplers,

and at the same time holding+

that such coupler-part of the Butler claimlanguage is broad enough to include plaintiff-respondent's commercial coupler (specifically different from that shown in Butler Figure 2), in conjoint use with which petitioner's old grease-cup is charged "contributorily" to infringe.

- 2) The Court of Appeals for the Seventh Circuit erred in holding† Butler claim 2 both valid and at the same time infringed by the *conjoint use* of an old pump and a so-called "Alemite-Hydraulic" coupler sold by respondent, with an old grease-cup sold by petitioner.†
- 3) The Court of Appeals for the Seventh Circuit erred in holding, t in effect, that the inventor of a presumably improved and patentable coupler can validly claim his specific coupler in combination with an old grease-cup (or so-called lubricant-receiving "nipple") and an old pump or compres-

† in direct conflict with Stewart-Warner Corp. v. Jiffy Lubricator Co. (81 Fed. 2d 786; C. C. A. 8) as to the scope of the coupler-part of the Butler claim-language.

Different claims of the Butler patent were involved, but the coupler-parts of the claim-language are substantially the same in both instances (see pages 28-30 herein).

t in direct conflict with this Court's decision as to Gullborg's claims 1 to 10 in the case of Rogers v. Alemite (298 U. S. 415).

sor; with which two old devices, couplers of the prior-art had theretofore been used, and without which two old devices the inventor's improved coupler has no utility.

- 4) The Court of Appeals for the Seventh Circuit erred in holding, t in effect, that one who has presumably invented a better coupler can claim (as an allegedly new "combination") the use of old grease-cups and old pumps with his presumably improved coupler.
- 5) The Court of Appeals for the Seventh Circuit erred in holding, tin effect, that a patentee may use the patent laws to prevent the competitive sale of old and unpatentable grease-cups (or so-called "nipples") which may be usable, or indeed intended to be used with the patentee's allegedly improved and patentable coupler, as assertedly manufactured by plaintiff.
- 6) The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the owner of the patent can extend the monopoly of a so-called "combination" claim (drawn to an improved device plus two old devices), to pre-

<sup>\*</sup>Assuming (without conceding) for the purposes of this issue, that the patent owner (plaintiff-respondent here) manufactures and sells, and gives wide distribution to a coupler in reality responding to the coupler-part of the claim-language. (The Court of Appeals for the Eighth Circuit in Stewart-Warner v. Jiffy (81 Fed. 2d 786) held that respondent's coupler was not the coupler of the Butler patent.)

<sup>†</sup> this holding of infringement, by the conjoint use of the patentee's improved coupler with the defendant's old grease-cup, is also in direct conflict with this Court's decision on Gullborg claims 1 to 10 in the case of Rogers v. Alemite (298 U. S. 415).

t in direct conflict with this Court's decision as to Gullborg's claims 1 to 10 in the case of Rogers v. Alemite (298 U. S. 415).

vent the use of an old-style grease-cup or so-called "nipple" of competitive manufacture, with a coupler assertedly in accordance with the patent and manufactured and sold by the patent owner and with an old-style pump, also supplied by the patent owner.

- 7) The Court of Appeals for the Seventh Circuit erred in holding,‡ in effect, that a patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, can re-patent the old combination by re-claiming the combination with the improved element substituted for the old element.
- 8) The Court of Appeals for the Seventh Circuit erred in holding, that the multi-jawed "chuck" type coupler purported to be defined in the coupler-part of the Butler claimlanguage is patentably distinct from, or represents a patentable improvement or invention over the multi-jawed "chuck" type couplers of the prior-art.
- 9) The Court of Appeals for the Seventh Circuit erred in failing to reverse the decree of the District Court.
- 10) The Court of Appeals for the Seventh Circuit erred in not dismissing the bill of complaint for want of equity.
- 11) The Court of Appeals for the Seventh Circuit erred in denying defendant'petitioner's petition for re-hearing.

t in direct conflict with this Court's decision as to Gullborg's claims 1 to 10 in the case of Rogers v. Alemite (298 U.S. 415).

#### SUMMARY OF ARGUMENT.

The points of the argument hereinbelow follow the reasons relied upon for the allowance of the writ, as outlined in pages 19 to 24 of the Petition for Writ of Certiorari, and are briefly:

#### Argument Point 1:

The coupler part of the Butler claim-language, construed in the light of the applicable portions of the specification and drawings of the Butler patent <sup>1</sup>

#### and/or

construed in the light of the prior art so as in some way to be distinguishable over the prior art hose couplers

is not readable on and does not cover the respondent's commercial form of coupler, sometimes referred to as the "Alemite Hydraulic" coupler, in conjoint use with which petitioner's grease-cup is charged contributorily to infringe, and (as held by the United States Circuit Court of Appeals for the Eighth Circuit, in respondent's suit against Jiffy Lubricator Co., 81 Fed. 2d 786) respondent's said commercial form of hose coupler here involved is not in fact the coupler of the Butler patent.

#### Argument Point 2:

A patentee may not re-monopolize old-style grease-cups on the basis of an asserted improvement in a hose coupler <sup>2</sup> usable therewith.

<sup>2</sup> The hose coupler improvement may, for the purposes of this point of the argument, be assumed to be a patent-

able hose coupler.

<sup>&</sup>lt;sup>1</sup> Figure 2 of the Butler drawings, and the corresponding parts of the specification beginning in line 87, of page 2 of the Butler specification (R. p. 468), down to line 5 of page 3 of the Butler specification (R. p. 469) and lines 14 to 36 inclusive of page 3 of the Butler specification (R. p. 469).

#### Argument Point 3:

The Butler claim in suit is invalid or unpatentable because drawn to an old and exhausted combination of pump, grease-cup and coupler, whereas the patentee's improvement (if any), is at best merely in the internal construction or mechanism of the coupler. The construction and mode of operation of the old "combination" of pump, grease-cup and coupler, is otherwise unchanged.

The Butler claim in suit violates Section 4888 of the Revised Statutes in that the patentee has commingled in the patent claim

- (a) that which may be his (the improved coupler) with
- (b) that which is in the public domain (old-style grease-cup and old-style pump);—

the Statute requiring, inter alia, that the patentee "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery".

#### Argument Point 4-a:

Section 3 of the Clayton Act prohibits the monopoly such as herein asserted by respondent, and respondent may not restrict the use of the assertedly Butler-improved coupler of its own manufacture, to its periodic attachment solely to grease-cups of its own manufacture, (to the exclusion of grease-cups manufactured and sold by petitioner);—notwithstanding respondent's ownership of a patent assertedly covering its coupler in so-called "combination", broadly, with any old grease-cup;

or otherwise stated:

Respondent may not impose as a condition of sale of its assertedly Butler-improved couplers, that the purchasers shall not use the same in conjunction with old-style grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of the patent in suit which claims an improved coupler in so-called "combination" with an old-style grease-cup. Such condition of sale violates Section 3 of the Clayton Act:

#### Argument Point 4-b:

Under the principle of estoppel, purchasers of respondent's assertedly Butler-improved "Alemite Hydraulic" couplers are impliedly licensed to use the same with any old-style and unpatentable grease-cups including those of petitioner.

#### STATUTES.

The statute under which this case arises and which is necessary to be considered, is section 4886 of the Revised Statutes (U. S. C. Title 35, Sec. 31). That statute reads as follows:—

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to

have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 4888 of the Revised Statute (U. S. C. Title 35, Sec. 33) is also involved in the case, and is as follows:—

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonbly possible."

Section 3 of the Act of October 15, 1914, 38 Stat. L. 731, known as the Clayton Act, and also involved in the cause, is as follows:

"That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use, consumption, or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement, or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies, or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce."

#### ARGUMENT OF POINT I.

Petitioner's old-style (and unpatented) grease-cup or socalled "nipple" or "fitting"

cannot possibly constitute "contributory" infringement as charged, because

respondent's own commercial "Alemite Hydraulic" coupler (in conjoint use with which petitioner's unpatentable grease-cup or "nipple" is charged "contributorily" to infringe) is not in fact the Butler coupler because not "according to the drawing or specifications on which the claim in suit read", quoting from the Circuit Court of Appeals for Eighth Circuit in respondent's earlier suit against Jiffy Lubricator Co. (81 Fed 2d 786, 788).

One of the separate and distinct defenses of non-infringement in the case at bar is that respondent's commercial "Alemite Hydraulic" coupler is not, in fact, the Butler coupler. If that is true then non-infringement is conclusively established in the case at bar on that one ground alone, irrespective of the other defenses of non-infringement and invalidity covered by the other Argument of Points in this brief.

Thus, if plaintiff-respondent's own commercial "Alemite Hydraulic" coupler is **not** the coupler of the Butler claim, then the conjoint use therewith of defendant-petitioner's grease-cup or "nipple" can **not** constitute direct infringement. In the absence of such direct infringement, there can be no contributory infringement (Popular Mechanics v. Brown, 245 Fed 859, 860, CCA 7).

In the Jiffy case, the Circuit Court of Appeals for the Eighth Circuit held that plaintiff-respondent's "Alemite Hydraulic" coupler is not the coupler defined by the coupler part of the Butler claim-language for the reason that the coupler part of the claim-language requires that the nipple-engaging means (the three radially-movable locking jaws 40) be compressively actuated. The only means of "compression" disclosed, are Butler's resilient spring fingers 42, which do subject the radially-movable locking jaws 40 to spring-compression. Plaintiff-respondent's commercial "Alemite Hydraulic" couplers do not have any such spring fingers nor any other resilent or spring-like or "compressive" jaw-actuating means. Instead, the jaws of the "Alemite Hydraulic" coupler are actuated by an unyielding cam or wedge surface.

The Court of Appeals for the Eighth Circuit in respondent's suit against Jiffy Lubricator Co. (81 Fed 2d 786), affirming the trial court, correctly held that neither the Jiffy coupler, nor indeed respondent's own commercial "Alemite Hydraulic" coupler responded to the coupler-part of the Butler claim-language for the above-outlined reason.

The coupler parts of Butler claims 1 and 2 are indistinguishable in substance as shown by the parallel columns of the coupler-parts of Butler claims 1 and 2, on pages 28 to 30 of this brief and on the Summary Chart facing this page.

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PAGE

### CHART

Summarizing the conflict between the decision of the Circuit Court of Appeals in the case at bar and:

- 1) decision of Court of Appeals for the Eighth Circuit in Stewart-Warner vs Jiffy (81 Fed. 2d, 786) as to the scope of the coupler-part of the
- 2) decision of this Court in Rogers vs Alemite (298 U.S. 415) as to right of an alleged inventor of an improved coupler, to monopolize old an

"The combination with" ..... "The combination with" ..... "The combination with" &....

Center column contains the entire Butler Claim 2 in suit. The column directly to the left of the center contains the entire Butler Claim 1, adjudicated in the Jiffy case. The column directly to the right of the The apertured sealing seat (washer 51) of Butler's coupler, and which is element numbered 4 in the Butler claim analysis below, is the same as Gullborg's "perforated sealing dise" wi

> This Court held that the patentee can not monopolise the grease oup and old pump. ("Respondent says that as pin fittings made in accordance were sold by petiti

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The C C A 8 held that respondent's "Alemite Hydraulic" coupler (in conjoint use with which petitioner's accused grease-cup or so-called "nipple" is charged contributorily to infringe) is not "according to the drawing or specifications on which the claim in suit reads" (81 Fed. 2 789). The coupler part of both Butler claims is substantially the same.

14.1 1 4 (1) -1

The definition of devices "A" and "B" in the claims is merely a generic and all-inclusive reference to the entire class of each of the two devices.

#### BUTLER CLAIM 1.

Adjudicated by C C A 8 (81 Fed. 2 786). (Certiorari denied 299 U.S. 554.)

#### BUTLER CLAIM 2 IN SUIT.

Held invalid at 15 F. Supp. 410 on authority of 298 U. S. 415.

GULLBORG CLA Adjudicated at 298 U

- Device A-An old grease-cup or so-called lubricant-receiving. . . . "a nipple for receiving lubricant, of".... "a hollow coupling member bavis of"..... "a headed nipple for receiving lubricant, "nipple") ing from one side thereof pressed closure, of" (a
- An old pump or grease-dispensing "compressor") . . . "a lubricant compressor having".... "a pump", ..... having"..... "a lubricant compressor Device B-Butler's "lubricant compressor" also includes a discharge conduit. (Butler's "lubricant compressor" also includes a discharge conduit.) (Butler's "lubricant compressor" also includes a discharge conduit.) "a discharge conduit having on the outlet of said pump"
  - "a coupling member for connecting said com-... "a second coupling member (a coms coupling for connecting said compressor...... pressor and nipple" and nipple," "the coupling comprising" (coupler elements .... "comprising" (coupler elements 1 to 5 below) 1 to 5 below)
  - 1) "a cylinder" (parts 31 & 32 in Figure 2 con-.... 1) "a cylinder (parts 31 & 32 in Figure 2 constituting the body or housing of the stituting the body or housing of the

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of the Butler claim-language, and old grease-cups usable therewith.

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t of the center contains the entire Gullborg Claim 2, adjudicated by this Court in Rogers vs Alemite.

disc" which is element numbered 2 in the Gullborg claim analysis below.

ease-cup or so-called "fitting" or "nipple" intended for use with the improved coupler cordance with the prior art, but susceptible of use with a gun covered by the patent in suit. petitioners, these sales constituted contributory infringements of all the claims of the patent. of the opinion that the owner of patents . . . cannot extend the monopoly of the combination to prevent the use of a pin fitting . . . with a gun having a coupler such as that claimed in mit". 298 U.S., 424, 425).

is the contract of each of the two devices

RG CLAIM 2 THIS COURT'S DEFINITION OF THE at 298 U. S. 415. GULLBORG DEVICES. (298 U. S. 419.)

THE DEVICES. as referred to by this Court at 298. U. S. 419.

ber having a pin project.... "a type of pin fitting which was old in the art".... Device 1 thereof and a spring- (a grease-cup) ... " (a grease-cup)

gmos" grisneds to easily to easily for creating pressure, which was old".... Device 2

ving one end secured to.... "a hose to connect the two; and" Device 3 oump".

er (a coupler) for receiving. aid first named coupling d of the grease-cup or "nipple") upler is secured) to the other it and provided with" 1 to 4 below)

ted to co-act with said.

... orddra...) to the entire class of each of the two devices. cidens to inerely a generic and all-modusive refere The definition of devices "A" and "B" in oth Dutler chains is substantially the same. The Cot Figure 2 of drawings only. " Y learning live The Court of Appeals for the Eighth Circuit held that respondent's commercial "Alemite Hydraulic" coupler is not the coupler here defined, and that the coupler here defined was never produced or sold by respondent. (To recently trees Runnies posteriols out Contor Column Configure the gauge Dutae Chain

- stituting the body or housing of the coupler). a hippie for receiving moricant, 2) "a piston (43 & 45) movable within the cylin-... der, and having 3) "an aperture (48) for the discharge of lubri.... cant therethrough." "and" BOLLER OF ALL
- 4) "an apertured seat" (washer 51) "for engagement with the end of the nipple,".... combica for comform now many across beengto 5) "means (jaws 40) carried by the cylinder" "for compressively engaging 3 about the nipple" "for locking said parts together against longitudinal displacement and" "actuated by said piston". (43 & 45 + 42)(given its radial nipple-gripping motion by the radially
  - compressive action of the radially resilient springfingers 42 carried by the piston 43 & 45).
  - "whereby the pressure of the lubricant on said . . . . piston will move the piston to forcibly compress said means (jaws 40) while the lubricant is passing through said connecting parts."

- 1) "a cylinder" (parts 31 & 32 in Figure 2 con-... 1) "a cylinder (parts 31 & 32 in Figure 2 constituting the body or housing of the coupler).
  - 2) "a piston (43 and 45) movable within the cylinder, and having
  - 3) "an aperture (48) for the discharge of lubricant thereof"
  - 4) "an apertured sealing seat (washer 51) carried by said piston"
    - "for engagement with the end of the nipple," "connecting the piston aperture with a passage through the nipple,"
  - 5) "radially movable locking elements (jaws 40) carried by the cylinder coacting with the pay us ben strength was a second ternipple and a refer soul if a new instances one not themoboses pro species es
    - actuated by said piston" (given its radial nipple-gripping motion by the radially compressive action of the radially resilient springfingers 42 carried by the piston 43 & 45).
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    - "whereby the pressure of the lubricant on said piston 1 will move the piston 1 to forcibly compress 2 said means (jaws 40) while the lubricant is passing through said connecting parts."

- 1) "a bayonet slot adopted to or morrow coobject member prair
- 2) "a perforated sealing disk mou cate in the bore of said cour
- 3) "means for yieldingly urging against the closed end of coupling member (amin

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4) "means for limiting the movem ing disk in the direction coupling member."

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1) The piston (43 & 45 + 42) within the coupler.

2) By the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45.

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The Court of Appeals for the Eighth Circuit held that respondent's own "Alemite Hydraulic" coupler (in conjoint use with which petitioner's grease-cup or so-called "nipple" is charged contributorily to infringe) is not "according to the drawing or specifications on which the claim in suit reads" (81 Fed 2d 789). The coupler-language of both Butler claims is substantially the same.

To show what was before the Court of Appeals for the Eighth Circuit in the Jiffy case and what that Court decided, petitioner in the case at bar introduced in evidence (R. pp. 98, 99, 403) a drawing of respondent's own commercial coupler (or so-called "Alemite Hydraulic" coupler) referred to in the Opinion of the Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786). This Court also has available the entire record in the Jiffy case, as that record was filed in this Court by respondent with its own petition to this Court in the Jiffy case (No. 114, Oct. Term, 1935; certiorari denied 299 U. S. 554).

Respondent's commercial form of coupler (the so-called "Alemite Hydraulic' coupler) which the Court of Appeals for the Eighth Circuit in the Jiffy case held not to be the coupler of the Butler patent and to be outside the scope thereof, is identically the same as respondent's commercial "Alemite Hydraulic" coupler in the case at bar (in conjoint use with which the petitioner's accused grease-cup or "nipple" is charged "contributorily" to infringe).

Respondent's own "Alemite Hydraulic" coupler is also substantially identical with the exculpated Jiffy coupler. The Court of Appeals for the Eighth Circuit not only held the Jiffy coupler to be outside the scope of the Butler patent, but also clearly and expressly and necessarily excluded respondent's "Alemite Hydraulic" coupler from the scope

of the Butler patent. This exclusion of plaintiff-respondent's own "Alemite Hydraulic" coupler from the scope of the Butler patent follows both from the fact that it is substantially identical with Jiffy's accused and exculpated coupler, as well as from the Court's statements in its Opinion (81 Fed 2d 786).

The Court of Appeals for the Eighth Circuit was indeed compelled specifically to pass upon respondent's own so-called "Alemite Hydraulic" coupler for the reason that respondent represented the commercial success of its own "Alemite Hydraulic" coupler as one of the reasons why Butler Claim 1 should be given the broad interpretation necessary for respondent's success in that suit, and also because respondent urged upon the Court of Appeals for the Eighth Circuit that the coupler part of Butler Claim 1 should be given a broad enough interpretation to make the Jiffy coupler an infringement, for otherwise respondent's own "Alemite Hydraulic" coupler would of necessity be outside the scope of its own Butler patent. In Appendix I appended to this brief we have excerpted the pertinent portions from respondent's briefs addressed to the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786). These excerpts further show just what the respondent at bar did urge upon that Court as to the scope of the Butler patent.

The Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786) flatly denied respondent's contentions as to the scope of the Butler patent and clearly divested Butler of any vestige of inventorship with respect to respondent's own commercial "Alemite Hydraulic"

<sup>\*</sup>The substantial identity of the Jiffy coupler and the "Alemite Hydraulic" coupler was asserted and urged in the Jiffy case by respondent.

coupler (in conjoint use with which petitioner's old greasecup or "nipple" is charged "contributorily" to infringe in the case at bar). The Court of Appeals for the Eighth Circuit said:

"The plaintiff has not made or sold any coupler constructed according to the above drawing and specifications of its Butler patent, nor had it made or sold any couplers in which the pressure of the lubricant actuated the compression or gripping of the parts upon the bearing nipple until long after it had received examples of the defendants so-called Jiffy lubricator."

(81 Fed 2d 786, 788.)

"the plaintiff had not manufactured for sale any couplers according to the drawing or specifications on which the claim in suit reads"

(81 Fed 2d 786, 788.)

"The claim that Butler accomplished a new and useful result in the industry and therefore is entitled to broad protection (Smith v. Snow, 294 U. S. 1. 14, and cases there cited) is without merit. As was said in Dernell Potato Products Co. v. Snelling, (CCA 2) 38 Fed 2d 788, 789:

'The appellant's\* patent has not been put to commercial use, and, therefore, it is not entitled to a construction of any broader scope than it is clearly required to be given.''

(81 Fed 2d 786, 793.)

The Court of Appeals for the Seventh Circuit in the case at bar erroneously rejected the conclusion reached by the Court of Appeals for the Eighth Circuit with respect to the scope of the Butler patent and held, in conflict with the Eighth Circuit, that respondent's own commercial "Ale-

<sup>\*</sup>Respondent at bar.

mite Hydraulic" coupler did embody Butler's coupler invention.

In Appendix II appended to this brief, we have reproduced pages 49 to 54 inclusive of the court reporter's transcript of respondent's oral argument before the Circuit Court of Appeals for the Seventh Circuit in the case at bar (not reproduced in the record), wherein respondent's counsel, Mr. Williams, admitted to that Court (responsive to Judge Evans' pointed question) that in order for respondent to prevail in the case at bar it was necessary for that Court "to reach a different conclusion" from that reached by the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case with respect to the scope of the Butler patent.

Respondent's own commercial "Alemite Hydraulic" coupler is **not** in fact the coupler defined in the coupler part of the Butler claim-language, for the reason relied upon by the Court of Appeals for the Eighth Circuit, whose decision (81 Fed 2d 786) is in and of itself sufficiently clear and cogent to make it unnecessary for us to argue this point beyond reliance upon said decision (81 Fed 2d 786) and the authorities cited therein.

The Chart facing page 52 further serves to show the identity of the issues involved in the case at bar and in the Jiffy case with respect to the scope of the Butler patent and the conflict of opinion of the two Circuits (7th and 8th) with respect to the scope of the Butler patent.

We submit that the decision of the Court of Appeals for the Eighth Circuit as to the scope of the Butler patent is correct, and that the decision of the Court of Appeals for the Seventh Circuit in the case at bar with respect to the scope of the same patent is erroneous and should be reversed by this Court.

#### ARGUMENT OF POINT II.

A patentee may not monopolize what he did not contribute. Specifically a patentee may not re-monopolize an old-style grease-cup or so-called "nipple" or "fitting" on the basis of an asserted improvement in a hose-coupler usable therewith.

In patent cases, this Court has always looked through the verbiage of patent claims, and has determined what it was (if anything) that the patentee invented. This Court has always, in effect, asked the question: What did the patentee contribute? If the answer is "Nothing", then the patent cannot be valid, because the statutory requirement for the granting of a patent has not been met.

If the answer to the above question be, "He made a new coupler", then the patentee's monopoly is in a coupler, and in nothing else, since the statutory provision is that the monopoly shall be for limited times upon what the patentee has contributed, and not upon what someone else invented or upon what was already known.

### The Common Denominator of This Court's Decisions on Contributory Infringement.

The searching inquiry which this Court makes in every patent case does not stop at the mere words that are put together as a patent claim, and which often go far beyond the invention in their inclusiveness. This Court in every case, according to the facts and the law, penetrates through patent claim language, and decides upon what monopoly the patentee is entitled, according to what the patentee contributed.

Petitioner's position in this suit is in harmony with each of this Court's four leading decisions on contributory infringement. These decisions are:— Leeds & Catlin Company v. Victor Talking Machine Company, 213 U. S. 301 and 325;

Carbice Corporation of America v. American Patents Development Corporation, et al., 283 U. S. 27;

Leitch Manufacturing Company, Inc., v. The Barber Company, et al., 302 U.S.; and

Rogers, et al. v. Alemite Corporation, 298 U.S. 415.

The common denominator of this Court's four abovecited decisions is that where the defendant appropriated the thing which the patentee in reality contributed, then the defendant trespassed upon the patentee's rights; and where the defendant did not appropriate the thing which the patentee in reality contributed, then the defendant did not trespass upon the patentee's rights.

Thus, while the theory of contributory infringement may be applicable to prevent a defendant from appropriating the patentee's actual contribution to the art, as in the Leeds and Catlin case, it is entirely inapplicable to prevent a defendant from using things long old in the art as in the the Carbice, Leitch, and Rogers cases.

Thus, the theory of contributory infringement, as pointed out by this Court in the three cases last above mentioned cannot be used by a patentee to gain a monopoly of old materials, articles or devices.

In the patent in the Leeds & Catlin suit, the invention was distinguished by the phonograph disc record. At 213 U.S. 325, at 330, this Court said:

"It will be observed how important the record is to the invention embodied in the claims. It is the undulations in the side walls of the spiral groove which vibrate the stylus back and forth, transmitting the recorded sound waves to the diaphragm, at the same time propelling the stylus as it engages with the record. If

a comparison may be made between the importance of the elements, as high a degree (if not a higher degree) must be awarded to the disc with its lateral undulations as to the stylus. It is the disc that serves to distingush the invention,—to mark the advance upon the prior art."

And in 213 U.S. on page 335, the Court said:

"Indeed, as we have seen, it is the distinction of the invention, constituting, by its laterally undulating line of even depth and the effect thereof, the advance upon the prior art."

In Leeds & Catlin the defendant sought to appropriate Berliner's disc record which the Supreme Court said was new and marked "the advance upon the prior art."

On the other hand, in the case at bar, the defendant is not making any coupler complained of, but is making an old grease-cup or so-called "fitting" or "nipple" for use, inter alia, with plaintiff's old pump and allegedly Butler-improved coupler.

It will thus be seen that in Leeds & Catlin, Berliner had, inter alia, a disc-type phonograph record which in and of itself was new and theretofore unknown\* both per se and in its effect in the combination. Berliner claimed such new phonograph record in combination with the phonograph machine. Leeds & Catlon appropriated that part of the claimed combination constituted by such new phonograph record.

Thus, although Berliner's form of claim may or may not have been proper,† Berliner's assignee was permitted to reach the trespasser upon Berliner's new record.

+ Whether proper or improper, it was not necessary

there to decide.

<sup>\*</sup>That is, a disc record with a generally spiral groove of uniform depth having lateral "sound" undulations therein and capable of both vibrating the stylus of the sound reproducer on a phonograph and also capable of propelling that stylus across the face of the record.

In the Carbice case, 283 U. S. 27, the patentee had invented a container, and the Carbice Corporation was charged with contributory infringement because it sold its product with knowledge that it was to be used by the purchaser in transportation packages like those described in the patent. The defendant was not charged with making or selling packages but with making or selling solid carbon dioxide (dry ice). This Court said at page 29:

"The patent in suit is not for solid carbon dioxide. That article and its properties as a refrigerant have been long known to the public."

At pages 30 and 31:

At pages 30 and 31:

"The invention claimed is for a particular kind of package employing solid carbon dioxide in a new combination. If the patent is valid the owner can, of course, prohibit entirely the manufacture, sale, or use of such packages".

This Court therefore held that the defendant had not infringed, stating at page 33:

"The Dry Ice Corporation has no right to be free from competition in the sale of solid carbon dioxide. Control over the supply of such unpatented material is beyond the scope of the patentee's monopoly; and this limitation, inherent in the patent grant, is not dependent upon the peculiar function or character of the unpatented material or on he way in which it is used. Relief is denied because the Dry Ice Corporation is attempting, without sanction of law, to employ the patent to secure a limited monopoly of unpatented material used in applying the invention."

In the Leitch v. Barber case, 302 U.S., the patentee contributed a method of practicing road building, and the defendant, with knowledge of the use to which it was to be

put, supplied to the road builder, for the purpose of practicing the method, an unpatented material necessary to carry out the method. This Court said, at the last paragraph of the Leitch decision, in referring to the Carbice case:

"By the rule there declared every use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process. It applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly. Nothing in Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 325, limits it".

In the Rogers v. Alemite case, 298 U. S. 415, precisely as in the case at bar, defendant made only the generally-old, prior-art devices and not any device embodying that which constituted the real improvement (if any) of the patent in suit.

In the Hollingshead case, and in the Rogers case, defendant made an old prior-art grease pump and old bayonet coupler, for use with the Gullborg-improved grease-cups or so-called "fittings" or "nipples" sold by plaintiff, and when Hollingshead's and Rogers' grease pump and coupler were so used with plaintiff's grease-cup "fitting" or "nipple", the entire combination of Gullborg claims 14 and 15 was brought into being.

Similarly, in the Rogers' case, as also in the case at bar, defendant manufactured and sold a generally old priorart grease-cup or so-called "fitting" or "nipple" specifically dimensioned for use with an old pump and a new improved coupler, and when used, the entire combination of the allegedly infringed claims was brought into being.

In the Rogers case, these were claims 1-10, of the Gullborg patent.

This Court expressly said in the Hollingshead and Rogers cases that one inventing an improved coupler cannot monopolize the grease cups or so-called "fittings" or "nipples" which are to be used with it:

the patent owner "cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting " " with a gun having a coupler such as that claimed in the patent in suit." (298 U.S. 415, 425.)

From the above, it is clear just what this Court has done in all of these four cases. In every instance this Court has actually determined where the invention was, and has, on that basis, either held the defendant guilty or not guilty, depending on whether the defendant did or did not make the thing which constituted the patentee's contribution.

On the authority of this Court's decision in Rogers v. Alemite, we submit that Butler's invention (if any) is in the internal construction or mechanism of a coupler. Since the petitioner has not been accused of making or selling any couplers, the petitioner has not trespassed on the respondent's rights.

A patentee may not fe-monopolize an old-style grease-cup on the basis of an asserted improvement in a hosecoupler usable therewith.

Precisely this point was decided against this respondent in Rogers v. Alemite, 298 U. S. 415, 425, upon a state of facts as identical with the state of facts in the case at bar, as the state of facts could ever be alike in any two patent infringement suits based upon two different patents.

If anything, the facts in the case at bar are even less favorable to respondent's position than were the corresponding facts in its Rogers v. Alemite case.

Thus, in its earlier Rogers v. Alemite suit, the Gullborg coupler was not only found to be improved and patentable but was in reality manufactured and widely distributed by respondent.

In the case at bar, however, respondent has clearly not manufactured or sold any coupler in accordance with the Butler patent, as held by the Circuit Court of Appeals in respondent's earlier Jiffy suit (81 Fed 2d 786; certiorari denied 299 U. S. 554).

The facts in the case at bar are also less favorable to respondent than were the corresponding facts in the Rogers v. Alemite case, for the further reason that while in the Alemite case Gullborg's improved coupler was claimed to have done something new to the old-style (bayonet or "pinfitting" type) grease-cup there sought to be re-monopolized,

that is, ostensibly "sucking" the slight excess of grease off the end of the grease-cup upon the disunion of the coupler therefrom and so "cleansing" the grease-cup;—

there is not even the remotest suggestion in the case at bar that Butler's assertedly improved coupler does anything new to the old-style "headed" grease-cup or "nipple" sought to be re-monopolized in the case at bar.

Thus, while Butler's assertedly improved coupler may be asserted to grip or grap or seal better than the other multi-jawed "chuck" type couplers of the prior-art, there is not the remotest suggestion that anything new happens to the old style "headed" grease-cup or "nipple" when assertedly better grabbed or gripped or sealed by the Butler coupler.

Thus, the question in the case at bar, just as in Rogers v. Alemite (298 U. S. 415), is whether a patentee may remonopolize an old-style grease-cup, merely because he has allegedly invented an assertedly improved coupler usable therewith (in place of the coupler of the prior-art thereto-fore used with such old-style grease-cup).

Stating the question in a different way: whether an inventor of an improved and presumably patentable coupler can also have a monopoly on all the old-style headed greasecups, "fittings" or "nipples" with which his improved coupler is adapted to be used and must necessarily be used, even assuming that such assertedly improved coupler grips or grabs the old-style grease-cup better than it had theretofore been gripped or grabbed by the prior-art couplers, and even assuming that the patentee's improved coupler makes a better fluid-seal than did the prior-art hose-couplers.

This is indeed a fundamental question of patent law because if the patentee of an improved coupler can also have a monopoly of the old-style grease-cup, "fitting" or "nipple" with which his coupler would normally be used, then the same old grease-cup "fitting" or "nipple" can be re-monopolized for as many successive seventeen-year periods as there can be improvements in couplers.

Thus, for instance, the very "bayonet" type greasecup or so-called "pin-fitting" which this Court said could not be re-monopolized under claims 1, 2, 3, 4 and 8 of Gullborg patent No. 1,307,734 (298 U. S. 415), could then, under respondent's theory of the case at bar be re-monopolized under its much more recent Butler patent here in suit.

Thus, in the Jiffy case (81 Fed 2d 786) the old and heretofore much litigated (298 U. S. 415) "bayonet" type

grease-cup or so-called "pin-fitting" was indeed asserted by respondent to be the grease-cup or "nipple" element of its more recent Butler claim 1.

Thus, as Butler claim 1 does not call for a "headed" nipple but merely a "nipple for receiving lubricant", and as multi-jawed "chuck" type couplers can be and are also made with smooth-surfaced gripping jaws (as for instance, Jiffy's accused coupler) for gripping the smooth side-wall of the old and much litigated "bayonet" type grease-cup or so-called "pin-fitting", it would only be necessary under respondent's theory of the case at bar, that respondent should manufacture and widely distribute in the field a real Butler coupler of the diameter of the Jiffy coupler for use with the old and much litigated "bayonet" type grease-cup or so-called "pin-fitting". Thereafter, the competitive manufacture and sale by others of the old "bayonet" type grease-cups or so-called "pin-fittings"

either of the form of the now-expired Gullborg patents Nos. 1,307,733 and 1,307,734 (298 U. S. 415),

or of the still older form known prior thereto (and which this Court said respondent could not remonopolize under its Gullborg patent 1,307,734),

could again be charged to constitute "contributory" infringement of the Butler patent, under respondent's theory of the case at bar;—because such old "bayonet" type grease-cups or so-called "pin fittings" would then become the "nipple" of Butler claim 1, just as much as petitioner's herein-accused old-style headed grease-cup is allegedly the "nipple" of Butler claim 2 in the case at bar.

The trial court as well as the Court of Appeals for the Seventh Circuit in the case at bar confused two different kinds of "combinations", that is,  the combination of mechanical elements which compose or constitute, or go to make up the one device assertedly improved by the patentee, that is, the coupler,

#### and

2) the so-called "combination" between (or what in reality is, merely the conjoint use of) the patentee's assertedly improved coupler and the old-style grease-cup and old-style pump;—with which his assertedly improved hose-coupler must necessarily be used in order to have utility.

Thus, while Butler may have invented a novel combination of coupler-composing elements (constituting an improved coupler), he did not invent any "combination" of grease-cup, pump and coupler, because grease-cups, pumps and couplers had been used or "combined" with each other long before Butler in the same way that Butler "combined" them.

The Court of Appeals for the Seventh Circuit in the case at bar has erroneously failed to distinguish between the possible patentability of a new combination of coupler-composing elements on one hand, and the manifestly unpatentable old "combination" of grease-cup, pump and coupler, on the other hand;—the latter old combination not being rendered "new" merely by substituting an improved coupler for the old coupler.

The decision of both the trial court as well as the Court of Appeals for the Seventh Circuit in the case at bar is manifestly erroneous on the question of law here involved,

<sup>\*</sup>Just as did Gullborg in the Bassick-Alemite cases (296 U. S. 415).

as can be shown by the simplest and plainest application of the language of this Court's opinion in the Rogers v. Alemite case, to the precisely parallel facts of the case at bar.

The controlling effect of this Court's decision in Bassick v. Hollingshead and Rogers v. Alemite (298 U. S. 415, 424, 425) upon the questions at bar, is clear from the following quotation from page 425, wherein we have inserted parenthetically certain explanatory terms:

"It is plain that Gullborg (and likewise Butler)... invented an improved form of (grease-delivery) coupler to be attached to the end of the hose leading from the (old) pump to the (old) fitting (the grease-cup or 'nipple'). Instead of patenting this, ..., he claimed a combination of pump, hose-coupler, and pin-fitting, ('headed' instead of 'pin' in the case of Butler), and embodied in the combination his improved form of (grease-delivery) coupler."

#### This Court then further said:

"The question then is whether, by this method, the patentee, by improving one element (or one device, as for instance, the hose-coupler) of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element (his improved coupler device) substituted for the old element (the old prior-art coupler). That this cannot be done is shown by numerous cases in this and in other federal courts".

#### This Court then further went on to say:

"We are of the opinion that the owner of the patents... cannot extend the monopoly of the combination patent in suit to prevent the use of a (old) pin-fitting (headed fitting or 'nipple' in the case of Butler) which

does not infringe the fitting patent, 1,307,733 (that is, a pin-fitting or grease-cup or 'nipple' of the prior art) with a gun (or pump) having a (grease-delivery) coupler such as that claimed in the patent in suit."

Thus, to paraphrase the above-quoted language of this Court in the Rogers v. Alemite case, to apply it to the case at bar, it is merely necessary to substitute the name "Butler" instead of the name "Gullborg", and to change the word "pin" to the word "headed".

The above quoted decision of this Court in the Rogers v. Alemite case was properly deemed absolutely controlling by the District Court for the Western District of Pennsylvania in respondent's two suits against the same Rogers and against the Universal Lubricating Systems Inc. and others, in which suits the decision is reported at 15 F. Supp. 410. The District Court said in its Findings of Fact (not published):—

"11. The alleged novelty and improvement, if any, of each of the patents in suit is in the mechanism or construction or structural characteristics of the particular coupler or nozzle disclosed in each patent.

"12. The construction and operation of the old combination or system of: (a) nipple; (b) pump; (c) coupler or nozzle is not changed by the allegedly novel or coupler improvement of the respective patents in suit.

The absolute parallelism between the facts of the case at bar and the facts involved in Rogers v. Alemite (298 U.S. 415) can best be shown from the following comparative columns:—

Butler made an alleged improvement in the internal construction or mechanism of an otherwise old "chuck" type (multi-jawed) coupler for making perhaps a better "chuck-coupled" connection between

- 1) the old "headed" type grease-cup or "nipple" or "fitting" of the prior art and
- 2) the old grease pump, compressor, or "grease-gun" of the prior art.

Butler (in his claims) claims his specific and allegedly improved "chuck" type coupler in so-called "combination" with

the old "headed" type grease-cup or "nipple" or "fitting" of the prior art

and

the *old* pump or compressor of the prior art.

### In the Rogers vs Alemite Case:

Gullborg made an improvement in the internal construction or mechanism of an otherwise old "bayonet" type-coupler for making perhaps a better "bayonet-coupled" connection between

- 1) the old "bayonet" type grease-cup or "nipple" or "fitting" of the prior art and
- 2) the old grease pump, compressor, or "grease-gun" of the prior art.

Gullborg claimed his specific and allegedly improved "bayonet" type coupler (in claims 1, 2, 3, 4, & 8 in issue) in so-called "combination" with

the old "bayonet" type grease-cup or "nipple" or "fitting" of the prior art

and.

the old pump or compressor of the prior art.

Respondent, under its later Butler patent here in suit, charges contributory infringement, by reason of defendant-petitioner's sale of old and unpatented "headed"-type grease-cups, "fittings" or "nipples" of the prior art, merely because such old grease-cups were adapted and intended for use, inter alia, with the allegedly. Butler-improved "chuck" type couplers manufactured and sold by plaintiff-respondent.

In the case at bar plaintiffrespondent charges no infringement of Butler claim 2
by defendant-petitioner's
manufacture or sale of any
couplers (or pumps), even
though the asserted novelty
of the Butler claim is predicated solely upon the particular internal construction
of the coupler;—the only
one of the several separate

### In the Rogers vs Alemite Case:

Respondent. under its earlier Gullborg patent. charged contributory infringement, by reason of defendant - petitioner's manufacture and sale of old and unpatented bayonet -t y p.e grease-cups, "fittings" or "nipples" of the prior art. merely because such old grease-cups were adapted and intended for use, inter alia, with the Gullborg-improved bayonet-type couplers manufactured and sold by plaintiff-respondent.

In the Rogers vs Alemite case respondent charged no infringement of Gullborg claims 1, 2, 3, 4, & 8, by petitioner's manufacture or sale of any couplers (or pumps), even though the asserted novelty of these claims was predicated solely upon the particular internal construction of the coupler;—the only one of the several separate and

<sup>\*</sup> See explanation on page immediately following these parallel columns.

and distinct devices included in the Butler claim which is specifically defined therein in terms to distinguish it from the corresponding prior-art device.

The sole charge of infringement in the case at bar is levelled at defendantpetitioner's old and unpatented grease-cup or sodalled "fitting" or "nipple", which is one of the several separate and distinct devices included in however, any specific definition thereof in this claim;the grease-cup or "nipple" being defined in the claim merely in broad and allinclusive terms not distinguishing from the greasecups or "nipples" of the prior art.

Plaintiff-respondent's (levelled at defendant-petitioner's old and unpatented grease-cup), in the case at bar, is that when one of In the Rogers vs Alemite Case:

distinct devices included in these Gullborg claims which was specifically defined therein in terms to distinguish it from the corresponding prior-art device.

One of the two charges of infringement in Rogers vs Alemite, was levelled at petitioner's old and unpatented grease-cup or so-called "nipple" or "fitting", which was one of the several separate and distinct devices included in Gullborg Bulter claim 2, without, claims 1, 2, 3, 4, & 8, without, however, any specific definition thereof in these claims; the grease-cup or "nipple," being defined in the claims merely in broad and all-inclusive terms not distinguishing from the grease-cups or "nipples" of the prior art.

Plaintiff-respondent's theory of infringement theory of infringement (levelled at defendant-petitioner's old and unpatented grease-cup), in the Rogers vs Alemite case was that

plaintiff-respondent's own allegedly Butler-improved couplers (and an old pump) is applied momentarily to defendant-petitioner's old grease-cups at some automobile service station where the owner of the automobile equipped with these defendant-petitioner's accused grease-cups would take it for occasional "greasing" then, during each momentray application of one of plaintiff's - respondent's allegedly\* Butler - improved couplers (and an old pump), the entire assemblage of the several distinct devices defined in Butler claim 2 comes into being, and that the old grease-cup in such momentary assemblage is a device not made or sold by respondent, but indeed, made and sold by petitioner. This, according to respondent's theory of the case, constitutes contributory infringe-

In the Rogers vs Alemite Case:

when one of respondent's o w n Gullborg-improved couplers (and an old pump) were applied momentarily to defendant - petitioner's old grease-cups at some automobile service station where the owner of the automobile equipped with these defendant-petitioner's accused grease-cups would take it for occasional "greasing", then, during each momentary application of one of plaintiff - respondent's Gullborg-improved couplers (and an old pump), the entire assemblage of the several distinct devices defined in Gullborg claims 1, 2,3, 4, & 8 would come into being. and that the old grease-cup in such assemblage would be a device not made or sold by respondent, but indeed. made and sold by petitioner. This, according to respondent's theory of the case, constituted contributory in-

<sup>\*</sup> See explanation immediately following these parallel columns.

ment on the part of petitioner;—the direct infringement taking place the few moment is respondent's allegedly\* Butler-improved coupler is connected onto the grease-cup during the automobile's occasional visit at a grease-service station.

### In the Rogers vs Alemite Case:

fringement on the part of petitioner;—the direct infringement taking place the few moments respondent's Gullborg-improved coupler is connected onto the grease-cup during the automobile's occasional visit at a grease-service station.

The only difference between the case at bar and the Rogers v. Alemite case is that while the Gullborg coupler improvement was in reality embodied by plaintiff in its commercial coupler device which it at once sold in substantial quantities, the couplers made by respondent allegedly embodying the Butler coupler improvement, are in fact not even made in accordance with the Butler patent and do not embody the Butler coupler improvement. This difference does not help respondent's position in the case at bar, but on the contrary, further detracts from it.

Respondent strenuously but unsuccessfully urged before the Court of Appeals for the 8th Circuit, in Stewart-Warner v. Jiffy (81 Fed 2d 786), that its commercial couplers, marketed under the trade designation of "Alemite Hydraulic" couplers, were in accordance with the Butler patent and within the scope of the claim thereof. The Court of Appeals for the 8th Circuit, however, in Stewart-Warner v. Jiffy (certiorari denied, 299 U. S. 554), held that respondent's own allegedly Butler-improved couplers were not

<sup>\*</sup> See explanation immediately following these parallel columns.

Butler improved at all, as they were not in accordance with the Butler patent here in suit and were not within the scope of the claim thereof. The decision of the Court of Appeals for the 7th Circuit in the case at bar is therefore in direct conflict with the correct decision of the Court of Appeals for the 8th Circuit in the case of Stewart-Warner v. Jiffy (certiorari denied, 299 U. S. 554), as to the scope of the coupler-part of the Butler patent here in suit.

The Court of Appeals for the Seventh Circuit in its decision in the case at bar (91 Fed 2d 757) recognized the applicability of this Court's earlier decision in the Rogers v. Alemite case to the case at bar with respect to the first of the three grounds of appeal there presented to that Court by petitioner. Thus, the Court of Appeals for the Seventh Circuit in its opinion in the case at bar said (at p. 760):

- "Appellant challenges the decree on three separate, distinct grounds, stating each with commendable frankness, brevity, and clarity:
- "(1) Butler's hose coupler can not be validly claimed in combination with a non-patented lubricant receiving nipple or an old compressor, particularly where his conceded purpose is not merely to monopolize the hose coupler, but to include in the monopoly the admittedly old device which is used with it. To support this position appellant relies upon Bassick Manufacturing Co. v. Hollingshead Co. and Rogers v. Alemite Corp., 298 U. S. 415.
- "(2) The coupler of the Butler patent shown in Figure 2 is not the so-called "Alemite Hydraulic" coupler. Supporting this position, appellant relies upon the facts brought out by the evidence and the holding in Stewart-Warner v. Jiffy Lubricating Co., 81 Fed 2d 786.

"(3) The Butler multi-jaw chuck type hose coupler is not a patentable improvement over the multitype hose coupler of the prior art. As bearing upon this issue, it contends that the evidence does not support the finding of validity because the Butler hose coupler as described by Butler both in Figure 2 and in his claim never went into commercial use. It likewise argues that extensive use where the trade was so dominated by Stewart-Warner is not persuasive of validity.

"The importance of the suit and the effect of the Bassick opinion upon the whole field of patent law make it impossible for us to dispose of the case in an opinion of desirable and satisfactory brevity.

"While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that Bassick v. Hollingshead, supra, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. This revolutionary concept was accepted and applied by the District Court (in Pennsylvania) in Stewart-Warner v. Universal Co., 15 F. Supp. 410.

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick v. Hollingshead opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

"The novel proposition which appellant seeks to apply to the present case is to be found in the language on pages 424, 425. There it was said:

" 'It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hosecoupler and a grease cup or pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hosecoupler, and pin fitting, and embodied in the combination his improved form of coupler. 1,307,734, the patent in suit; claims 1-6, 8 and 10.) He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. (Claims 14 and 15.) The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts,' "

What the Court of Appeals for the Seventh Circuit in the case at bar has erroneously characterized as "the novel proposition" is seemingly that part of this Court's opinion in the Rogers v. Alemite case which the Court of Appeals for the Seventh Circuit emphasized by italics in quoting from this Court's opinion as last above shown;—that emphasis having been supplied by the Court of Appeals in its own quotation from this Court's opinion.

At the outset, respondent admitted in its brief addressed to the Court of Appeals for the Seventh Circuit

<sup>\*</sup>Emphasis by the Circuit Court of Appeals.

in the case at bar, that if the first issue presented to that Court by defendant-petitioner was correctly stated, that then "there can be only one answer,—the answer which defendant wants".

Thus, the first issue presented by us to the Court of Appeals for the Seventh Circuit in the case at bar was:

"Can an improvement in a hose coupler be the basis for a valid monopoly on an old headed nipple or an old compressor which is to be used with it?"

The Circuit Court of Appeals conceded the correctness of petitioner's statement of said first issue, which, even according to respondent, could be answered only favorably to petitioner. Notwithstanding this, however, the Circuit Court of Appeals answered said issue unfavorably to petitioner.

Petitioner respectfully submits that this Court's opinion in the Bassick v. Hollingshead and Rogers v. Alemite, 298 U. S. 415, is correct and controlling on this point of law at bar.

Thus,

while respondent has conceded on page 3 of its main brief addressed to the Court of Appeals for the Seventh Circuit in the case at bar that on the first issue there presented (here argument point No. 2) "there can be only one answer,—the answer which defendant (petitioner) wants", and

while the Court of Appeals for the Seventh Circuit could find no fault with our statement of issue No. 1 there presented by us (present argument point No. 2) but instead commended us for the frankness, brevity and clarity of our statement of the issue,

the Court of Appeals for the Seventh Circuit neverthless decided against petitioner and contrary to and in conflict with this Court's recent ruling and decision on a precisely parallel factual situation and the same question of law (298 U. S. 415).

We respectfully submit that the decision of the Court of Appeals for the Seventh Circuit in the case at bar on this second point is manifestly erroneous and in conflict with the decision of this Court in the Rogers v. Alemite case and other decision of this and other Federal Courts and should be reversed by this Court.

#### ARGUMENT OF POINT III.

Butler claim in suit invalid as drawn to (or because claiming) an old and exhausted combination of grease-cup, pump and coupler;—whereas patentee's improvement, if any, is merely in the assertedly improved coupler.

The Court of Appeals for the Seventh Circuit in the case at bar has erroneously held, in effect, that one who invents an improvement in **one** device normally useful in conjunction (or in an old combination) with **other** devices of the prior-art, need not content himself with merely claiming his assertedly improved device, per se, but may validly claim his improved device in the old combination where it is normally to be used.

The aforesaid decision of the Court of Appeals for the Seventh Circuit in the case at bar is clearly in conflict with the applicable decisions of this Court and other appellate courts, as shown by the following decisions:—

Heald v. Rice, 104 U. S. 737, 755; Underwood v. Gerber, 149 U. S. 224, 227; General Electric Co. v. Ohio Brass Co., 277 Fed 917 (C. C. A. 3);

Langen v. Warren Axe & Tool Co., 184 Fed 720 (C. C. A. 3);

In re Ratican, 36 App. D. C. 95;

In re Germantown Trust Co., 57 Fed 2d 365 (U.S. Ct. of Customs & Patent Appeals);

Kodell Electric v. Warren Telechron, 62 Fed 2d 692 (C. C. A. 6);

Alemite Corp. v. Lubrair Corp., 62 Fed 2d 899 (C. C. A. 1);

Rogers v. Alemite Bassick v. Hollingshead 298 U. S. 415.

The first four of the above cited cases were cited by this Court in its recent decision in Rogers v. Alemite and Bassick v.-Hollingshead (298 U. S. 415).

Section 4888 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 33) not only requires the applicant for a patent to make a full and clear disclosure of his alleged invention, but also further requires that "he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

It is because of this statutory requirement that each patent contains (or that the specification of each patent concludes with) one or more claims.

However prolix the patentee may have been in describing his invention in the specification of his patent, he should, at least in his claims, clearly delineate between that which he really invented and that which he did not invent (or that which was in the public demain).

Thus, however loosely a patentee may describe his invention in relation to the prior-art to which it relates, nevertheless in the claim or claims of his patent, he must not commingle that which he invented, with that which is in the public domain. Otherwise, the statutory requirement for claims is completely vitiated. Unless this statutory requirement is complied with, the public has no possible way of knowing where the patentee's contribution begins and where it ends.

In the case at bar, just as in the case of Gullborg claims 1, 2, 3, 4 and 8, adjudicated by this Court (at 298 U. S. 415), the patentee's contribution, if any, was in an assertedly improved coupler. That is where the patentee's contribution ends, however. There was no further invention involved in the mere idea of using the assertedly improved coupler in a way that couplers had always been used, that is, in conjunction with the other two old devices (grease-cup and pump) requiring to be coupled, or needing a coupler.

Respondent's misconceived theory of patent-claiming in the case at bar, is merely that if the coupler is new, then, as a matter of form, the coupler plus old grease-cup plus old pump is also "new".

Precisely that was the situation in the case of Gullborg claims 1, 2, 3, 4 and 8 involved in Rogers v. Alemite (298 U. S. 415).

Gullborg even went so far in some of the claims as to include, as an element of the claimed "combination", the machinery such as the automobile requiring to be lubricated. Thus, for instance, Gullborg claim 8 adjudicated by this Court not only included in the so-called "combination"

<sup>•</sup>In the descriptive portion of his specification.

(with the assertedly improved coupler) the admittedly old pump, hose and grease-cup, but also included the "apparatus having a part to be lubricated"—this last phrase generically defining (in the *claim*) the automobile or other machine to which the grease-cup may be attached.

Thus, according to respondent's misconceived theory of patent-claiming, anyone inventing a better or improved coupler may claim in so-called "combination" therewith, the old pump and old grease-cup;—merely because the old pump and old grease-cup are to constitute the environment in which the improved coupler is to be used. It is respondent's theory therefore that if the coupler is new, then naturally the combination with it of an old pump and old grease-cup must, as a matter of course, also be new.

The fallacy of this theory of patent-claiming has been exposed many times in the decisions hereinabove cited on pages 78-9. The fallacy of this theory of patent claiming will further be apparent when it is recognized that by far the largest bulk of all mechanical devices now in common use (both old and new) are not useful alone, but only when used in conjunction (or in so-called "combination") with other devices.

Thus, an improved bottle-cap-opener is not useful by itself but only when used in conjunction (or in so-called "combination") with an old bottle and an old bottle-cap. It will be conceded that there is co-action and cooperation between the bottle-cap-opener, on one hand, and the bottle-cap and bottle, on the other hand;—indeed they all work together when the bottle-cap-opener is in actual operation. It will also be conceded that an improved bottle-cap-opener may grip or grab the bottle-cap better than some other unimproved bottle-cap-opener.

Likewise, an improved lamp-socket undoubtedly cooperates and co-acts with the old electric bulb which it is adapted to receive, and may indeed hold the electric bulb better and make better electrical contact with it than some other unimproved electric socket.

Likewise, an improved quick-detachable and quick-attachable coupler for connecting the old fire-engine to the old fire-hydrant at the street curb or with the old stand-pipe (on the side of the skyscraper) co-acts with and co-operates with the fire-engine and the fire-hydrant, and may indeed make a much better coupling between the old fire-engine and the old fire-hydrant than that made by some other unimproved coupler.

So, whenever any single device is improved, can it be said that the patentee also invented the "combination" therewith of the old devices with which it is to be used? Obviously not.

As pointed out by this Court in Heald v. Rice (104 U. S. 737, 755), the inventor of an assertedly improved returnflue boiler for use with an old straw-feeding device, did not invent a new combination of boiler plus straw-feeding device. He merely invented a new return-flue boiler (if anything). The claim on the so-called "combination" of boiler and straw-feeding device was therefore held invalid.

Likewise, an improved coating composition may constitute a patentable improvement. As pointed out however by this Court in Underwood v. Gerber (149 U. S. 224, 227), there is no further invention involved in the idea of coating the improved coating composition onto a sheet of paper, as coating compositions had always been combined with paper.

Or, as pointed out by the Court of Appeals for the Third Circuit in General Electric v. Ohio Brass (277 Fed

917), while there may be patentable invention in an improved electrical insulator, there is no invention in the idea of combining the improved insulator with the old poles and cross arms and electrical wires with which other old and unimproved insulators had customarily been used.

So in the case at bar, there was no patentable or inventive concept involved in putting an assertedly improved coupler to use in conjunction with the old grease-cup and old pump;—irrespective of whether the coupler itself may be an improved and patentable coupler.

For this reason, the Butler claim is invalid as drawn to an old and exhausted combination of grease-cup, pump and coupler, whereas Butler's invention, if any, was merely in the internal construction or mechanism of the coupler (that is, the combination of coupler-composing elements).

The Butler claim in suit therefore violates Section 4888 of the Revised Statutes, 35 U. S. Code 33, in that the patentee has commingled in his claim that which at best was his contribution and that which was clearly and most obviously within the public domain (the old grease-cup and old pump). The decision of the Circuit Court of Appeals in the case at bar should therefore be reversed by this Court.

#### ARGUMENT OF POINT IV.

#### Point IV-a:

Section 3 of the Clayton Act prohibits the monopoly herein asserted by respondent and erroneously sustained by the Court of Appeals.

Respondent may NOT restrict the proper and only possible use of the assertedly Butler-improved couplers of its own manufacture, to the use of such couplers solely with grease-cups of its own manufacture and to the exclusion of grease-cups manufactured and sold by petitioner;—not-

withstanding respondent's ownership of a patent assertedly covering its coupler in so-called "combination", broadly, with any old grease-cup,

#### or, otherwise stated:

Respondent may NOT impose as a condition of sale of its assertedly Butler-improved couplers, that the purchasers shall not use the same in conjunction with old-style grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of the patent in suit which claims an improved coupler in so-called combination with an old-style grease-cup. Such condition of sale is violative of Section 3 of the Clayton Act.

#### Point IV-b:

Under the principle of estoppel, purchasers of respondent's assertedly Butler-improved "Alemite Hydraulic" couplers are impliedly licensed to use the same with any old and unpatented grease-cups including those of petitioner.

While the courts have from time to time approached the problem of improper "combination" claims through several different avenues of approach, the result has always been the same, to wit, the denial of the patent owner's asserted monopoly of old and unpatentable devices.

In foregoing Argument of Point II, we have pointed out this Court's treatment of precisely the same problem in the case of Rogers v. Alemite (298 U. S. 415).

In Rogers v. Alemite, where the defendant-petitioner had conceded the validity of the patent in the trial court, this Court solved the problem of improper "combination" claims upon the broad proposition that a patentee could

In reliance upon the broader defense rejected by both lower courts in that case but sustained by this Court at 298 U.S. 415.

not re-patent the old combination of grease-cup, pump and coupler (regardless of the presence of some asserted improvement in the coupler), and could not so re-monopolize the old grease-cup.

In support of its decision, this Court cited a number of earlier decisions of its own and also other Federal Courts. The decisions cited by this Court in support of its decision in Rogers v. Alemite may be classified into three groups according to the manner in which the Court approached and solved the problem of improper "combination" claims involved in the particular case.

Thus, some of the authorities cited by this Court in its opinion in Rogers v. Alemite hold that such improper "combination" claims are invalid as drawn to an old and exhausted combination, whereas the asserted improvement, if any, is merely in the construction of one of the elements:

> Heald v. Rice, 104, U. S. 737, 755; Underwood v. Gerber, 149 U. S. 224, 227; Langen v. Warren Axe & Tool Co., 184 Fed 720; Troy Wagon v. Ohio Trailer, 274 Fed 612; General Electric v. Ohio Brass, 277 Fed 917 (C. C. A. 3);

> Wall Pump Co. v. Gardner, 28 Fed 2d 334, 338 (C. C. A. 7).

The general point of law upon which the last abovecited decisions rest, constitutes our Argument of Point III; wherein we have relied upon these decisions and others covering the same point of law, to the effect that when one invents the asserted improvement in one device he may claim the combination of elements constituting that one device, but may not claim the so-called "combination" of that one (assertedly improved) device with other old devices with which it is normally used.

The following authorities cited by this Court in its opinion in Rogers v. Alemite, 298 U. S. 415, hold that so-called "combination" claims which claim an assertedly improved device in so-called "combination" with one or more old devices (with which the improved device must be used) cannot be asserted either through a patent infringement suit or through patent license contracts (with licensees under the patent) to prevent or restrict the use of the old and unpatented devices manufactured by others:

Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 431, 432;

Carbice v. American Patents Corp., 283 U. S. 27, 31, 32;

Wagner v. Webster, 144 Fed 405, 409;

Harvey-Hubbell v. General Electric, 267 Fed. 564; Radio Corp. v. Lord, 28 Fed 2d 257.

On the other hand, the case of Edison Electric Light Co. v. Peninsular Light Co., 101 Fed. 831 (C. C. A. 6) cited by this Court in its opinion in Rogers v. Alemite, solves the problem of so-called "combination" claims by holding that the purchaser of the inventive device (from the patentee), has an implied license to use with it the old and uninventive devices purchased from others;—notwithstanding the fact that such old and uninventive devices are included generically in the patent claim

The last two groups of authorities, and others on the same points of law are relied upon as authorities for Argument of Point IV, parts a and b respectively.

Whether the controversy arises as a patent infringement suit, as in the cases of

Morgan Envelope v. Albany Paper, 152 U. S. 425, 431, 432;

Carbice v. American Patents Development Corp., 283 U. S. 27;

Wagner v. Webster, 144 Fed 405, 409;

Harvey-Hubbell v. General Electric, 267 Fed 564;

or whether it arises under a patent contract as in the cases of

United Shoe Mach. Corp. v. U. S., 258 U. S. 451; Radio Corp. v. Lord, 28 Fed 2d 257 (C. C. A. 3); (Certiorari denied, 278 U. S. 648);

International Business Machines Corp. v. U. S., 298 U. S. 131;

the courts have uniformly held that competitive sale of the old and unpatented devices or articles of commerce which may be generically included in the claims of a patent (in conjunction with some other device presumably invented by the patentee) may not be prohibited or restricted or in any way curtailed.

The courts have so held regardless of whether the prohibition, restriction or curtailment was attempted to be worked through the assertion of the patent against such competitive old devices under the theory of "contributory" infringement, as in the first group of cases last above cited, or whether such prohibition, restriction or curtailment was attempted to be worked through a license contract or other contract with licensees or users under the patent in question, as in the second group of cases last above cited.

Thus, there is no conflict whatever between the patent laws and the anti-trust laws. On the contrary, the patent laws were not intended to grant monopolies on old and unpatented devices or articles of commerce, and the anti-trust laws expressly prohibit such monopolies. In the case at bar, the Court of Appeals for the Seventh Circuit has erroneously sustained respondent's asserted monopoly of admittedly old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings." Such monopoly was not contemplated by the patent laws and is expressly prohibited by the anti-trust of the United States. Therefore, for this further reason, the decision for the Circuit Court of Appeals for the Seventh Circuit in the case at bar should be reversed by this Court.

The problem of improper "combination" claims was dealt with in the following cases under the principle of implied license by estoppel:

Edison Electric Light Co. v. Peninsular Light, Power & Heat Co., 101 Fed. 831 (C. C. A. 6); Thomson-Houston Electric Co. v. Illinois Telephone Construction Co., 152 Fed 631 (C. C. A. 7).

Thus, in these cases, the Court, in an effort to save the patentee from the consequences of the improper form of his patent claims, held that the defendant had an implied license to manufacture and sell and use the old and unpatentable devices of the prior-art, which were generically included in the patent claim. This was on the theory that when the patentee sold the inventive devices without restriction or limitation, he impliedly granted to the purchaser of such inventive device the license to use the same with the old and unpatentable devices of the prior art with which it had to be used in order to have utility.

Thus, in the case at bar, respondent sold its assertedly Butler-improved couplers and the old pumps without restriction or limitation, and the purchasers of such assertedly Butler-improved couplers and old pumps (of respondent's manufacture) necessarily have the implied license to use such devices in the only way they were intended to be used and the only way in which they could be used; that is, in conjunction with the old and unpatentable "headed" greasecups or so-called "nipples" or "fittings." The purchasers from respondent (of its assertedly Butler-improved couplers and old pumps) having such an implied license, it necessarily follows that any member of the public, including petitioner, has a right to supply such old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings" for use with the assertedly Butler-improved couplers and old pumps purchased from respondent.

The decision of the Court of Appeals for the Seventh Circuit is therefore clearly erroneous and in conflict with this last cited line of authorities and should for that reason also, be reversed by this Court.

#### CONCLUSION.

In conclusion, it is respectfully submitted that the decision and judgment of the Court of Appeals for the Seventh Circuit should be reversed by this Court, for the reason that said decision and judgment of the Circuit Court of Appeals for the Seventh Circuit

- is in direct conflict with the correct decision of the Circuit Court of Appeals for the Eighth Circuit as to the scope of the coupler-part of the same patent (Stewart-Warner v. Jiffy, 81 Fed 2d 786, certiorari denied 299 U. S. 554);
  - is in direct conflict with the correct decision of this Court in the case of Rogers v. Alemite, 298 U. S. 415, as to another patent just like the patent here in suit and presenting precisely parallel facts and the same legal situation;

- is in direct conflict with the correct decision of the United States District Court for the Western District of Pennsylvania, for the defendants, in a suit on the same patent as in the case at bar, on the authority of this Court's decision in said Rogers v. Alemite case (Stewart-Warner v. Rogers & Universal, 15 F. Supp. 410);
- is in direct conflict with the earlier correct decisions of this and other Federal Courts on the point of law that a claim drawn to an old and exhausted combination of several separate and distinct devices (customarily used with each other) is invalid where the patentee's improvement is merely in the construction or mechanism of one of the several devices;
- is in direct conflict with the earlier correct decisions of this and other Federal Courts on the point of law that the patent owner who has manufactured and sold an assertedly improved and patentable device (a coupler) may not prohibit or restrict the use thereof by reason of his ownership of a patent covering his improved device (coupler) in so-called "combination" with other old and unpatentable devices or articles of commerce with which it is normally to be used; or otherwise stated, the owner of a patent on a so-called "combination" of several separate and distinct devices or articles of commerce may not impose, as a condition of the sale of his assertedly improved device, that the same shall not be used in conjunction with the other old devices of a competitor;
- is in direct conflict with the earlier correct decisions of another Circuit Court of Appeals (and also the

earlier decision of the same Circuit Court of Appeals) on the point of law that when the patentee sells his assertedly improved device without restriction, the purchaser acquires an implied license to use it with the other old and unpatentable devices with which it normally must be used in order to have utility, and under such implied license, any member of the public has a right to supply such old and unpatentable device or article of commerce.

Respectfully submitted,

LINCOLN ENGINEERING CO. OF ILLINOIS,

Petitioner,

By Leonard L. Kalish,
Delos G. Haynes,
Lloyd R. Koenig,
Counsel for Petitioner.

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#### APPENDIX I.

The following excerpts from plaintiff-respondent's briefs addressed to the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786) further show just what respondent did urge upon and admit to that Court as to the scope of the Butler patent. (emphasis supplied.)

#### Respondent urged in its Jiffy suit

(on page 3 of its main brief in CCA 8):-

"Lubricating equipment manufactured by the present plaintiff, Stewart-Warner Corporation, and first manufactured by its subsidiary, Alemite Corporation, and marketed under the name 'Alemite Hydraulic Type Lubricating Equipment,' immediately upon its commercial introduction displaced all other types of lubricating equipment on automobiles. This Alemite hydraulic type of equipment embodies the invention of this Butler patent. The language of claim 1 describes it with literal fidelity."

#### Respondent urged in its Jiffy suit

(on page 5 of its main brief in CCA 8):-

"The tremendous success of the plaintiff's Alemite hydraulic type of lubricating equipment is emphasized by the sales figures of Plaintiff's Exhibit No. 8, Rec. 345. These figures show that in the single year of 1934 the sales of plaintiff's hydraulic type of equipment amounted to two and one-quarter million dollars. The tremendous commercial success of this hydraulic type of equipment is due solely to the advantages resulting from Butler's invention."

#### Respondent urged in its Jiffy suit

(on page 6 of its main briefin CCA 8): -

"The plaintiff's hydraulic type of equipment is protected by this Butler patent only if claim 1 be given its

natural and literal meaning. The Alemite hydraulic equipment responds to the literal wording of claim 1 of Butler (Rec., 98-99), but this hydraulic equipment does not have spring fingers and is not protected by this claim with the additional limitation read into it by the District Court."

#### Respondent urged in its Jiffy suit

(on page 11 of its main brief in CCA 8):-

"This variation of Butler's Figure 2 has been adopted by **both** the plaintiff's Alemite hydraulic type of coupler and the defendant's Jiffy coupler."

#### Respondent urged in its Jiffy suit

(on page 12 of its main brief in CCA 8):-

"Claim 1 of the Butler patent reads on this Alemite hydraulic type of equipment just as clearly as it does on the disclosure of the Butler patent."

#### Respondent urged in its Jiffy suit

(on page 14 of its main brief in CCA 8):-

"The Commercial Success of the Alemite Hydraulic Type of Equipment Embodying the Invention of the Butler Patent Was Due to the Advantages Inherent in Butler's Invention.

"We have already pointed out that by 1930 all American-made passenger automobiles and trucks were factory-equipped with either the Alemite pin type of lubricating equipment made under Gullborg patent 1,307,734, or the Alemite push type of lubricating equipment made under Zerk patent 1,475,980, and that all passenger automobiles and trucks made in America continued to have one or the other of these systems as factory equipment until the introduction of the Alemite hydraulic type of equipment in April, 1933. By January, 1934, all American-made automobiles, including both passenger vehicles and trucks, had changed over to the Alemite hydraulic type of lubricating equipment. (Rec., 66.)

"The rapid adoption of the Alemite hydraulic type of lubricating equipment by the automobile manufacturers was based on certain important advantages which this equipment has over the Gullborg and Zerk equipments previously used. These advantages are an inherent part of Butler's invention."

#### Respondent urged in its Jiffy suit

(on page 2 of its reply brief in CCCA 8):-

- "(4) If claim 1 of the Butler patent be given merely the plain and natural meaning of its words, then it describes both (a) the "Alemite Hydraulic" lubricating equipment sold by the plaintiff, and (b) the 'Jiffy' lubricating equipment sold by the defendant.
- "(5) Within less than one year after its advent upon the market, the plaintiff's 'Alemite Hydraulic' lubricating system had completely displaced every other known means for lubricating the chassis bearings of automobiles,—to the extent that every automobile and truck manufactured in America was equipped at its factory with the 'Alemite Hydraulic' equipment. That condition has continued uninterruptedly to the date of the trial herein.
- "(6) Even if claim 1 of the Butler patent be interpreted to mean the precise thing described and illustrated in Butler's specifications and drawings, still, if Butler is entitled to any range of 'equivalents' whatsoever, then (a) the plaintiff's 'Alemite Hydraulic' equipment embodies the Butler invention, and (b) the defendant has infringed."

#### Respondent urged in its Jiffy suit

(on page 11 of its reply brief in CCA 8):-

"Even here, however, the language of claim 1 does not support the twist which counsel attempt to give to it. What counsel for defendant-appellee attempt to make of this language is a statement that the piston must directly and immediately compress the locking jaws. They attempt to distinguish this fanciful limitation from a construction like that of the Alemite Hydraulic system and the defendant's system, in which the actuation of the piston more indirectly compresses the locking jaws about the nipple for locking the parts together."

#### APPENDIX II.

The following admissions from pages 49 to 54 of the transcript of respondent's oral argument before the Court of Appeals for the Seventh Circuit in the case at bar (reported by court stenographer Rankin) further confirms the fact that the Court of Appeals for the Seventh Circuit in the case at bar did reach a conclusion as to the scope of the Butler patent, in conflict with the conclusion reached by the Court of Appeals for the Eighth Circuit as to the scope of the same patent:

"MR. WILLIAMS: . . . Now, there again I probably have not spent enough time on it to make absolutely clear all of the details of the construction, but I have gone into it with the idea of convincing your Honors, if I may, that the difference between the plaintiff's commercial construction and the disclosure of the patent involves the simplest kind of a mechanical reversal and equivalency.

JUDGE EVANS: What does the defendant sell?

Mr. WILLIAMS: Beg pardont

JUDGE EVANS: What does the defendant sell?

Mr. WILLIAMS: What the defendant sells is this nipple part.

JUDGE EVANS: You don't make any claim that he sells the other part?

Mr. Williams: That is right. Now, what defendant discloses is a piston—this is of course an enlarged model—piston acted upon by the grease with a wedging or camming surface at the forward end. In the shell of the coupler there are mounted some jaws and there is a piece of sponge rubber between those jaws. The result is that the grease pressure comes on as I shall simulate, those jaws are squeezed inwardly—I don't know whether your Honors can see that—squeezed inwardly, and it is the inward movement of

those jaws which grip about the neck of the nipple and hold the parts together during the injection of the grease.

Now, what the plaintiff has done in its commercial model is to reverse those jaws, and your Honors will see at the forward end of this enlarged coupler the ends of three jaws corresponding somewhat with the three jaws as they appear in this aluminum model. That has been turned: instead of that way it has been turned this way, and the part of the piston which formerly acted as the wedging cam has been incorporated into the outer shell here and the forward end of the piston in this instance has been left square like that. Now, your Honors will observe the three jaws and you will see again that they are squeezed inwardly in such a way as to grab about the neck of the fitting. There is that simple reversal, and that is one of the grounds which is urged by the defendant for saying that the parts which we sell do not embody the disclosure of the Butler patent and do not embody the claim of the Butler patent, although your Honors will find that the language of the claim is just as readable upon this reversed form as it is upon the other. Just because of that reversal the contention is made that we ourselves have not embodied the Butler patent in the thing that we sell and from that the argument is made that if the defendant sells a part of that combination it cannot contributorily infringe because we ourselves are not supplying other parts necessary to complete the infringement. Now, I want to skip to-

JUDGE EVANS: Starting with that last, that position is sound, is it not, if you were not selling a product that is the embodiment of a patent?

Mr. Williams: That would be conclusive. If what we sell does not embody, so far as this goes, the Butler invention, then nothing that the defendant could do with the balance of the stuff would be contributory infringement;—but that, of course, is what we do sell.

JUDGE EVANS: The point of that is that the Eighth Circuit has held that this does not embody.

MB. WILLIAMS: Well, that is one of the things that counsel says and with which I disagree to this extent. In the Eighth Circuit Court of Appeals we had brought a suit against a concern which was engaged in, not making a gun as counsel says, but in making a coupler with a gun or compressor and the fitting part too and we brought suit against that Jiffy Company alleging infringement by its sale of the entire thing, and as showing the extent to which the Butler invention was gone into at that time, we offered evidence showing that the plaintiff had sold, as it has literally, millions and millions of guns and couplers and literally hundreds of millions of the fitting parts, and the Court of Appeals for the Eighth Circuit said, and that is a matter that I want to come to, said that as they viewed the Butler patent, it must be strictly limited to certain spring fingers so flimsy that there would be no effective gripping such as I have demonstrated by the coupler and the nipple, and that the plaintiff in its construction had effected the kind of a reversal that I have been showing to your Honors, and furthermore, that this construction was such that there was a powerful gripping, and they said that that was not the disclosure of the Butler patent and therefore they would not give the Butler patent the breadth or the scope requisite to hold the defendant, because it was not shown to have been a commercial success, that one claim.

Judge Evans: This is what your opponent said, that they held that this was not entitled to that scope and also held that the coupler was originally copied from Jiffy, that they had made that very thing, and therefore you were necessarily—

Mr. WILLIAMS: I don't remember exactly what they said about that.

JUDGE EVANS: Your position is practically that we must reject that decision as to the scope of that patent.

Mr. Williams: It was not strictly an issue in this case, and to the extent that the Eighth Circuit Court of Appeals

said what they did upon the scope, I am urging your Honor to disagree. I say it was no ultimate issue in that case. It was a discussion of collateral evidence that might have swayed the Court on a question of invention, and trying to apply the facts, they reached the conclusion with which I do not agree upon that point. I am asking your Honors therefore, if not to disagree with them, at least to reach a different conclusion."

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IN THE

CHARLES ELMORE CROPLEY

### Supreme Court of the United States

No. 608.

October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

Ð.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

Petitioner's Reply Brief.

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PAGE

# INDEX OF SUBJECT-MATTER.

Page
Nomenclature 1-5
The issues do not turn on "expert testimony" 5-7
Respondent can NOT monopolize old grease-cups (or
old pumps) merely because some of the internal
parts of respondent's allegedly Butler-improved
coupler move, when the coupler is applied to (or
removed from) the old grease-cup
The catch-phrase "cocking", conjured up by re-
spondent's counsel7-12
This Court's decisions on contributory infringement
harmonize with each other and with our position
at bar12-16
Respondent attempts to re-try Leeds & Catlin 16
Answer to respondent's four questions16-17
Who prepared the findings and conclusions?17-21
Table of concordance between respondent's pro-
posal and the words adopted by the trial
Court
Petitioner's grease-cups at bar have other uses, not
complained of herein
Respondent publicly asserts such other uses, in re-
spondent's other suits
Respondent's nine Min-A-Max suits25-28
Plaintiff's Exhibits from Min-A-Max suits, show-
, ing uses of the herein accused grease cups in
ways not complained of under Butler patent:
Facing 26 & 27
Plf. Exh. A in Min-A-Max suit No. 1 Facing 26
Plf. Exh. A in Min-A-Max suit No. 7 Facing 27
3

INDEX OF SUBJECT-MATTER (Continued).
Page
Respondent's Manzel suits and Zerk suits28-30
Respondent's Morris suits
Jacques suits, sponsored by respondent31-33
The Court's decision in one of these Jacques
suits sponsored by respondent (Appen-
dix II)2a to 5a
Conclusion 33
APPENDIX I.
Excerpt from respondent's Min-A-Max patent con- tract, showing respondent's control over the Min-
A-Max suits 1a
APPENDIX II.
Opinion and findings of fact and conclusions of law in
Jacques v. Universal suit, U. S. D. C., W. D.
Penna., February 4, 1938, not yet reported2a-21a Opinion
Findings and conclusions adopted by Court.6a-21a

# TABLE OF CASES CITED.

Page	
Alemite v. Lubrair (C. C. A. 1), 62 F. (2d) 899 5	
American Cotton Tie Co. v. Simmons, 106 U.S. 8913, 14	
Carbice v. American Patents Corp., 283 U.S. 27 12	
General Electric Co. v. Ohio Brass Co., (C. C. A. 3), 277	
Fed. 917 5	
Germantown Trust Co. (C. C. P. A.), 57 Fed. (2d) 365. 5	
Heald v. Rice, 104 U. S. 737 5	
Jacques v. Universal Lub. Syst., Inc	
Decided February 4, 1938, but not reported.	
Opinion of Court and finding and conclusions	
adopted by Court are in Appendix II.	
Kodell Electric Co. v. Warren Telechron (C. C. A. 6),	
62 F. (2d) 692 5	
Langen v. Warren Axe & Tool Co., (C. C. A. 3), 184	
Fed. 720 5	
Leeds & Catlin v. Victor, 231 U.S. 301 and 32512, 16	
Leitch v. Barber, 302 U.S. , 58 S. Ct. 288 12	
Lincoln v. Stewart-Warner (the case at bar), C. C. A.	
7, 91 F. (2d) 757, R. p. 6283, 4, 24	
New York Central v. Henney (C. C. A. 2), 207 Fed. 78. 6	
Process Engineers v. Container Corp., 70 F. (2d) 487. 17	
In re Ratican, 36 App. D. C. 95	
Rogers v. Alemite, 298 U. S. 415,	
2, 7, 8, 9, 10, 12, 15, 24, 30, 32	
Stewart-Warner v. Jiffy (C. C. A. 8), 81 F. (2d) 786	
(certiorari denied 299 U. S. 554)	
Stewart-Warner v. Rogers and Universal, 15 F. Supp.	
410	
Underwood v. Gerber, 149 U. S. 224 5	
Woodward v. Hurd, 232 U. S. 428	

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# Supreme Court of the United States.

No. 608. October Term, 1937.

# LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

v

# STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

## PETITIONER'S REPLY BRIEF.

To the Honorable, The Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent's brief represents such a palpable attempt to evade and becloud the issues by feigning non-existent factual disputes and by discussing generalities on nonissues, as to call for a reply.

# NOMENCLATURE.

As a part of its evasive strategy, respondent has attempted to be cloud and confuse the issues by criticizing our brief as misrepresentative in our statement of the case. This criticism is presented by respondent as a pretext for its own re-statement of the case;—which respondent's brief does by merely quoting at length the findings of fact and conclusions of law adopted by the trial court. As to the authorship of these findings and conclusions, see pages 17-21 herein.

The only thing to which respondent was able to address any criticism, however, was purely a matter of nomenclature. The nomenclature which respondent criticizes in our brief, is the same nomenclature given by the prior-art and by respondent's own earlier patents including respondent's patent which was adjudicated in this Court (in Rogers v. Alemite, 298 U. S. 415) as well as by findings of fact, in the case at bar, which were written by respondent's counsel and adopted by the trial Court.

Thus, respondent's **only** criticism of our brief, and the thing which respondent calls "typical" of our entire statement of the case, is merely the fact that we call the "lubricant-receiving nipple" a **grease-cup**, and that we call the "lubricant compressor" a **pump**.

Respondent's own earlier Gullborg patent 1,307,734 (R pp 534, 539) calls the "lubricant receiving device" a grease-cup (and also calls the same device by other names), and calls the "compressor" a pump. Gullborg's pump is indistinguishable from Butler's pump.

Respondent has not attempted to show either by reference to the record or in argument that what it now calls the "nipple" is not the same device which in its Gullborg patent it called the grease-cup. Respondent obviously could show no distinction, because in its commercial catalogs (Plf. Exh. 21-B; pages 3 and 13) it calls both types of grease-cups, that is, both the bayonet type grease-cup of its earlier Gullborg patent, as well as the headed grease-cup by the same name, to wit, a "fitting".

Respondent has not attempted to show that Butler's compressor is anything but a pump and indeed an old pump. Respondent's brief (page 3) says:

"One of the elements of the combination claimed in the patent in suit is a 'lubricant compressor' (see claims 1

and 2, R. p. 470). Counsel for petitioner choose to rename this element as a 'pump''.
Respondent's brief then continues:

"No lubricant compressor prior to the advent of Butler's invention ever performed the function of Butler's compressor."

Beyond making this astounding statement, respondent's brief does not anywhere give any support for this statement. Obviously there is no support for such statement in the record nor can any be evolved in argument, because Butler's pump is indistinguishable in structure and function from the pump of respondent's own prior Gullborg patent (R p 534) and of respondent's own prior Winkley patent (R p 526). Moreover, the term "lubricant compressor" has been interpreted by respondent to include not only those pumps shown in these patents and in the Butler patent but also the entire field of pumps including those operated by compressed-air motors as well as those operated by electric motors (kinds of pumps not anywhere disclosed in the Butler patent).

Respondent spends many pages of its brief on the proposition that the Butler headed grease up and pump are proper elements of a claim defining what Butler invented. Respondent's utter disregard of propriety in reaching beyond the invention with claims is well pointed at page 3 of its brief, quoted above.

Respondent's feigned dispute as to nomenclature is further without point because the decision of the Court of Appeals for the Seventh Circuit in the case at bar has clearly pointed out that both the combination as a whole is old and that the headed "nipple" or grease-cup (the only defendant's device now accused in the case at bar) is also old.

The Court of Appeals for the Seventh Circuit in the case at bar said:

"the patent in issue here deals with some of the same old elements of combination" as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Battick vs. Hollingshead opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here, with (1) a type of pin fitting, (2) a grease-gun, (3) a connecting hose, and (4) a type of coupler."

(91 Fed 2d 757, 761, R p 633.)

The Court of Appeals for the Seventh Circuit in the case at bar also recognized (what the record clearly shows) that the headed grease-cup or nipple accused in the case at bar and included in Butler's patent claim was also old and not patentable; the Court saying in its opinion:

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old".

(91 Fed. 2d 757, 763, R p 637.)

This conclusion was inescapable and was forced upon the Court of Appeals for the Seventh Circuit in the case at bar by the long series of headed grease-cups and analogous headed fluid-receiving devices (called by many names), of which typical examples appear in our main brief, on the chart facing page 16.

We submit, in view of respondent's obvious intention also to reach, via "contributory" infringements, the ob-

<sup>•</sup> In quotations throughout this brief, emphasis is ours unless otherwise noted.

viously old pumps, as well as the obviously old headed grease-cups, that this and like claims should once and for all be stamped as invalid. Such claims menace the common-law rights of the public generally and should be abolished as was done in the following cases:

Heald v. Rice, 104 U.S. 737, 755;

Underwood v. Gerber, 149 U. S. 224, 227;

General Electric Co. v. Ohio Brass Co., 277 Fed 917 (C. C. A. 3);

Langen v. Warren Axe & Tool Co., 184 Fed 720 (C. C. A. 3);

In re Ratican, 36 App. D. C. 95;

In re Germantown Trust Co., 57 Fed 2d 365 (U. S. Ct. of Customs & Patent Appeals);

Kodell Electric v. Warren Telechron, 62 Fed 2d 692 (C. C. A. 6);

Alemite Corp. v. Lubrair Corp., 62 Fed 2d 899 (C. C. A. 1).

# THE ISSUES DO NOT TURN ON "EXPERT TESTIMONY."

Respondent's brief criticizes our brief on the score that we have not sufficiently referenced our brief to the testimony, particularly the "expert testimony" of respondent's opinion witness.

While the so-called "expert testimony" of lawyer (R p 49) Lynn A. Williams, Jr., in the case at bar when interrogated by his father, Lynn A. Williams, Sr., was nothing but an echo of counsel's argumentative position, yet the documentary evidence, in the case at bar so completely

<sup>\*</sup> Our statement (pages 5-43 of our main brief) contains over seventy references to documents in the Record.

establishes the essential facts that it was not necessary for us to refer to such "expert testimony." This type of testimony has long ago and aptly been condemned by the Court of Appeals for the Second Circuit in New York Central v. Henney, 207 Fed. 78, 81.

Even this type of "expert testimony" cannot explain away the facts shown on the face of the prior-art patents, as recognized by the Court of Appeals in the case at bar in its opinion, that the combination of the four devices, to wit, grease-cup (nipple), pump (grease-gun or compressor), hose and coupler (nozzle) was old, and that headed greasecups or nipples were also old prior to Butler.

Thus, what Butler's astute patent solicitors have done and what the respondent's "lawyer-expert" has done in the case at bar is to describe the coupler (in the descriptive portion of the Butler specification) as five elements alongside of a pump and a grease-cup, thereby to spell out of this commingling of five coupler-composing elements, and two separate and independent devices, a so-called "combination" of seven elements, of which the pump and grease-cup are two and of which the five coupler-composing elements are the other five.

Respondent's "lawyer-expert" has, for example, tried to obscure the fact that the pump, coupler and grease-cup are three independent devices, by calling them seven elements. He did this by splitting the coupler into five elements whose combination forms Butler's invention, if Butler made any invention. To these five coupler-composing elements this "lawyer-expert" of respondent added a complete independent pump and a complete independent grease-cup, both outside the invention, if any. This is how he obtained the total of seven elements. As a matter of fact, the coupler is one device, the pump is a second device,

and the grease-cup is a third device. The pump and the grease-cup are separate devices which lie outside of Butler's invention.

RESPONDENT CAN NOT MONOPOLIZE OLD GREASE-CUPS (OR OLD PUMPS) MERELY BECAUSE SOME OF THE INTERNAL PARTS OF RESPONDENT'S ALLEGEDLY BUTLER-IMPROVED COUPLER MOVE, WHEN THE COUPLER IS APPLIED TO (OR REMOVED FROM) THE OLD GREASE-CUP.

This Court has decided just this, in the Rogers v. Alemite case quoted below.

Much of respondent's brief simply boil down to an argument of the dubious proposition that the headed characteristic of the Butler grease-cup causes coaction with the coupler to effect an automatic sealing against leakage and so-called "cocking" of the coupler by the grease-cup. It is upon this basis that respondent also, at the bottom of page 190 of its brief, challenges petitioner to discuss the following italicized phrase in a quotation from the Hollingshead and Rogers case, to wit:

"The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element." (298 U. S. 415, 425.)

We accept this challenge simply by noting that in the Rogers v. Alemite case there was a similar automatic sealing action against leakage and a similar "cocking" action. This Court said, at 298 U. S. 415, 418, that Gullborg

<sup>\*</sup>This word "cocking" is not in the Butler patent, and is a mere catch-phrase evolved by respondent's counsel.

"conceived the idea of placing a movable perforated cup-shaped disc or washer in the barrel of the coupler held by a spring against the orifice of the coupler. The intended operation of his device was that when the coupler had been fastened over the pin fitting thespring should press the washer against the ball in the pin fitting so that the tube in the fitting would be open to receive the grease, and, upon application of pressure to the grease, the washer would thereby be firmly pressed against the opening of the pin fitting, thus causing a tight union and preventing exudation of grease. His specification asserts that the invention makes possible the injection of grease under very high pressure. The design of the bayonet slots is such that, in uncoupling, the coupling member of the gun will at first be moved slightly forward on the pin fitting thus backing up the perforated washer in the bore of the coupler. As the two parts are then drawn apart by the retraction of the coupler, the cup-shaped washer will be forced forward by the spring. This will cause a vacuum beyond the washer and the air rushing in through the perforation in the washer will draw with it any grease which would otherwise adhere about the orifices of the fitting and the coupling."

From the above it is clear that Gullborg's perforated washer in the barrel of the coupler was similarly "cocked" (pressed back against the spring) when the Gullborg coupler met an old pin-fitting type or grease-cup, so that when the Gullborg coupler was pulled away from said grease-cup, the Gullborg washer was forced forward by the spring to suck the grease away from the old grease-cup.

Thus, this Court has already held in the Rogers v. Alemite case, that the movement \* of one or more internal

<sup>\*</sup> which movement respondent at long last calls "cocking".

elements of the coupler, when the coupler is used with an old grease-cup, does not entitle the patentee to monopolize old pumps or old grease-cups.

Furthermore, this Court was correct in its decision in Rogers v. Alemite in holding that the invention was merely in the coupler, because it was the parts in the coupler that were organized and positioned to provide a new coupler, and the grease-cup had nothing to do with it, except to provide the old environment in which the invention (the coupler) was to be used. Likewise, we submit that we are correct in the present case in our position that when Butler, like Gullborg, positions or arranges the internal parts in the coupler, per se, so as to move ("cock") when used with the old environmental grease-cup, that this case is on all fours with the Rogers v. Alemite case and that this Court should correctly hold that Butler's invention is also restricted to the coupler and does not extend to the old pump nor to the old grease-cup.

This Court's statement in the Rogers v. Alemite case at 298 U. S. 415, 419, that,

"While Gullborg's invention was confined to an improvement in the hose coupler, which is but one element in the old and well understood combination of a compression chamber or pump, a hose, a hose-coupler, and a grease cup or fitting connected to the bearing to be lubricated, his claims are not for the improvement as such but all are for a combination of the old elements with the improved form of coupler."

applies with equal force to Butler's invention. To show that this Court's statement applies to the present case, it is only necessary to substitute the name Butler for the name Gullborg in the above quotation. Another point that emphasizes the similarity between this case and Rogers v. Alemite is that even the same pressure release, referred to at 298 U. S. 415, 420, as being necessary for the Gullborg sealing washer to perform its function of creating a suction when the pin (of the grease-cup) and coupler are disengaged, is paralleled by the requirement for pressure release referred to by respondent at page 29 of its brief as being necessary to permit the head of the nipple to wedge its way through the jaws 40 to bring about the so-called "cocking" upon release.

Thus, it will be seen that what this Court refers to as the "old combination whose construction and operation is otherwise unchanged" (see 298 U. S. 415, 425), simply means that the broad combination (which was already known) of a pump, coupler and grease-cup, and that Butler, like Gullborg, simply improved the coupler, and that Butler, like Gullborg, is not entitled to monopolize the old pump or old grease-cup. Certainly, we may say that the Butler combination of pump, coupler and grease-cup has a construction and operation which is unchanged, except as to the changes in the coupler per se, in the same sense Gullborg's combination of pump, coupler and grease-cup had a construction and operation which was unchanged, except as to the changes in the coupler per se.

Butler has done no more for the old combination of pump, coupler and grease-cup than did Gullborg, that is, Butler merely improved the coupler and is not entitled to monopolize the pump or grease-cup.

Respondent's catchword "cocking" has no real significance whatever. This catchword is merely conjured up by respondent's counsel to mystify the obvious. What respondent is doing is merely saying in another and somewhat dramatic way, that when a coupler meets a grease-cup or is subsequently disunited from the grease-cup, the internal parts of the coupler go through all their motions and functions as determined by the coupler design. This is true of every coupler. It is true of the old Gullborg coupler. It is likewise true of the Seng coupler and the Newton coupler, both shown on the chart facing page 26 of our main brief. Thus, whatever motions and functions the internal parts and mechanisms of a coupler have, as determined by the coupler design, they go through these motions and perform these functions when meeting a grease-cup, "fitting" or "nipple".

Respondent's catchword has no real significance in glorifying the old headed grease-cup (when meeting a Butler coupler) as distinguished from some other type of old grease-cup. This is perhaps best demonstrated by the fact that in its suit against Jiffy, decided by the 8th Circuit, respondent asserted claim 1 of the Butler patent against a Jiffy coupler when used with respondent's own old Alemite "pin-fitting" type grease-cup of its now-expired Gullborg patent (see the top center of the chart facing page 26 of our main brief). The old Alemite pin-fitting (R. p. 534) was not a headed grease-cup but a "bayonet" type grease-cup, and the Jiffy coupler was obviously "cocked" when meeting the old "non-headed" bayonet-type grease-cup;that is, its internal elements went through their intended motions and performed their intended functions when meeting the non-headed grease-cup. The bayonet pins on this bayonet-type grease-cup had no function with the Jiffy coupler. The Jiffy coupler merely gripped the cylindrical free end of the Alemite bayonet-type grease-cup beyond the bayonet pin.

<sup>\*</sup>in the same sense as that old "pin-fitting" type grease-cup has been "cocking" the internal elements of the old Gullborg coupler for the past twenty years.

We thus see that the limitation in claim 2 to a headed fitting does not provide any unique feature by which any unique so-called "cocking" feature is brought about. In fact, respondent was pursuing the Jiffy Company under claim 1, which calls for a fitting without limitation to any headed characteristics.

Respondent's "cocking" argument boils down to this:—
the Butler coupler, like most prior couplers, has some movement of internal parts when it meets a grease-cup or "fitwhen it leaves the grease-cup. This Court, in the Hollingshead and Rogers decision quoted above, describes just such
an action as occurring when the Gullborg coupler meets or
leaves a grease-cup. This Court held that such circumstances do not entitle the patent owner to monopolize the
pump or grease-cup.

# THIS COURT'S DECISIONS ON CONTRIBUTORY IN-FRINGEMENT HARMONIZE WITH EACH OTHER AND WITH OUR POSITION AT BAR.

At pages 85 to 179, respondent's brief attempts to show that our position at bar is at variance with the relevant decisions of this Court.

We refrain from repeating here our detailed arguments at pages 57-78 of our main brief, showing that our position at bar is exactly in harmony with each of this Court's four leading and latest relevant decisions, namely, the Leeds, Carbice, Leitch and Rogers cases.

Carbice Corporation of America v. American Patents Development Corporation, et al., 283 U. S. 27;

Leitch Manufacturing Company, Inc., v. The Barber Company, et al., 302 U.S.; 58 S. Ct. 288; and Rogers et al. v. Alemite Corporation, 298 U.S. 415.

<sup>\*</sup> Leeds & Catlin Company v. Victor Talking Machine Company, 213 U. S. 301 and 325;

To the above four decisions, respondent's brief (pages 82-85) adds two of this Court's earlier decisions. We now discuss these two, briefly, and show that they are completely in harmony with the four decisions noted above:

American Cotton Tie Co. v. Simmons, 106 U. S. 89:

In this suit, the patents were for a cotton bale tie. The defendant sold the tie. Only the bale of cotton and the press were needed to produce the result set forth in the patent.

At 106 U.S. 89, 94, the Court said, referring to the defendants:

"They sell the tie having the capacity of use in the manner described (in the patents), and intended to be so used. Only the bale of cotton and the press are needed to produce the result set forth in the specifications of the patents, and without the bale of cotton and the press the tie would not be made or sold. The slot through the end bar of the buckle in the Cook patent is of no practical use apart from the band and the bale of cotton, and the same thing is true of the link of the McComb patent with its arrow-shaped aperture; . . ."
"We do not decide that they are liable as infringers of either of the three patents merely because they have sold the buckle considered apart from the band or from the entire structure as a tie." (106 U. S. 89, 95.)

Thus, in this cotton tie case, the defendants appropriated the tie, which was the patentees' advance over the prior art.

On the other hand, in the case at bar, the petitioner is not making any coupler complained of, but is making an old grease-cup for use, inter alia, with respondent's old pump and allegedly Butler-improved coupler.

Thus, in this cotton tie case, the common denominator of this Court's decisions on contributory infringement (page 57 of our main brief) is again found, namely, that one who makes, sells or supplies the thing which the patentee really invented, is a contributory infringer, but the doctrine of contributory infringement cannot be abused to monopolize an old device which the patentee may have included in his claim along with the patentee's assertedly improved device.

# Woodward Co. v. Hurd, et al., 232 U. S. 428:

Here the patent was on a rubber-tired wheel. The wheel was old. The tire was new.

The defendant sold all the parts essential to the making of the tire. This Court said (232 U. S. 428, 429):

"The case as stated concerns the liability of the defendant as a contributory infringer upon the assumption that in the manner described it assembles the various elements essential to the making of the Grant tire and sells them with the intent and purpose that they shall be so combined."

This decision distinguishes the infringement by making tire, from non-infringement by making the rubber element of the tire.

Thus, in this Woodward case, the common denominator of this Court's decisions on contributory infringement (page 57 of our main brief) is again found, namely, that one who makes, sells or supplies the thing which the patentee really invented (the tire), is a contributory infringer.

Again, the doctrine of contributory infringement cannot be used to monopolize something (the rubber element) which the patentee did not invent, even though it was included in his claim. At page 100, respondent's brief takes the position that the Rogers v. Alemite case was based upon the question of double patenting, so far as Gullborg claims 14 and 15 are concerned, and infers that this distinguishes that case from the present case. This is far from true.

In the first place the case at bar is precisely parallel to the case before this Court on Gullborg claims 1 to 4 and 10, where, as here, the claim was drawn to a so-called "combination" of an assertedly improved coupler (specificallydefined) and an old pump and an old grease-cup (the latter two devices were included in the claim only in broad and all-inclusive language).

In this connection respondent does not discuss this Court's decision on Gullborg's claims 1 to 4 and 10.

Moreover, even considering respondent's argument with respect to Gullborg claims 14 and 15, a person will not be permitted to patent de novo an old combination, as Butler does, any more than he will be permitted to repatent an old combination. The question as to whether the grease-cup, per se, has been separately patented in some other unexpired patent (not in suit), or whether such grease-cup was merely an old grease-cup of the prior art, is purely incidental and immaterial.

In any event, respondent's argument is not directed to Gullborg claims 1-10, which are analogous to the claim at bar.

However if any further parallelism is wanted between the respondent's position in its earlier Rogers and Hollingshead suits recently decided by this Court (298 U. S. 415), insofar as concerns the immaterial existence of a separate patent on the grease-cup, per se, we believe it appropriate to call attention to the fact that respondent in other simultaneous litigation is asserting its earlier Zerk patent 16 "Retrial" of Leeds and Catlin-Answer to Questions

1,619,455 which covers a grease-cup, per se, against the very same grease-cup as is accused in the case at bar.

Stewart-Warner Corp. v. V. L. Jacobs, U. S. Dist. Court, N. Dist. of Ill., E. Div. Equity No. 15,820, filed Oct. 2, 1937.

Respondent Attempts to Re-Try Leeds & Catlin.

This Court's decision in the case of Leeds & Catlin v. Victor speaks for itself. We have quoted the pertinent parts of this Court's decision from the Leeds & Catlin case.

Respondent's attempt (pages 165-181 of its brief) to go back of this Court's decision in the Leeds & Catlin case and re-try (in effect) the Leeds & Catlin case, is inappropriate and impertinent for two reasons;—one, because the only possible significance of that decision (or any decision) as a precedent, is the announcement of the law based on the facts found by the Court, and secondly, it is entirely impertinent for respondent to attempt to show that the facts announced in this Court's decision in the Leeds & Catlin case are at variance with the facts shown in or out of the record of that case.

If a re-trial of the Leeds & Catlin facts were proper or useful now, such re-trial would show that this Court's recital of the facts, in this Court's Leeds & Catlin decision, is correct. See pages 58-59 of our main brief.

# ANSWER TO RESPONDENT'S FOUR QUESTIONS.

Respondent's four questions at page 68 of its brief may all be answered and applied to the Butler patent, if we assume, for the moment, that Butler claim 1 is valid, by saying that if Jiffy had sold a Butler coupler, Jiffy would have been a contributory infringer of Butler claim 1. This is because the doctrine of contributory infringement

can be used only to reach one who supplies or does the thing which the patentee really contributed to the art.

On the contrary, there can be no contributory infringement in the case at bar, because the petitioner is not even charged with having appropriated the thing (the coupler) which Butler contributed to the art.

By the same token, contributory infringement might have existed in the case at bar, if respondent had retained petitioner's own coupler upon which this suit was originally based, and if such coupler had been shown to be a Butler coupler. The respondent chose to throw petitioner's coupler out of this case. The reason for this must be obvious. It had no confidence in its ability to show that petitioner's coupler, upon which the suit was originally based, was in reality a Butler coupler.

# WHO PREPARED THE FINDINGS AND CONCLUSIONS?

Respondent's brief rests heavily upon respondent's representation that the findings of fact and conclusions of law were prepared by the trial judge himself.

In our brief heretofore filed, we did not in any way discuss the authorship of the trial court's findings and conclusions because such authorship is ordinarily immaterial—it being a well settled principle that an appellate tribunal is not bound by the findings and conclusions of the trial court.

We know of no rule against the trial judge adopting the findings of fact and conclusions of law proposed by either party, nor do we know of any rule against the trial court writing an opinion by collecting and condensing excerpts from counsel's brief. Indeed, many trial courts very prop-

Process Engineers v. Container Corp., 70 F. (2d) 487, 489.

erly request each side to submit findings and conclusions which the court may adopt.

We are filing in this Court copies of plaintiff's proposed findings and conclusions and an accompanying letter from Mr. Lynn A. Williams (respondent's counsel) dated June 29, 1936, to His Honor Judge Lindley.

We compare the trial court's findings and conclusions with those which had been submitted to the trial court by Mr. Lynn A. Williams, as follows:

### Table of Concordance.

### Between

respondent's findings of fact and conclusions of law submitted to the trial judge some time prior to June 29, 1936,

### and

the trial court's findings of fact and conclusions of law filed July 15, 1936 (R. p. 431).

Plaintiffrespondent's Trial court's
proposed findings
of fact and conclusions of law

(Findings of Fact)

1+2	1	Substant	ially the sam	e except that
				changed to "Vir-

3	2 Verbatin	m.	
4	3 Verbatin	m, except that the Cour	t
	ter bring of Branches	added 'and' and	1
	test to anniver	omitted "and at the ex	-
		nense of the"	

age of fair all	pense of the".
5	4Verbatim, except that the Court
	added "or shouldered"
	and substituted "lubri-
Pie depeter	cant-right" for "lubri-

Plaintiff- respondent's proposed findings of fact and con- clusions of law (Findings	Trial court's findings of fact and conclusions of law s of Fact)	
6		batim, except that the Court added "In practical op-
7	6Ver	eration". batim, except that the Court emitted "gun or", and "gun and the", and
8	7Ver	added "compressor". batim, except that the Court
	d	added "in order to pre- vent leakage of lubri- cant".
9	8Ver	batim, except that the Court added "the" and "combination".
10		batim, except that the Court added "51".
11	10Ver 11Ver	batim, except that the Court omitted "Clyde B." and "patent".
13	12Ver	omitted "in any form whatsoever" and transposed "automatically" and "effected".
14	13Ver	
15	14Ver	
	15Ver	
	16Ver	batim.
18	17Ver	batim.
		batim, except that the Court
		added "Under this
		equipment'', and omitted "car".

# Authorship of Findings

Plaintiff- respondent's proposed findings of fact and con- clusions of law	Trial court's findings of fact and conclusions of law
(Findings	s of Fact)
20	19Verbatim. 20Verbatim.
22	21 Yerbatim.
23	22Verbatim, except that the Court omitted "(St. Louis)", and substituted "fitting" for "fittings".
24.	23Verbatim, except that the Court substituted "at least as early as" for "in".
25	24Verbatim, except that the Court substituted "of" for "or".
26:	25Verbatim.
. 27	261Verbatim.
28	27Verbatim.
291	28Verbatim.
30	29: Verbatim.
31	30Verbatim, except that the Court omitted "(St. Louis)".
32	31Verbatim.
33	32Verbatim, except that the Court added "or shoulder or
C.	head".
34	33Verbatim.
35	34Verbatim.
36	35Verbatim.
37	36Verbatim, except that the Court omitted "Mr. A. P. Fox".
a to the tell that I	From State 18

for

1	Plaintiff- respondent's proposed findings of fact and con- clusions of law	Trial court's findings of fact and conclu- sions of law	
	(Findings	of Fact)	
	38	37Verbatim	
		38Verbatim	
*	40	39Verbatim	substituted "not" "but".
	41	40Verbatim	
	42	41Verbatim	
	(Conclusion	s of Law)	
	43	1Verbatim 2Verbatim	
	45	3Verbatim	
	46	4Verbatim	
	47	5	
	48	6Verbatim	
	49	7Verbatim	
	50	8,Verbatim	
	51	9Verbatim	
	52	10Verbatim	

We do not question that the trial court may have expended a great deal of time and effort and had given a great deal of consideration to the findings of fact and conclusions of law prepared by respondent's counsel before adopting and making such findings and conclusions its own. What we do object to, is respondent's disproportionate emphasis of a matter in which respondent clearly rests upon its own misrepresentation of an otherwise immaterial fact.

11..... Verbatim.

53.

# PETITIONER'S GREASE-CUPS AT BAR HAVE OTHER USES, NOT COMPLAINED OF HEREIN.

The record shows conclusively that petitioner's grease-cups at bar have other uses, not complained of in this suit, such as with petitioner's N-6 nozzle (Defendant's Exhibit A-44). See for example, R. pp. 87-89, 93-98. See also the chart at R. p. 427, which illustrates and describes the Lincoln "KLEENSEAL Nozzles" and their conjoint use with petitioner's grease-cups at bar. The chart at R. 423 shows how the petitioner's grease-cups at bar have a use with respondent's Zerk nozzles. Respondent makes no complaint whatever that such uses infringe the Butler patent.

At R. pp. 397-401, 411, 415 and 427, petitioner's lubrication system composed of co-operative Kleenseal nozzles and fittings is illustrated. Respondent makes no complaint whatever that such uses infringe the Butler patent.

Respondent (page 52 of its brief) describes these other uses as "innocent", but attempts to belittle them.

The fact remains, however, that these other uses do exist and have always existed as long as petitioner's grease-cups at bar have existed.

As pointed out on pages 8, 9, and 10 of our main brief, petitioner sells not only the grease-cups to which respondent has at last confined the present suit, but petitioner (just like respondent) also sells an extensive line of pumps\* and grease-delivery couplers or nozzles used on the discharge hoses or conduits of the pumps, for making the temporary fluid-tight connection between the pumps and petitioner's

<sup>\*</sup>Some small, some large, some manually operated, some operated by compressed-air motors, and some operated by electric motors.

grease-cups at bar (as well as other grease-cups on the market).

As also heretofore pointed out in our main brief (pages 8 to 10), respondent brought this suit, at the outset, solely on the basis of a coupler sold by petitioner;—charging that such coupler constituted "contributory" infringement of the Butler patent here in suit.

Through a series of steps†, respondent completely changed the basis of its present suit by withdrawing the coupler upon which the suit was solely based and then resting its suit solely upon petitioner's grease-cup later brought into this suit. Respondent's action is capable of only one interpretation, and that is, that respondent had no confidence in its charge of infringement first levelled at petitioner's coupler. Respondent had no confidence in its ability to convince any court that petitioner's coupler was the Butler coupler.

As hereinabove pointed out above (and also on pages 8-10 of our main brief), petitioner also sells other \* grease-delivery couplers or nozzles, known as the Lincoln "KLEENSEAL Nozzle".\*\* These are also for use with petitioner's grease-cups at bar, and are useful with other grease-cups as well. These nozzles have never been complained of at any time under this Butler patent.

<sup>†</sup>See pages 8 to 10 of our main brief.

<sup>\*</sup>That is, other than the coupler or nozzle upon which this suit was originally based.

<sup>\*\*</sup> These are of another kind, to wit, of the "push-contact" type.

Respondent ASSERTS That Petitioner's Grease-cups at Bar Have Other Uses, Not Complained of Here.

Respondent would have this Court believe that petitioner's grease-cups at bar have no use save with respondent's allegedly Butler-improved couplers. The record cited above shows that the opposite is true. Furthermore, respondent's own litigation which it is waging in various courts on other so-called "combination" patents confirms this fact that the petitioner's grease-cups at bar have other commercial uses than the use herein complained of. Respondent's litigations which we cite below, contain public allegations and admissions by this respondent, or by others acting under its direction, that petitioner's grease-cups at bar are adapted and intended and are in fact used with couplers other than respondent's couplers at bar.

Respondent has recognized this fact by charging infringement against such conjoint use of petitioner's greasecups with other couplers or nozzles, in suits sponsored and maintained by respondent under the more recent Boker patent 1,802,700 (R pp 673-6). The Boker patent 1,802,700 (just like the Butler patent in suit, and just like claims 1 to 10 of the Gullborg patent, 298 U. S. 415), is based upon an alleged improvement in a grease-delivery coupler or "nozzle", but again claims a so-called "combination" of the assertedly improved grease-delivery coupler or "nozzle" with an old grease-cup. (91 F. (2d) 763; R p. 673.)

# Respondent's Nine Min-A-Max Suits.

Thus, in each of the following "Min-A-Max" suits", respondent is asserting

that

petitioner's herein-accused grease-cup or so-called Lincoln KLEENSEAL fitting, or

that

respondent's own similar grease-cup known as the
Alemite HYDRAULIC fitting, or
that

respondent's own earlier Zerk fitting of Zerk patent 1,475,980 (R pp 546-55)

is the grease-cup of the Boker patent 1,802,700 (R p. 673) when used with petitioner's own (herein unaccused) coupler or so-called "KLEENSEAL Nozzle", or when used conjointly with grease-delivery "push-contact" nozzles (couplers) of others:—

- Min-A-Max v. Lincoln Engineering Co. and Smith & Gregory Co., Dist. Court, S. Div., N. Y. (At Law 66-363).
- Min-A-Max v. Lincoln Engineering Co. and Strehlinger, Dist. Court, E. Dist. Mich., S. Div. (Equity No. 8196).
- 3) Stewart-Warner Corp. and Min-A-Max v. Scharoun et al, Dist. Court, N. Dist., N. Y., Equity No. 2893 (decision reported at 32 U. S. P. Q. 499, but not reported in the Federal Reporter System).

<sup>\*</sup>Respondent's connection with Min-A-Max is demonstrated by our discussion at page 27 herein and in Appendix I hereto.

- 4) Stewart-Warner Corp. and Min-A-Max v. The Norlipp Co., Dist. Court, N. Dist., Ill., E. Div., Equity No. 14,362.
- 5) Stewart-Warner Corp. and Min-A-Max v. G. C. Smith, Dist. Court, S. Dist., Calif. (Los Angeles), Equity No. 842-Y.
- 6) Min-A-Max v. Edwin Sundholm, Dist. Court, N. Dist. Iowa, W. Div. (Equity No. 437).
- 7) Min-A-Max v. Red Brown Patch Co., Dist. Court, S. Dist., N. Y. (Equity No. 85-7).
- Min-A-Max v. J. H. Lustgarten, Dist. Court, S. Dist.,
   N. Y. (Equity No. 85/66).
- Min-A-Max v. Pacific Screw Corp., Dist. Court, S. Dist., Calif. (Equity No. 11,658).

Min-A-Max suits numbered 1 and 2 above specificall charge infringement of the Boker patent by the *conjoint* use of petitioner's herein accused grease-cup with peitioner's herein unaccused grease-delivery KLEENSEAL Nozzle' (coupler).

Facing this page is a reproduction of plaintiff's Exhibit A attached to and forming a part of the Complaint in "Min-A-Max suit" No. 1 above;—being, inter alia, a pictorial illustration and description of

petitioner's herein accused grease-cup (Lincoln "KLEENSEAL Fitting") and

petitioner's herein unaccused coupler (Lincoln "KLEENSEAL Nozzle"),

which are charged to infringe Boker patent 1,802,700 because conjointly used.

In "Min-A-Max suits" numbered 3 and 7 above, infringement of the Boker patent is charged (inter alia) by This is Plaintiff's Exhibit A, attached to the complaint in Min-A-Max \* v. Smith & Gregory, Inc. and Lincoln Engineering Co.

Form 19 1884 4.36



NOZZLE ASSEMBLY No. 5813

# LINCOLN KLEENSEAL SYSTEMS

FOR HIGH PRESSURE LUBRICATION



The Nozzle furnished attached to this equipment is the Patented Lincoln Elecason Nozzle Type N6 designed for quick centering on KLEENSEAL Pittings and permits angling the nomic on the fitting without gratine leakage.



The Type NS ELEENERAL Nossie can be used effectively on competitive High Pressure Fittings having ball shaped heads which have sufficient clearance under the head to angle the nessie.

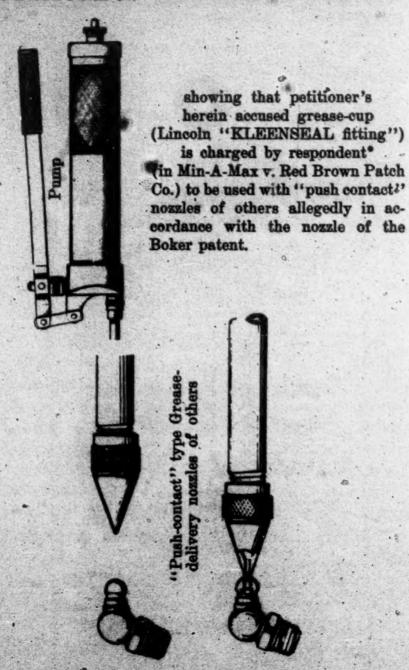


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TILLOOM, NO. " DELIVERED, DECIMENT

(0000)

"Respondent's connection with Min-A-Max is demonstrated at pages 25 to 37 herein and in Appendix L This is a photographic reproduction of Plaintiff's Exhibit A annexed to the Bill of Complaint in Min-A-Max v. Red Brown Pat-L Co.



Petitioner's herein-accused grease-cup (Lincoln "KLEENSEAL fittings")

"Respondent's connection with Min-A-Max is demonstrated at pages 25 to 27 herein and in Appendix I.

the conjoint use of petitioner's herein accused grease-cup with grease-delivery "push-contact" nozzles of others. We attach hereto, facing this page, a photographic reproduction of Plaintiff's Exhibit A annexed to the Bill of Complaint in Min-A-Max suit No. 7 above, portraying the therein accused devices and showing petitioner's herein accused grease-cup in conjoint use with a "push-contact" couplers or nozzle of another.

The respondent, Stewart-Warner Corporation, has not made itself a party to each of the above identified suits but only in three of them, as above indicated, although the Bill of Complaint in above-identified suit No. 3, states that respondent has

"the right to commence and to prosecute actions at law and suits in equity against infringers of the said Boker patent and to make recoveries for infringement of said Letters Patent"

Annexed hereto as Appendix I we have reproduced paragraph 4 from an agreement dated December 11, 1934 between respondent and Min-A-Max Company which constitutes Defendant's Exhibit 38 in the record of Min-A-Max suit No. 6 above, and shows just what the respondent's position is in these "Min-A-Max" suits.

Respondent's attorneys and counsel, Messrs. Williams, Bradbury, McCaleb & Hinkle, are the attorneys in active charge of each of these nine "Min-A-Max suits". Respondent's "lawyer-expert", Mr. Lynn A. Williams, Jr., has also given "expert testimony" in each of the "Min-A-Max suits" which have gone to trial.

Only suits numbered 3, 5 and 6 above have gone to trial, so far as we know.

While respondent may contend in the case at bar that petitioner's herein accused grease-cups have no other purpose than to be used with respondent's couplers (assertedly made by respondent under its Butler patent in suit), yet respondent is, at the same time, engaged in a nation-wide campaign of patent litigation on many other patents owned or controlled by respondent, each based upon some alleged improvement in the construction, form or mechanism of a grease-delivery coupler (or nozzle or connector device), but each again claiming the assertedly improved coupler (or nozzle) in so-called "combination" with an old grease-cup.

In respondent's vast campaign of patent litigation on these many other so-called "combination" patents, respondent is accusing the same old grease-cups as being, in turn, the grease-cups of each of these many other patents.

Thus, as the date of expiration of respondent's many so-called "combination" patents varies over a wide range, respondent is actually bidding for a perpetual monopoly of old grease-cups, so long as some real or imaginary improvement can be made in grease-delivery couplers or nozzles which can be pushed up against or hooked onto an old grease-cup.

Many of these suits have not been contested or only inadequately contested. Some have been contested, as will be more fully pointed out hereinbelow.

# Respondent's Manzel Suits and Zerk Suits.

In addition to the "Min-A-Max suits" hereinabove referred to, in which the *conjoint use* of petitioner's greasecup with petitioner's nozzle is charged to constitute the infringement, respondent is also, in other litigation, charging that the same grease-cups constitute the grease-cups of

or similar headed grease-cups of its own manufacture.

still other of its many so-called "combination" patents with which it has harassed the industry for the past 20 years. Thus, the same headed grease-cup (or "nipple") as ininvolved in the case at bar, or the similar but headless "nipple" of its Zerk patent No. 1,475,980 (R pp 546-555), has also been asserted by respondent to be the grease-cup or "nipple" of its still earlier Manzel patent No. 1,459,662, in its recent suits against Rogers and Universal in the Western District of Pennsylvania, in which suits the decision is reported at 15 F. Supp. 410. In these suits of Stewart-Warner v. Universal and Rogers, respondent's

\*The same Manzel patent has also been litigated in each of the following suits:—

Stewart-Warner Corp. v. Air Scale Co. D. C. N. D.

Ohio Eq. 1432; Stewart-Warner Corp. v. Scharoun et al D. C. N. D. N. Y. Eq. 2856;

Stewart-Warner Corp. v. G. C. Smith D. C. S. D. Calif. Eq. 843-S;

Bassick Mfg. Co. v. Allyne-Zerk Co. D. C. N. D. Ohio, E. Div. Eq. 859;

Bassick Mfg. Co. v. Peerless D. C. N. D. Ohio, E. Div. Eq. 1275. Decision reported at 18 Fed. 2, 29;

Bassick Mfg. Co. v. Lyman Mfg. Co. D. C. N. D. Ohio, E. Div. Eq. 1000. Decision reported at 18 Fed. 2, 29:

Bassick Mfg. Co. v. O. K. Mfg. Co. C. C. A. 6th. Decision reported at 18 Fed. 2, 29;

Bassick Mfg. Co. v. Larkin C. C. A. 6th. Decision reported at 18 Fed. 2, 29;

Bassick Mfg. Co. v. Wag's Auto Accessories C. C. A. 6th. Decision reported at 18 Fed. 2, 29;

Bassick Mfg. Co. v. Riggs Tire Co. C. C. A. 6th. Decision reported at 18 Fed. 2, 29;

Alemite v. P. J. Polisch et al D. C. S. D. Calif. Eq. R-15H;

Alemite et al v. D. L. Yant et al D. C. S. D. Calif. Eq. EY-21-J;

Alemite v. Globe Sales Co. et al D. C. Minn. Eq. 2608.

Manzel patent was held invalid on the authority of this Court's decision in the Rogers v. Alemite case (298 U. S. 415) because the claim of the Manzel patent is also drawn to a so-called "combination" of an assertedly improved grease-delivery coupler or nozzle with an admittedly old grease-cup and old pump, and was also being asserted in an effort to monopolize, inter alia, the use of an old pump and an old grease-cup. It is in this same suit that the Butler patent here in suit was also held invalid for the same reason.

Likewise, respondent's own headed grease-cup (or "nipple"), asserted in the case at bar to be the "nipple" of the Butler patent here in suit, is also asserted by respondent to be the grease-cup or lubricant-receiving element of the claims of its earlier Zerk patent No. 1,475,980 (R pp 546-555), in respondent's said suits against Rogers and Universal, in the Western District of Pennsylvania, in which the decision is reported at 15 F. Supp. 410. In these suits, respondent's Zerk Patent was also held invalid on the authority of this Court's decision in the Rogers v. Alemite case (298 U.S. 415) because the claim of the Zerk patent is drawn to a so-called "combination" of an assertedly improved grease-delivery nozzle with an admittedly old grease-cup and old pump, and was also being asserted in an effort to monopolize, inter alia, the use of an old pump and an old grease-cup.

This Zerk patent has also been widely litigated by respondent and its wholly-owned predecessor.

# Respondent's Morris Suits.

Likewise, headed grease-cups (or so-called "nipples") identical with petitioner's and respondent's headed grease-cups or "nipples" (asserted in the case at bar to be the "nipples" of the Butler patent), are also asserted to be the

grease-cups (or "nipples") of respondent's Morris reissue patent 18,278 (R pp 677-693) in at least four other suits:

Stewart-Warner & Lubrication Corp. v. Service et al Equity No. 605, U. S. D. C., N. D. Ind., Hammond Div.

Stewart-Warner & Lubrication Corp. v. Service et al, Equity No. 15,536, U. S. D. C., N. D. Ill., E. Div.

Stewart-Warner & Lubrication Corp. v. J & R Motor Supply, Equity No. 4957, U. S. D. C., E. D. Wisc.

Stewart-Warner & Lubrication Corp. v. Universal Lub. Syst. Inc., Equity No. 3353, U. S. D. C., W. Dist. Pa.

The Morris Reissue patent 18,278 (R 677), just like the Butler patent here in suit, also claims the so-called "combination" of an assertedly improved grease-delivery nozzle or coupler with an old headed grease-cup or "nipple" generically recited in the claim. The Morris reissue patent 18,278 (R. p. 677), while having an effective patent date of April 29, 1930 (and was issued originally about four years after the issue of the Butler patent) claims an effective filing date of August 7th, 1916 (seven years earlier than Butler's filing date).

### Jacques Suits, Sponsored by Respondent.

Respondent has also caused to be asserted against petitioner's herein accused grease-cup (or so-called "fitting" or "nipple") an earlier patent No. 1,383,306 to one Raynaldo P. Jacques, which, like the Butler patent in suit and like respondent's earlier Gullborg patent, is based upon

The fact that respondent sponsors the Jacques suits is clear from Judge Schoonmaker's opinion in Jacques v. Universal, as well as Finding No. 3 adopted by Judge Schoonmaker. These are reproduced at pages 2a and 6a herein.

an asserted improvement in the internal construction or mechanism of a coupler, but claims the assertedly improved coupler in so-called "combination" with the same old headed grease-cup generically included in the patent claims. The three suits in which respondent caused the Jacques patent to be asserted against the same grease-cup and upon the same theory of "contributory" infringement as involved in the case at bar, are:—

- Raynaldo P. Jacques v. Lincoln Engineering Co., Equity No. 11,334, U. S. Dist. Court, E. Dist. Mo., E. Div.
- Raynaldo P. Jacques v. Universal Lubricating Systems Inc., Equity No. 3043, U. S. Dist. Court, W. Dist. Penna.
- Raynaldo P. Jacques v. General Motors Corp., Equity No. 6808, U. S. Dist. Court, E. Dist. Mich., S. Div.

Only the first two of these suits has so far been determined in the lower courts, and only in the Universal case did the Court hand down an opinion.

In the above Universal suit sponsored by respondent, the United States District Court for the Western District of Pennsylvania held that the Jacques patent 1,383,306 (levelled at an identical grease-cup and upon the same theory of "contributory" infringement as is involved in the case at bar) is also controlled by this Court's lecision in Rogers v. Alemite (298 U. S. 415). In Appendix II hereto, we have reproduced the recent (February 4, 1938) and yet unpublished opinion of the United States District Court for the Western District of Pennsylvania in said suit of Jacques v. Universal sponsored by the respondent, together with the findings of fact and conclusions of law adopted by the District Court in that case. A copy of the Jacques patent is

found on pages 715 to 718 inclusive of the Transcript of Record herein, with the peripherally grooved or "headed" grease-cup or lubricant-receiving "fitting" or "nipple" colored blue and with the corresponding part of the claim-language also underscored in blue.

Thus, while respondent has urged in the case at bar that petitioner's otherwise old grease-cup is the grease-cup of the Butler patent because usable with couplers made by respondent (assertedly under its Butler patent), respondent is, at the same time, maintaining in other suits under other of its "combination patents", that the same and other similar grease-cups are the grease-cups of these other "combination patents" because usable with the couplers or nozzles of these other "combination patents."

Respondent thus clearly recognizes and publicly asserts that the headed grease-cup is a device having other uses not complained of herein, and is of wide and general application, and is used with grease-delivery nozzles or couplers other than the coupler made by respondent assertedly under the Butler patent in suit.

#### CONCLUSION.

In view of the above and for the reasons stated more at length in our main brief, we pray that the decision and judgment of the Circuit Court of Appeals for the Seventh Circuit be reversed.

Respectfully submitted,

LEONARD L. KALISH,
DELOS G. HAYNES,
LLOYD R. KOENIG,
Counsel for Petitioner.

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### **APPENDIXES**

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PAGE

#### APPENDIX I.

Paragraph 4 from agreement dated December 11th, 1934 between

Stewart-Warner Corporation and Min-A-Max Co.

The agreement is Defendant's Exhibit 38

in the case of

Min-A-Max versus Sundholm, Eq. No. 437 in the Western District of Iowa, Western Division which is referred to on page 27 of the foregoing brief:

4

"It is understood and agreed that STEWART-WARNER shall have the right, at its own election, to commence and to presecute actions at law and/or suits in equity against infringers of any of the said Min-A-Max Patents, provided, however, that the entire expense of any such litigation shall be borne by STEW-ART-WARNER, and that the recoveries in any such litigation shall inure to the benefit of STEWART-WARNER, and MIN-A-MAX agrees that STEWART-WARNER may commence and prosecute any and all such litigation in the name of MIN-A-MAX, or in the name of MIN-A-MAX jointly with STEWART-WAR-NER, and MIN-A-MAX hereby appoints the solicitors and counsel selected by STEWART-WARNER for the purposes of any and all such litigation, as its solicitors and counsel therefor. MIN-A-MAX shall have the right to employ counsel at its own expense to defend or otherwise protect the interests of MIN-A-MAX in any suit brought by MIN-A-MAX or STEWART-WARNER hereunder STEWART-WARNER agrees to hold MIN-A-MAX free and harmless of any damage the subject of a judgment on a counterclaim asserted against MIN-A-MAX except where such damage is based upon misconduct of MIN-A-MAX."

#### APPENDIX II.

DISTRIST COURT OF THE UNITED STATES, WESTERN DISTRICT OF PENNSYLVANIA.

IN EQUITY. No. 3043.

RAYNALDO P. JACQUES,

VB.

UNIVERSAL LUBRICATING SYSTEMS, INC.

#### OPINION.

(Filed February 4, 1938.)

SCHOONMAKER, Judge:

This is a patent-suit involving Jacques Patent No. 1,383,306 for a connecting device particularly designed for the connecting of a grease-gun to a grease-cup in the lubricating of automobiles. The two claims of the patent are in suit. They are as fellows:

- "1. A connector for lubricating apparatus having, in combination, a nipple with a recessed outer surface, a nozzle having radially movable locking elements co-acting with said recessed nipple, an outer locking sleeve covering said elements in all positions, said sleeve being slidable on said nozzle and having a recess receiving portions of said locking elements when said sleeve is removed from locking position, and a spring effective to hold said sleeve yieldingly in locking position.
- "2. A connector for lubricating apparatus having, in combination, a nipple having a recessed outer suface, a nozzle having radially movable locking elements coacting with said recessed nipple and manual releasing

means normally holding said elements in locking position, said nozzle having a spring pressed plunger with an axially extending passage therethrough for the lubricant and having a conical outer end yieldingly engaging the edge of the axial opening in the nipple and forming a tight connection therewith."

The charge of infringement is that: (1) The defendant has manufactured and sold the entire connector of the patent in suit, namely, both the coupler and the nipple; and (2) the defendant has contributorily infringed the patent by manufacturing and selling nipples of the kind specified in the patent, and defined in its claims and adapted and intended to be used with the Alemite Hydraulic couplers of the Stewart-Warner Corporation, which form with said nipples the connector covered by the claim of the patent in suit.

So far as concerns the charge of contributory infringement, we have precisely the same case of a lubricating device as was presented to this court in the cases of Stewart-Warner Corporation v. Rogers, No. 2983 Equity; and Stewart-Warner Corporation v. Universal Lubricating Systems, Inc. (the same defendant as in the instant suit), No. 3041 Equity, reported in 15 Fed. Supp. 410, where we held the combination claims of the patents there in suit invalid, because the patentees were merely claiming an old combination whose construction and operation are not changed merely by substituing an improved element in the combination for an old element. In this ruling we relied on the decision of the Supreme Court involving a combination of the same elements for lubricating automobiles as that involved in the instant suit: Bassick v. Hollingshead Co., 298 U. S. 415. Relying on these cases, we hold that the defendant has not contributorily infringed the patent in suit.

In this connection, we should note that, although Jacques is the nominal plaintiff in the instant suit, the Stewart-Warner Corporation, the plaintiff in the two suits heretofore decided by the court and reported at No. 15 F. Supp. 410, is the real party in interest in the instant suit by virtue of a patent contract with Jacques (Plff Ex. 7), whereby it controls this suit and holds an exclusive license under the patent in suit, which it may exercise at any time on the payment of \$10.00.

On the charge of direct infringement, the plaintiff fails to make out a case, because neither the Stewart-Warner couplers upon which the suit was founded, nor the defendants' coupler, which was placed before the court by stipulation of counsel, embody the outer slidable manually operable locking sleeve of the Jacques patent in suit. Not only is the construction different, but the mode of operation of the couplers is different. The Jacques coupler may be detached from the grease-cup only by manipulating manually the locking of the outer slidable-locking sleeve, while the Stewart-Warner coupler and the defendant's coupler can be attached to, and detached from the grease-cup without touching the coupler at all, by merely pushing the grease-delivery conduit or pipe of the pump. Then, too, the outer locking sleeve of the Jacques coupler actually locks the coupler, while in the Stewart-Warner's and defendant's coupler, there is no such locking at any time, as the coupler can be detached from the grease-cup by a slight angularity.

In addition to that, we are of the opinion there is no novelty even in the coupler element over the prior art.

Claim 1 of the patent distinguishes from the Ferguson Patent No. 1,324,654 only in reciting that the locking sleeve covers the balls in the structure in all positions. This is a mere arbitrary selection of the direction of movement of the locking sleeve and does not disclose invention.

The Stichler Patents Nos. 1,242,490 and 1,337,288; the Sutton Patent No. 978,957; the Newton Patent No. 1,118,876; and the McMullin Patent No. 1,340,785, all show multijawed chuck-type hose couplers, in which the jaws are never exposed.

The Schmidt Patent No. 1,061,410; Reiness Patent 836,534; Reiness Patent No. 883,422; Bodor Patent No. 1,002,632; Aldridge Patent No. 1,019,938; Sheppard Patent No. 1,053,883; Fischer Patents Nos. 1,089,755 and Reissue 13,009; and the Fassett Patent No. 1,118,518, likewise show multi-jawed chuck-type construction with the external ball-actuating sleeve or the external locking sleeve.

Claim 2 of the patent in suit is invalid, because the coupler construction defined therein is readable upon each of the couplers of each of the two Stichler patents of the Doman patent and of the Paul patent, and does not involve invention over them.

We adopt as our findings of fact and conclusions of law those proposed by the defendant and marked filed therein on December 20, 1937. Appropriate decree in accordance therewith may be submitted.

## FINDINGS OF FACT AND CONCLUSIONS OF LAW. (Filed December 20, 1937.)

This cause having been tried at final hearing, defendant now, in accordance with the directions of the Court, herewith submits its proposed Findings of Fact and Conclusions of Law, and requests the same.

#### FINDINGS OF FACT.

- 1) Plaintiff, Raynaldo P. Jacques, is a citizen of the United States and State of Rhode Island and is a resident of Woonsocket, Rhode Island.
- 2) Defendant, Universal Lubricating Systems, Inc., is a Delaware corporation, a citizen of Delaware, and has its principal place of business at Oakmont, Pennsylvania within the Western District of Pennsylvania.
- 3) Plaintiff, Raynaldo P. Jacques, is vested with the legal title to patent No. 1,383,306, in suit, issued to him on July 5th, 1921, on an application filed August 23rd, 1920, subject to a certain "PATENT CONTRACT" (Plaintiff's Exhibit "7") dated February 16th, 1935, between the plaintiff and the Stewart-Warner Corporation, a Virginia corporation, having its principal place of business at Chicago, Illinois,

under which the Stewart-Warner Corporation paid plaintiff the sum of \$20,000 for an irrevocable and perpetual option for a certain "EXCLUSIVE LICENSE" (Plaintiff's Exhibit "6") under the patent in suit (which license would be subject, however, to one other outstanding non-exclusive license to manufacture and sell under said patent), and under which plaintiff contracted with the Stewart-

Warner Corporation (in further consideration of

the aforesaid sum of \$20,000.00) to bring a patent infringement suit under the patent here in suit charging contributory infringement against headed grease-cups or so-called lubricant-receiving "fittings" or "nipples" like the defendant's herein accused headed grease-cups or "fittings" or "nipples";-said charge of contributory infringement to be based upon the contention that said headed grease-cups or lubricant-receiving "fittings" or "nipples" constituted contributory infringement of the patent in suit because adapted and intended for use with multi-jawed "chuck" type grease-delivery hose-couplers of the kind manufactured and sold by the Stewart-Warner Corporation and sometimes referred to in the trade as the "Alemite Hydraulic" couplers, and

under which the Stewart-Warner Corporation agreed further to pay additional and substantial sums in the event that the patent in suit was adjudicated as valid and contributorily infringed by the manufacture, sale and use of headed grease-cups or so-called "fittings" or "nipples," manufactured and sold by the defendant with knowledge and intent that they were to be used in conjunction with the said "Alemite Hydraulic" couplers, or with other couplers of the form and character such that no other or different question of infringement was involved, which additional sum varied in amount in accordance with the charge and character of such adjudication.

The present suit is in pursuance of said "PATENT CONTRACT" (Plaintiff's Exhibit "7") of February 16th, 1935, between plaintiff and the Stewart-Warner Corpora-

tion, and particularly in pursuance of plaintiff's obligation under paragraph numbered "1" of said Contract.

- 4) The defendant in the present suit is the same corporation as the corporate defendant in Equity suit No. 3041 in this Court, entitled "Stewart-Warner Corporation v. Universal Lubricating Systems, Inc., et al." (in which decision is reported at 15 F. Supp. 410).
- 5) The Stewart-Warner Corporation referred to in the foregoing Finding numbered "3" is the same corporation which is the plaintiff in Equity suit No. 3041 mentioned in the foregoing Finding numbered "4."
- 6) The principal charge of infringement specified by the Bill of Complaint and by plaintiff's Bill of Particulars subsequently filed herein on May 20th, 1935, is that the manufacture and sale by defendant of its headed greasecups or so-called lubricant-receiving "fittings" or "nipples," constitutes contributory infringement of each of the claims of the Jacques patent No. 1,383,306 in suit, because adapted and intended for use with the two different kinds of multi-jawed "chuck" type grease-delivery hose-couplers manufactured and sold by the Stewart-Warner Corporation and which two different kinds of "Alemite Hydraulic" couplers are designated respectively as the "single-seal" and as the "double-seal" couplers-said two different kinds of "Alemite Hydraulic" couplers being both shown in the drawing of Plaintiff's Exhibit "2", and the single-seal "Alemite Hydraulic" coupler being further shown separately in Defendant's Exhibit "97", and the double-seal "Alemite Hydraulic" coupler being further shown separately in Defendant's Exhibit "98."

<sup>•</sup> Infringement charges "A" and "B" set out in Finding of Fact 30, infra.

- 7) The defendant's headed grease-cup or so-called lubricant-receiving "fitting" or "nipple", charged in the present suit to constitute contributory infringement of Jacques patent No. 1,383,306 in the manner set forth in foregoing Finding numbered "6", is precisely the same headed grease-cup or so-called lubricant-receiving "fitting" or "nipple" which in the aforementioned earlier Equity suit No. 3041 in this Court was similarly charged to constitute contributory infringement of Butler patent No. 1,593,791.
  - 8) The Alemite single-seal "Hydraulic" coupler and the Alemite double-seal "Hydraulic" coupler (of Stewart-Warner manufacture), with which defendant's herein accused headed grease-cup or so-called lubricant-receiving "fitting" or "nipple" is charged contributorily to infringe, are precisely the same Stewart-Warner couplers with which the defendant's accused headed grease-cup or "fitting" or "nipple" was charged contributorily to infringe Butler patent No. 1,593,791 in the aforementioned earlier Equity suit No. 3041 in this Court.
  - 9) The Alemite double-seal "Hydraulic" coupler by was not placed on the market by the Stewart-Warner Corporation until some time after defendant had placed on the market its herein accused headed grease-cups or so-called lubricant-fitting "fittings" or "nipples".
  - 10) Subsequent to the filing of the Bill of Complaint in the present suit, defendant also placed on the market and sold a multi-jawed "chuck" type grease-delivery hose-coupler of its own manufacture, as shown in the drawing of

b) involved in infringement-charge "B" in Finding 30, infra.

Plaintiff's Exhibit "3" and also as shown in the drawing of Defendant's Exhibit "99".

- 11) At the trial, it was stipulated by and between counsel for the respective parties that the Court may also determine whether the manufacture and sale of defendant's own multi-jawed "chuck" type grease-delivery hose-coupler shown in Plaintiff's Exhibit "3" and shown in Defendant's Exhibit "99" constituted direct infringement of the Jacques patent No. 1,383,306 when sold with or sold for use with defendant's own herein-accused headed grease-cups or lubricant-receiving "fittings" or "nipples", and whether it constituted contributory infringement when sold for use with or when intended for use with the headed grease-cups or lubricant-receiving "fittings" or "nipples" of Stewart-Warner's manufacture.d)
- 12) The patent in suit relates to conduit couplers or hose-couplers of the quick-attachable-and-detachable type: which the patentee explains in lines 9 and 10 of page 1 of the patent specification is "capable of general application". but was particularly designed by the patentee "for connecting a grease-gun to a grease-cup".
- 13) The patent in suit discloses the old combination of:
  - 1) a grease-cup (or lubricant-receiving "fitting" or "nipple"),

and

2) a hose-coupler (or conduit coupler)

and

3) a grease-delivery pump or so-called "grease-gun".

infra.

constituting infringement-charge "C" in Finding 30, d) constituting infringement-charge "D" in Finding 30,

14) The alleged improvement, if any, of the patent in suit, is in the mechanism or construction or structural characteristics of the particular coupler disclosed in the patent in suit.

The construction and operation of the old combination of:—(a) nipple; (b) coupler; is otherwise unchanged:—that is, the combination is not changed otherwise than by a change in the coupler.

- 15) Instead of just claiming his allegedly improved hose-coupler, per se, (or merely the combination of those elements which constitute the allegedly improved hose-coupler, per se), the patentee claims the combination of his allegedly improved hose-coupler (specifically defined) with the old grease-cup or so-called lubricant-receiving "fitting" or "nipple", which latter is included in the claims in generic and all-inclusive language not distinguishing it from the prior-art "nipples".
- 16) It was old prior to Jacques to use "headed" or peripherally-grooved grease-cups or so-called lubricant-receiving "fittings" or "nipples", affixed to the various bearings of automobiles and other machinery (industrial machinery, farming machinery, etc.) into which lubricant was adapted and intended to be supplied by any suitable lubricant-dispensing pump or compressor or so-called "grease-gun", on the discharge end of which (or on the discharge hose of which) a suitable hose-coupler was provided for the temporary quick-attachable and quick-detachable connection of the lubricant-dispensing pump or "grease-gun" to any of the several grease-cups or lubricant-receiving "fittings" or "nipples".

- 17) The combination of
- a peripherally-grooved or "headed" grease-cup (or so-called "fitting" or "nipple")

#### and

- 2) a groove-engaging or head-engaging hose-coupler and
- a lubricant-dispensing pump or compressor or socalled "grease-gun"

is disclosed in each of the following prior-art patents:

Davis & Jaeschke, 1,150,420, Aug. 17, 1915, (Def's Exh 123);

Seng Re 15,632, June 19, 1923, (Def's Exh 106) (Original Application filed Dec. 23, 1915);

Morris Re 18,278, December 8, 1931, (Def's Exh 146) (Original Application filed Aug. 7, 1916);

Morris 1,962,254, June 12, 1934, (Def's Exh 145) (Original Application filed Aug. 7, 1916);

Fesler 1,315,484, Sept. 9, 1919, (Def's Exh 127);

Winkley Re 14,667, June 10, 1919, (Def's Exh 130) (Original Application filed Oct. 17, 1916);

Martin 1,369,687, Feb. 22, 1921, (Def's Exh 129) (Original Application filed Oct. 4, 1919).

- 18) It was old prior to Jacques to use head-engaging or groove-engaging hose-couplers
- a) both of the fixed-jaw type, as in the Winkley patent Re 14,667 (Def's Exh 130) and in the Morris patents Re 18,278 and 1,962,254 (Def's Exh 145 and 146)

which were applied to "headed or peripherally-grooved grease-cups, ("fittings" or "nipples") by a transverse

movement (that is transversely to the axis of the grease-cup and coupler)

as well as of the movable-jaw type, as that of the Davis & Jaeschke patent 1,150,420 (Def's Exh 123); Seng patent Re 15,632 (Def's Exh 106); Fesler patent 1,315,484 (Def's Exh 127); and Martin patent 1,369,687 (Def's Exh 129)

in which a plurality of radially-movable jaws are provided in the hose-coupler, which jaws are adapted to move inwardly in a radial direction to engage the "head" or groove of the grease-cup or "nipple", and which movable-jawed couplers are applied to the "headed" or grooved grease-cups or "fittings" or "nipples" in a generally axial direction, that is by moving the couplers bodily onto the grease-cup in a generally axial direction.

19) Couplers having a plurality of radially-movable jaws for engaging a peripheral-groove or "head" of some other member to which they are to be connected, were also generally applied as conduit couplers or hose-couplers, prior to Jacques, as shown in the following patents:

Ferguson Patent 1,324,654, Dec. 9, 1919 (Def's Exh 127);

Newton Patent 1,118,876, Nov. 24, 1914 (Def's Exh., 122);

Stichler Patent 1,242,490, Oct. 9, 1917 (Def's Exh 112); Stichler Patent 1,337,288, Apr. 20, 1920 (Def's Exh 131);

Paul Patent 621,276, Mar. 14, 1899 (Def's Exh 118); Ulleland Patent 1,253,309, Jan. 15, 1918 (Def's Exh 129; Nielsen Patent 1,001,069, Aug. 22, 1911 (Def's Exh 121);

McMullin Patent 1,340,785, May 18, 1920 (Def's Exh 128);

Doman Patent 455,180, June 30, 1891 (Def's Exh 117); Sutton Patent 978,957, Dec. 20, 1910 (Def's Exh 119).

20) Jacques' allegedly improved coupler is set forth in the claims as being composed of the following elements:—

#### In Claim 1:

"a nozzle having radially movable locking elements coacting with said recessed nipple, an outer locking sleeve covering said elements in all positions, said sleeve being slidable on said nozzle and having a recess receiving portions of said locking elements when said sleeve is removed from locking position, and a spring effective to hold said sleeve yieldingly in locking position."

#### In Claim 2:

"a nozzle having radially movable locking elements coacting with said recessed nipple and manual releasing means normally holding said elements in locking position, said nozzle having a spring pressed plunger with an axially extending passage therethrough for the lubricant and having a conical outer end yieldingly engaging the edge of the axial opening in the nipple and forming a tight connection therewith."

- 21) Jacques' allegedly improved hose-coupler is composed of:
  - a) a tubular body member or portion designated in the specification as "the nozzle 11".

(the body portion or "nozzle 11" is composed of two portions 17 and 18 threadedly secured

to each other and is secured to and forms an extension of the grease-hose 16.)

This is the "nozzle" in each of claims 1 and 2.

b) radially movable "locking balls 20".

This is defined in each of the claims as "radially movable locking elements", with the further functional or explanatory statement in the claims that these locking elements are intended for "co-acting with" the grease-cups or "nipples" (whenever the coupler is attached to a grease-cup or "nipple").

c) an outer slidable locking sleeve 21, mounted outside "the sleeve 18" which forms a part of the nozzle 11.

This is defined in claim 1 as "an outer locking sleeve covering said elements in all positions, said sleeve being slidable on said nozzle and having a recess receiving portions of said locking elements when said sleeve is removed from locking position" and is defined in claim 2 as "manual releasing means normally holding said elements in locking position."

d) a spring 22 for yieldably moving the locking sleeve 21 in one direction.

This is defined in claim 1 as "a spring effective to hold said sleeve yieldingly in locking position", and is absent from claim 2.

e) a sealing plunger 25, having a convexly conical tip, within and slidable in the body or nozzle 11 (that is, within the portions 17 and 18 composing the nozzle

11) and a spring 28 urging said sealing plunger towards the open end of the coupler.

This is absent from claim 1, but is included in claim 2 as "a spring-pressed plunger with an axially extending passage therethrough for the lubricant, and having a conical outer end." Claim 2 also includes the functional explanatory statement that the conical outer end is for "yieldingly engaging the edge of the axial opening" of the grease-cup or "nipple" and for "forming a tight connection therewith" whenever the coupler is connected on to a grease-cup.

- 22) The feature of claim 1, that the outer locking sleeve covers the radially movable locking elements "in all positions" and that said locking sleeve has "a recess receiving portions of said locking elements when said sleeve is removed from locking position", is not included either in the statement of the invention contained in the specification of the patent in suit, nor is there any mention of it anywhere in the specification of the patent in suit, nor was it included as a feature of Jacques' coupler invention in any of the original claims filed with and forming part of his application as originally filed. This feature was first included in the application (Defendant's Exhibit 94) by amendment filed February 12, 1921, through which claim 1 of the patent was first submitted, without any supplemental oath of the applicant Raynaldo P. Jacques.
- 23) The feature of claim 1, that the outer locking sleeve covers the radially movable locking elements "in all positions" and that said locking sleeve has "a recess receiving portions of said locking elements when said sleeve is re-

moved from locking position", merely goes to the direction of movement of Jacques' outer locking sleeve 21; there being two possible directions of axial movement, both for the locking movement as well as for the unlocking movement. This feature of claim 1 merely represents a statement that Jacques has selected the motion of the sleeve toward the free end of the coupler to unlock, and the motion of the sleeve away from the free end of the coupler to lock.

- 24) It was old prior to Jacques to provide in multi-jawed "chuck" type couplers, a plurality of radially movable locking jaws "covered" by an outer locking sleeve "in all positions" and in which the outer locking sleeve has a "recess receiving portions of said locking elements when said sleeve is removed from locking position". This reversal of the movement of the outer locking sleeve in relation to the locking balls or elements is shown in the Stichler patents Nos. 1,242,490 and 1,337,288; in the Newton patent No. 1,118,876; in the McMullin patent No. 1,340,785; and in the Sutton patent No. 978,957.
  - 25) The choice of moving the locking sleeve in one direction or in the other direction to lock or unlock, is merely an arbitrary choice between two equally old and well-known ways of moving the locking sleeve.
  - 26) The structure defined in claim 1 is fully disclosed in Ferguson patent No. 1,324,654, except for the feature that the outer locking sleeve covers the radially movable locking elements "in all positions" and that said locking sleeve has "a recess receiving portions of said locking elements when said sleeve is removed from locking position"; which feature was old in the multi-jawed "chuck" type hose-couplers of Stichler patents Nos. 1,242,490 and 1,337,-

288; Newton patent No. 1,118,876; McMullin patent No. 1,340,785, and Sutton patent No. 978,957.

- 27) It involved nothing more than mere mechanical skill to reverse the direction of movement of the locking sleeve 22 of the Ferguson patent No. 1,324,654.
- 28) The coupler part of claim 1, reading "a nozzle having radially movable locking elements " ", an outer locking sleeve covering said elements in all positions, said sleeve being slidable on said nozzle and having a recess receiving portions of said locking elements when said sleeve is removed from locking position, and a spring effective to hold said sleeve yieldingly in locking position", is fully readable upon the couplers of each of the Stichler patents Nos. 1,242,490 and 1,337,288.
- having radially movable locking elements • • and manual releasing means normally holding said elements in locking position, said nozzle having a spring-pressed plunger with an axially extending passage therethrough for the lubricant and having a conical outer end yieldingly engaging the edge of the axial opening in the nipple (or the other coupled member) and forming a tight connection therewith', is fully readable upon the Stichler patent No. 1,242,490, while the patent to Paul, No. 621,276, and the patent to Ulleland, No. 1,253,309, fully responds to the coupler language of claim 2, except for the reversal of the conical surface onto the "nipple" device.
- 30) The claims of the patent in suit are not readable upon, nor found in, the assemblage of equipment variously charged to infringe,\* to wit:

- A defendant's "headed" grease-cup or so-called "fitting" or "nipple"
- B defendant's "headed" grease-cup or so-called "fitting" or "nipple"
- C defendant's "headed" grease-cup or so-called "fitting" or "nipple"
- D Stewart-Warner's
  "headed" grease-cup or
  so-called "fitting" or
  "nipple", designated in
  Stewart-Warner's trade
  as the "Hydraulic fitting"

- plus Stewart Warner's

  "single-seal" Alemite Hydraulic
  coupler
- plus Stewart Warner's
  ''double-seal'' Alemite Hydraulic
  coupler
- plus Defendant's "Hookon" coupler
- plus Defendant's "Hookon" coupler

because neither one of the two Stewart-Warner couplers, involved in infringement-charges A & B, nor the defendant's coupler, involved in infringement-charges C & D, includes "an outer locking sleeve " slidable on said nozzle", as required by claim 1 in suit, or "manual releasing means normally holding said elements in locking position", as required by claim 2 in suit, and because none of said couplers include a "conical outer end" on a sealing plunger, as required by claim 2 in suit.

<sup>•</sup> infringement-charges A and B were the sole basis for the Bill of Complaint, as set forth in foregoing Finding 6. infringement-charges C and D are predicated on a defendant's coupler subsequent to the Bill of Complaint, as set forth in foregoing Finding 10, and infringement-charges C and D are before the Court solely by virtue of stipulation of Counsel, as set forth in Finding 11.

#### CONCLUSIONS OF LAW.

- 1. Plaintiff is sufficiently vested with the legal title to the patent in suit to stand alone as the party plaintiff in this suit.
- 2. The patent in suit is prima facie not infringed because each of the couplers relied upon by plaintiff on its several charges of infringement, set forth in Finding of Fact numbered "30", lacks the outer manually slidable locking sleeve of the Jacques coupler, which locking sleeve is variously defined in each of the claims in suit, and because each of the couplers relied upon by plaintiff on its several charges of infringement lacks a plunger with a conical outer end, as required by claim 2 in suit.
- 3. The prima facie non-infringement, appearing from the face of the patent in suit, and from a comparison of the claims of the patent in suit with the devices charged to infringe, entitles defendant to a dismissal of the Bill of Complaint without reference to any of the evidence adduced at the trial.
- 4. Plaintiff's charge of infringement, directed against defendant's accused "headed" grease-cup or so-called "fitting" or "nipple", must also fail under the ruling of the United States Supreme Court upon the combination claims 1 to 6 and 8 & 10 of Gullborg Patent 1,307,734, in Rogers v. Alemite Corporation, 298 U. S. 415, because plaintiff may not have a monopoly of old "headed" or peripherally-grooved grease-cups, "fittings" or "nipples", which may be used with couplers assertedly embodying the alleged coupler improvement of the patent in suit.
- 5. Each of the claims of the patent in suit must be held invalid under the ruling of the United States Supreme Court upon the combinations claims 1 to 6 and 8 & 10 of

Gullborg Patent 1,307,734, in Rogers v. Alemite Corporation, 298 U. S. 415, because claiming (or drawn to) an old and exhausted combination (of "headed" grease-cup and head-engaging coupler), whereas the patentee's invention or contribution, if any, is merely in the internal construction or mechanism of the coupler; and the construction and operation of the combination of grease-cup and coupler is otherwise unchanged; and the patentee is merely claiming an old combination, whose construction and operation is not changed merely by substituting an allegedly improved coupler of this combination for an old coupler.

- 6. Each of the claims of the patent in suit is invalid because not in accordance with Section 4888 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 33), in that the patentee has failed to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery", and on the contrary, the patentee has, in his patent claims, co-mingled that which was in the public domain (the grease-cup or "nipple") with that which was assertedly improved or invented by him (the coupler).
- 7. Each of the claims of the patent in suit is invalid because the assertedly improved coupler, purported to be defined therein, was anticipated by the prior art.
- 8. Each of the claims of the patent in suit is invalid because the assertedly improved coupler, purported to be defined therein, did not involve invention over the prior art.
- 9. The Bill of Complaint must be dismissed with costs to defendant.

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CHARLES ELMORE CROPLEY

IN THE

### Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

228.

STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARL

LYNN A. WILLIAMS,

Counsel for Respondent.

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PAGE

### INDEX.

		age	
•	The Petitioner's Real Complaint Is Not That the Seventh Circuit Court of Appeals Misunderstood or Misstated the Law, but Rather That the Court Did Not Find the Facts to Be What the Petitioner Asserted Them to Be	1	
	The United States District Court for the Western District of Pennsylvania Held the Butler Patent in Suit to Be Invalid. An Appeal Is Pending. It Remains to Be Seen Whether the Third Circuit Court of Appeals Will Agree With or Disagree With the Seventh Circuit Court of Appeals	3	
	Counsel for Petitioner Realize That a Conflict of Decision Between the Seventh Circuit Court of Appeals and the District Court for the Western District of Pennsylvania in a Case Now on Appeal to the Third Circuit Court of Appeals and as Yet Unheard and Undecided, Would Probably Not Result in the Grant of a Writ of Certiorari.	4	
	All of the Questions Raised by the Petition Involve Pure Questions of Fact	5	*
	As Between the Seventh Circuit Court of Appeals and the Eighth Circuit Court of Appeals, There Is No Conflict of Decision on the Same Matter	5	
	The Jiffy Company's Combination Did Not Comprise a Nipple Having a Head or a Throat or a Shoulder, Nor Did It Have Locking Elements or Jaws Adapted For Cooperation With Such a Headed Nipple, and Was Held, Therefore, by the Eighth Circuit Court of Appeals, Not to Infringe Claim 1 of the Butler		
	Patent	7	

10	vided With "a Head, a Throat, and a Shoulder, and Segments Adapted to Slip Over the Head of Such a Nipple and Embrace the Throat Thereof," i. e., the Very Things Which the Eighth Circuit Court of Appeals Expressly Held to Be Lacking in the Nipple of the Lifty Company's Combination	
	of the Jiffy Company's Combination	9
T	he Eighth Circuit Court of Appeals Held Claim 1 of the Butler Patent to Be Valid Despite the Fact That Plaintiff Had Not Made or Sold Any Lubricating Equipment in Conformity With the Details Shown and Described in the Drawings and Specifications of the Butler Patent	10
T	he Question Whether or Not the Plaintiff's Commercial Equipment Embodied Either of the Claims of the Butler Patent Was Not at Issue at All in the Suit Against the Jiffy Company	11
T	he Eighth Circuit Court of Appeals Held That One Certain Device Did Not Infringe Claim 1. The Seventh Circuit Court of Appeals Held That an Entirely Different Device Did Infringe Claim 2. No Matter What the Decisions of the Two Courts Might Have Been, Their Conclusions in Respect of This Matter of Infringment Must Necessarily Have Been "Different Conclusions".	12
Si	of the Seventh Circuit Court of Appeals and the Eighth Circuit Court of Appeals on the Same Mat- ter, Counsel for Petitioner Have Found It Expedient	
	to Present a Disingenuous Statement and Argument	14

Accord With the Eighth Circuit Court of Appeals That the Plaintiff-Respondent's Commercial Equipment Does Not Correspond With the Details of Any of the Drawings and Specifications of the Butler Patent	15
Some Examples of the Petitioner's Many Times Reiterated Misrepresentation That the Plaintiff-Respondent's Alemite Hydraulic Equipment Involved a Question in Issue and Was Held by the Eighth Circuit Court of Appeals Not to Embody the Invention Covered by Claim 1 of the Butler Patent.	16
Even the Typography of the Petitioner's Brief Is Availed of by Counsel for Petitioner to Aid in the Sustained Disingenuousness of Their Presentation	18
The Real Test of Conflict or Lack of Conflict in the Decisions of the Two Courts of Appeal Is to Be Found in a Comparison of the Decrees of the Two Courts	19
The Lincoln Company Could Make, Use, and Sell Devices Identical With Those Made and Sold by the Jiffy Company and in Issue Before the Eighth C. C. A., Without Violating the Decree or the Injunction of the Seventh C. C. A.	20
In Summary, Then, Relative to the Petitioner's "Point I"	21
Relative to Petitioner's "Point II": The Misnomers Employed by Counsel for the Petitioner Do Not De- scribe Either the Case Which Was Presented by the Plaintiff-Respondent or the Case Which Was Decided by the Seventh Circuit Court of Appeals	22
The Opinion of the Seventh Circuit Court of Appeals Refers to and Discusses the Decision of This Court In Rogers vs. Alemite, and Expressly Recognizes It as Stating the Law Which Is to Be Observed, Re-	
spected, and Applied by the Lower Courts	23

The Seventh Circuit Court of Appeals Emphasized by the Use of Italics That Part of Your Honors' Deci- sion in the Rogers and Hollingshead Cases Which Distinguishes, Reconciles, and Harmonizes It With	
the Age-Old Law Which Has Been Observed and Applied by All of the Federal Courts	24
The Seventh Circuit Court of Appeals Determined as a Matter of Fact That Butler Brought Together a	
New Combination of Old Elements in Such a Way as to Involve a New Construction, a New Mode of Op- eration, and a New and Unitary Result, and That	-
He Did Not Merely "Improve One Element of an Old Combination Whose Construction and Operation Is	26
Otherwise Unchanged'  As Against the Petitioner's Pretended Statement of the Facts, We Contrast the Real Facts as Determined by the Seventh Circuit Court of Appeals,—	20
and Solely in the Language Employed and Adopted by That Court.	27
We Venture to Suggest That No Court Has Ever More Carefully, More Accurately, or With Greater Clar- ity, Stated the Law of Contributory Infringement and the Law of Patentable Combination, Than in This Opinion of the Seventh Circuit Court of Appeals	
Not Even Counsel for the Petitioner Advance a Single Word in Criticism of the Law as Fully and Explicitly	36
Stated in the Opinion of the Seventh Circuit Court	
	43
It Is Only by Assuming That the Facts Are as Stated by Counsel for the Petitioner, Rather Than as Stated	
by the Court of Appeals That Counsel Put Them- selves in Position to Assert, as They Do, the Con- clusion That the Court of Appeals Has Rendered a	13
Decision Which Is "in Direct Conflict" With Both the Recent Decisions of This Court and the Earlier Decisions of This and Other Federal Courts On a	
Point of Law	44

The state of the s	
What Are the Facts? That Is the Sole Question 44	
Relative to the Petitioner's "Point III" Variant of Its	
Relative to the Petitioner's 1 that 222	
Point II Contentions Cooks to Secrete a	
Under Point IV-a the Petitioner Seeks to Secure a	
De Novo Consideration and Decision of This Court	
Relative to Alleged Violations of the Clayton Act,—	
a Defense Which Was Never Pleaded, Never Offered, Never Urged, Never Considered, Never Decided,	
Never Urged, Never Considered, Nover Mentioned, Throughout All of the Proceedings	
Never Mentioned, Throughout An of the First in the Lower Courts. It Now Appears for the First	
Time and Your Honors Are Invited to Decide the	
Contention Without Having the Benefit of Any Evi-	
dence by Any Party4	7
The Petitioner's Point IV-b Is That the Lincoln Com-	
pany Was Impliedly Licensed to Sell the Various	
Parts of the Butler Invention. The Defense of Li-	
Cannot Re Made Unless Pleaded. It was	
Never Pleaded, Never Suggested, Never Urged,	
Never Considered, Never Decided, Never Mentioned	
Prior to the Advent of This Petition in the Supreme	
Court Petitioner Is Asking for a De Novo Consid-	
ention and Decision Upon a Contention Relative to	
Which No Party Has Offered Any Evidence what-	
COOVER	48
In General, Relative to the Petitioner's Points IV-a	
and TV-b	49
	50
III CONDITION	

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PAGE

## Supreme Court of the United States

No. 608

Остовив Тивм, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

08.

STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARL

THE PETITIONER'S REAL COMPLAINT IS NOT THAT THE SEVENTH CIRCUIT COURT OF APPEALS MISUNDERSTOOD OR MISSTATED THE LAW, BUT RATHER THAT THE COURT DID NOT FIND THE PACTS TO BE WHAT THE PETITIONER ASSERTED THEM TO BE.

Not every lawsuit involves new and important questions of law. This is as true of patent infringement suits as of other kinds of suits.

In the vast majority of cases, the requisite principles of law are thoroughly well settled. The only questions involve a determination of the facts.

Every defeated litigant who hopes to secure & review and a reversal in the United States Supreme Court, realizes that this Court cannot occupy itself with the mere redetermination of the facts. It is for this reason, doubtless, that every petitioner for a writ of certiorari tries to contort his case into one which involves new and important questions of pure law.

The petition herein has to do with another patent infringement suit of that character. If the facts are what the District Court and the Seventh Circuit Court of Appeals found them to be, then everyone must concede that the decision conformed with well-established law.

Counsel for the petitioner realize, of course, that they cannot secure a writ of certiorari by coming into this Court with the straightforward contention that the Seventh Circuit Court of Appeals decided this case under an alleged misconception of the facts.

On the other hand, they cannot find in the very full opinion of the Seventh Circuit Court of Appeals, any expression or any statement or any exposition of the law which can even be claimed to be at variance with the law as determined by this Court and as applied by all of the circuit courts of appeal.

Counsel for the petitioner find it necessary, therefore, to adopt an expedient. It is an old and often tried expedient. Counsel have recourse to the phrase, "in effect." The Circuit Court of Appeals is said to have held "in effect" that the law is black, whereas in truth the law is white. "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the inventor of a presumably "" (Petitioner's Brief, p. 6). "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that one who has presumably invented """ (Petitioner's Brief, p. 6). "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that a patentee may use the patent """ (Petitioner's Brief, p. 6). "The Court of

Appeals for the Seventh Circuit erred in holding, in effect, that the owner of the patent can extend the monopoly

"" (Petitioner's Brief, p. 6). "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that a patentee, by improving one element """ (Petitioner's Brief, p. 7). Etc., etc.

"In effect"!

If the facts are as the Court has found them to be, then its decision recognizes and applies the white law just as it really is. If, on the other hand, the facts are what the petitioner claims them to be, then the decision of the Court must necessarily mean that it thinks the law is black.

"The Seventh Circuit Court of Appeals held, in effect, that the law is black"—such is the gravaman of the petition.

The petitioner's real complaint is not that the Court misunderstood or misstated the law, but rather that the Court did not find the facts to be what the petitioner asserted them to be.

THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA HELD THE BUTLER PATENT IN SUIT TO BE INVALID. AN APPRAL IS PENDING. IT REMAINS TO BE SEEN WHETHER THE THIRD CIRCUIT COURT OF APPEALS WILL AGREE WITH OR DISAGREE WITH THE SEVENTH CIRCUIT COURT OF APPEALS.

Counsel for the petitioner devote seventy-three pages of their petition and brief to the development of the "conclusion" (Petitioner's Brief, p. 48) that the decision and judgment of the Circuit Court of Appeals for the Seventh Circuit involves six so-called "direct conflicts"—all separate and distinct from one another.

These six alleged "conflicts" include one real conflict.

This one real conflict is a conflict between the decision of the District Court for the Western District of Pennsyl-

vania on the one hand, and the decision of the Circuit Court of Appeals for the Seventh Circuit on the other hand.

In the instant suit, Judge Lindley, sitting in the District Court for the Northern District of Illinois, held claim 2 of Butler patent No. 1,593,791, to be valid and to have been contributorily infringed by the Lincoln Company's sale of one of the connector parts of the new combination claimed in the Butler patent.

The Seventh Circuit Court of Appeals affirmed Judge Lindley's decree.

In the District Court for the Western District of Pennsylvania, in a suit alleging identically similar acts to constitute a contributory infringement, Judge Schoonmaker held this same claim 2 of the Butler patent to be invalid. In that suit, the plaintiff, Stewart-Warner Corporation, has taken an appeal to the Court of Appeals for the Third Circuit. But the Third Circuit Court of Appeals has not yet even heard this appeal,—nor of course rendered any decision.

It remains to be seen, therefore, whether the Third Circuit Court of Appeals will agree with or disagree with the Seventh Circuit Court of Appeals.

COUNSEL FOR PETITIONER REALIZE THAT A CONFLICT OF DECISION BETWEEN THE SEVENTH CIRCUIT COURT OF APPEALS AND THE DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA IN A CASE NOW ON APPEAL TO THE THIRD CIRCUIT COURT OF APPEALS AND AS YET UNHEARD AND UNDECIDED, WOULD PROBABLY NOT RESULT IN THE GRANT OF A WRIT OF CERTIORARI.

Counsel for the petitioner are of course sufficiently familiar with the rules and policies of this Court to realize that a conflict of decision between the Seventh Circuit Court of Appeals on the one hand, and the District Court for the Western District of Pennsylvania on the other

hand, would probably not result in the grant of a writ of certiorari to the Seventh Circuit Court of Appeals. Counsel have found it expedient, therefore, to present five other contentions, all, however, under the appellation of "direct conflict."

This one real conflict, i. e., the conflict of decision between the Court of Appeals for the Seventh Circuit on the one hand, and the District Court for the Western District of Pennsylvania on the other hand, is thrown into the petitioner's petition for a writ of certiorari as an element of defensive coloration. It is not—and could not well be—one of the formal "reasons relied upon for allowing the writ of certiorari," as set forth in the petition for a writ of certiorari.

### ALL OF THE QUESTIONS RAISED BY THE PETITION INVOLVE PURE QUESTIONS OF FACT.

Although counsel for petitioner have attempted to capture and engage the interest of this Court by contorting their contentions into asserted conflicts of decision upon pure questions of law, it will be found that the petitioner's contentions resolve themselves into the complaint that the facts are not what the Seventh Circuit Court of Appeals found and held them to be.

# AS BETWEEN THE SEVENTH CIRCUIT COURT OF APPEALS AND THE EIGHTH CIRCUIT COURT OF APPEALS, THERE IS NO CONFLICT OF DECISION ON THE SAME MATTER.

In the instant suit against the Lincoln Engineering Company, the Seventh Circuit Court of Appeals found the Butler patent to be valid.

In the suit against the Jiffy Company, the Eighth Circuit Court of Appeals also found the Butler patent to be valid, saying, at 81 Fed. (2d) 786, 791:

"We think that when we allow to the Butler patent

such presumption of validity as its issue by the Patent Office would entitle it to " " that the defense of anticipation for want of novelty was not sustained."

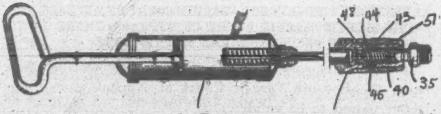
In the instant suit against the Lincoln Company, the Seventh Circuit Court of Appeals decided that the defendant's sale of a shouldered or headed nipple like that illustrated in the accompanying Fig. 1 (R. p. 397) involved a



F16. 1.

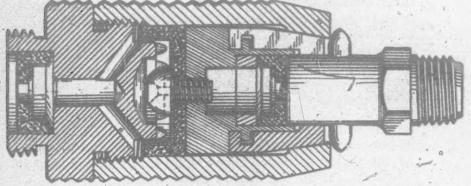
This cut illustrates the shouldered and headed nipple, the sale of which by the Lincoln Engineering Company was held by the Seventh Circuit Court of Appeals to involve a contributory infringement of claim 2 of the Butler patent.

contributory infringement of claim 2 of the Butler patent. This was for the reason that the defendant manufactured and sold this element of claim 2 with the knowledge and intent that it would be used as a part of the complete combination of claim 2 as illustrated in the accompanying Fig. 2 (R. p. 319).



Frg. 2.

This out illustrates the complete lubricating equipment held by the Seventh Circuit Court of Appeals to embody the invention of claim 2 of the Butler patent, and of which the Lincoln Company's shouldered and headed nipple constituted a part. In the suit against the Jiffy Company, the Eighth Circuit Court of Appeals held that the Jiffy Company's sale of a compressor having coupler mechanism of the kind illustrated in the accompanying Fig. 3 (R. p. 363 of the record



Frg. 3.

This cut illustrates the connector parts of the lubricating apparatus which was held by the Eighth Circuit Court of Appeals not to infringe claim 1 of the Butler patents

in Stewart Warner v. Jiffy, No. 114, October Term, 1936), did not involve an infringement of a different claim of the Butler patent, namely, claim 1.

THE JIFFY COMPANY'S COMBINATION DID NOT COMPRISE A NIPPLE HAVING A HEAD OR A THROAT OR A SHOULDER, HOR DID IT HAVE LOCKING ELEMENTS OR JAWS ADAPTED FOR COOPERATION WITH SUCH A HEADED NIPPLE, AND WAS HELD, THEREFORE, BY THE EIGHTH CERCUIT COURT OF APPEALS, NOT TO INFRINGE CLAIM 1 OF THE BUTLER PATENT.

In reaching its conclusion that the device sold by the Jiffy Company did not infringe claim 1 of the Butler patent, the Eighth Circuit Court of Appeals restricted claim 1 to a construction which involved the latching of the locking elements to the throat of a nipple having a head and a shoulder and a throat. It held that the Jiffy Company's device did not involve this construction and that it did not, therefore, infringe claim 1 of the Butler patent. These distinc-

tions which thus avoided infringement of claim 1 of the Butler patent were stated by the Eighth Circuit Court of Appeals as follows:

"But when we turn to the Butler patent specifications disclosing the 'means' he had in mind for 'compressively engaging about the nipple for locking said parts together,' we find no reference to any elements corresponding to such positive wedging means as above described. He describes a nipple having a head, a throat, and a shoulder, and segments adapted to slip over the head of such a sipple and embrace the throat thereof. Then he specifies spring fingers mounted on the forward face of the piston. Ample room is left in the cylinder for the free play of the spring fingers. As the piston is moved forward by the pressure of the lubricant, the spring fingers do engage and press upon the segments so that the segments are pressed upon the throat of the nipple. But the nipple is not specified to be held against longitudinal displacement by the force of the gripping. The language of the specifications is that the segments are held in position on the throat by the spring fingers, but it is the 'shoulder' on the nipple which 'prevents the retraction of the segments' or pulling away from the nipple. We conclude from consideration of all the specifications and the drawing that the inventor excluded disclosure of elements which would be actuated by the forward movement of the piston to lock the coupler to the nipple by any unyielding action, but that he disclosed only such a yielding compression as would be accomplished by spring fingers." (81 Fed. (2d) 786, 792-3.) (Italics ours.)

The Jiffy Company's combination, as is illustrated in the accompanying Fig. 3, did not comprise a nipple having a head of a throat or a shoulder, nor did it have locking elements or jaws adapted for cooperation with such a headed nipple. It did not, therefore, in the opinion of the Eighth Circuit Court of Appeals as expressed in the foregoing excerpt, involve any infringement of claim 1 of the Butler patent. This was for the reason that claim 1

of the Butler patent must be interpreted and limited in the light of the specifications and drawings to include these features,—features which the Jiffy Company's construction did not embody.

IN THE LINCOLN CASE, THE DEFENDANT'S NIPPLE WAS PRO-VIDED WITH "A HEAD, A THROAT, AND A SHOULDER, AND SEGMENTS ADAPTED TO SLIP OVER THE HEAD OF SUCH A MIPPLE AND EMBRACE THE THROAT THEREOF," I. e., THE VERY THINGS WHICH THE EIGHTH CIRCUIT COURT OF AP-PEALS EXPRESSLY HELD TO BE LACKING IN THE MIPPLE OF THE JIFFY COMPANY'S COMBINATION.

In the suit against the Lincoln Company, decided by the Seventh Circuit Court of Appeals, the defendant's nipple did have "a head, a throat, and a shoulder, and segments adapted to slip over the head of such a nipple and embrace the throat thereof," i.e., the very things which the Eighth Circuit Court of Appeals expressly held to be lacking in the nipple of the combination for which the Jiffy Company's device was sold. Certainly, the decision of the Seventh Circuit Court of Appeals that the Lincoln Company infringed by selling a thing having all of these features, was not in conflict with the decision of the Eighth Circuit Court of Appeals that no infringement was involved in the Jiffy Company's sale of a device having none of these features.

IT IS ONLY WHEN THE VALIDITY OF THE PATENT IN SUIT IS IN DOUBT UPON THE SCORE OF INVENTION THAT PROOFS OF COMMERCIAL SUCCESS ARE ADMISSIBLE TO RESOLVE THE DOUBT IN FAVOR OF VALIDITY.

In the suit against the Jiffy Company, the defendant contended that the Butler patent was invalid. In answer to this contention and in support of the validity of the patent, the plaintiff undertook to show that it had sold a great quantity of lubricating equipment embodying the invention described in claim 1 of the Butler patent. The reason was, of course, that in case of doubt as to the validity of a patent claim, that doubt may be resolved in favor of the validity of the patent by proof of notable commercial success in the manufacture and sale of the device of the patent. Such proofs were not admissible for any other purpose.

As was said by this Court in its opinion in the recent case of *Paramount* v. *American Tri-Ergon*, 294 U. S. 463, 79 L. Ed. 997, 1003 (March 4, 1935—Opinion by Mr. Justice Stone):

"Respondents also allege that the positive film produced by its method is more useful than any it had been possible to produce by other methods, and that it has found all but universal acceptance. These considerations, it is urged, should turn the scale in favor of invention.

"Laying aside the objection that it is only when invention is in doubt that advance in the art may be thrown in the scale, DeForest Radio Co. v. General Electric Co., 283 U. S. 664, 685, 75 L. ed. 1339, 1348, 51 S. Ct. 563; Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 495, 496, 23 L. ed. 952, 954, 955, we think the evidence of utility and prompt acceptance of the patented method, in the circumstances of this case, adds little weight to the claim of invention." (Emphasis ours.)

THE EIGHTH CIRCUIT COURT OF APPEALS HELD CLAIM 1 OF THE BUTLER PATENT TO BE VALID DESPITE THE FACT THAT PLAINTIFF HAD NOT MADE OR SOLD ANY LUBRICATING EQUIPMENT IN CONFORMITY WITH THE DETAILS SHOWN AND DESCRIBED IN THE DRAWINGS AND SPECIFICATIONS OF THE BUTLER PATENT.

The Eighth Circuit Court of Appeals did not hold that the Alemite Hydraulic lubricating equipment sold by the plaintiff, Stewart-Warner Corporation, did not realize or embody the invention set forth in the claims of the Butler patent. What the Eighth Circuit Court of Appeals did say in this connection was that

"The plaintiff has not made or sold any coupler constructed according to the above drawing and specifications of its Butler patent \* \*." (81 Fed. (2d) 786, 788)

The Eighth Circuit Court of Appeals held claim 1 of the Butler patent to be valid, despite the fact that the plaintiff had not "made or sold any coupler constructed according to the above drawing and specifications of its Butler patent."

This all means merely that the Eighth C. C. A.'s holding of validity with respect to claim 1, was not due to the plaintiff's alleged commercial success of the invention disclosed in Butler's drawings and specifications. It was due to conclusions reached upon other grounds.

THE QUESTION WHETHER OR NOT THE PLAINTIFF'S COMMERCIAL EQUIPMENT EMBODIED EITHER OF THE CLAIMS OF THE BUTLER PATENT WAS NOT AT ISSUE AT ALL IN THE SUIT AGAINST THE JIFFY COMPANY.

There was, of course, therefore, no decision upon the question whether the plaintiff's Alemite Hydraulic equipment embodied the combination of elements set forth in claim 1 (much less the combination of elements set forth in claim 2, which alone was involved in the Lincoln case and which was not involved at all in the Jiffy case). Indeed, the question whether or not the plaintiff's Alemite Hydraulic equipment embodied either of the claims of the Butler patent, was not at issue at all in the suit against the Jiffy Company. The only questions at issue were

- (a) the validity of claim 1; and
- (b) the defendant's infringement of claim 1. The issue of validity was decided in favor of the plaintiff. The issue of infringement was decided in favor of the defendant.

This involved simply and solely the determination that the defendant Jiffy Company's device did not embody the combination of elements set forth in claim 1.

In so far as the plaintiff's proofs of its sales of the Alemite Hydraulic equipment were concerned, the holding of validity by the Eighth Circuit Court of Appeals was in conformity with the plaintiff's contentions (although upon grounds other than that of the plaintiff's commercial success).

THE EIGHTH CIRCUIT COURT OF APPEALS HELD THAT ONE CERTAIN DEVICE DID NOT INFRINGE CLAIM 1. THE SEVENTE CIRCUIT COURT OF APPEALS HELD THAT AN ENTIRELY DIFFERENT DEVICE DID INFRINGE CLAIM 2. NO MATTER WHAT THE DECISIONS OF THE TWO COURTS MIGHT HAVE BEEN, THEIR CONCLUSIONS IN RESPECT OF THIS MATTER OF INFRINGEMENT MUST NECESSARILY HAVE BEEN "DIFFERENT CONCLUSIONS."

It is true, of course, that the Seventh Circuit Court of Appeals reached what might very appropriately be called a "different conclusion" from that reached by the Eighth Circuit Court of Appeals. This was necessarily so, because the issues of infringement were entirely different in the two suits. The Eighth Circuit Court of Appeals held that one certain device did not infringe claim 1. The Seventh Circuit Court of Appeals held that an entirely different device did infringe claim 2. No matter what the decisions of the two courts may have been, their conclusions in respect of this matter of infringement must necessarily have been different. The Seventh Circuit Court of Appeals held that the Lincoln Company's sale of a nipple having "a head, a throat, and a shoulder," did involve infringement of claim 2. If the Eighth Circuit Court of Appeals had held that the Jiffy Company's sale of its compressor and coupler mechanism did involve infringement of claim 1, the two courts would unavoidably have reached different conclusions. This was inevitable, simply because of the difference in the questions to be decided.

When, therefore, the two courts had before them two different claims, and had before them two entirely different issues of infringement, it can doubtless be said that the two courts reached "different conclusions." It cannot be truthfully said, however, that such different conclusions relative to such different matters involved a decision by one Circuit Court of Appeals "in conflict with the decision of another circuit court of appeals on the same matter."

It must have been evident to counsel for the petitioner that they could not spell out of the real facts of the decision of the Eighth C. C. A. in the Jiffy case, and of the decision of the Seventh C. C. A. in the instant suit against the Lincoln Company, any real or substantial conflict of decision between the two courts. Counsel for the petitioner were apparently familiar with such decisions of this court as that in Lane & Bowler Corp. v. Western Well Works, 261 U. S. 387, where, at page 393, this court said:

"" it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

The first sentence of that same opinion is, "This is an ordinary patent case."

SINCE THERE IS NO REAL CONFLICT BETWEEN THE DECISIONS
OF THE SEVENTH CIRCUIT COURT OF APPEALS AND THE
EIGHTH CIRCUIT COURT OF APPEALS ON THE SAME MATTER, COUNSEL FOR PETITIONER HAVE FOUND IT EXPEDIENT TO PRESENT A DISINGENUOUS STATEMENT AND ARGUMENT.

In the hope, therefore, of capturing the attention and interest of this Court, counsel for the petitioner have found it expedient to present a rather disingenuous statement and argument relative to the allegation of conflict between the decisions of the Seventh and Eighth circuit courts of appeal.

On page 788 of Volume 81 of the Federal Reporter, Second Series, the Eighth Circuit Court of Appeals said that

"The plaintiff has not made or sold any coupler constructed according to the above drawing and specifications of its Butler patent \* \* ."

Again on page 789 of its opinion, the Court referred to the fact that

"The plaintiff had not manufactured for sale any couplers according to the drawing or specifications on which the claim in suit reads."

In so far as the language or any possible interpretation of the claim is concerned, no one has ever suggested that the claim did not read upon the structure shown in the drawing and described in the specification of the Butler patent. The Eighth C. C. A. here referred quite incidentally to this fact. No one has ever questioned the correctness of this incidental statement.

THE SEVENTH CIRCUIT COURT OF APPEALS IS IN COMPLETE ACCORD WITH THE EIGHTH CIRCUIT COURT OF APPEALS THAT THE PLAINTIPF-RESPONDENT'S COMMERCIAL EQUIPMENT DOES NOT CORRESPOND WITH THE DETAILS OF ANY OF THE DRAWINGS AND SPECIFICATIONS OF THE BUTLER PATENT.

The opinion of the Seventh Circuit Court of Appeals is, however, in complete accord with that of the Eighth Circuit Court of Appeals, to the effect that the plaintiff-respondent's commercial equipment was not made in accordance with the drawings and specifications of the Butler patent. The two courts were in complete agreement upon this matter. Judge Evans' opinion for the Seventh Circuit Court of Appeals states this agreement with the Eighth Circuit Court of Appeals, saying in this connection, however, that

fully represents the concept of the inventor. Figures which accompany the patents are often presented merely to elucidate the thought expressed in the specifications. Their study is decidedly helpful in most cases, but it can hardly be expected that all of the possible variations in structure will be set forth in specifications or drawings. Frequently the improved type is described in detail. True, there are instances where specificity is necessary in order to distinguish the invention from the prior art. More frequently however, it is the principle of operation which is being illustrated rather than an effort to confine the invention to the exact figures shown in drawings.

"Our conclusion is that such departures from the Butler patent as were made in the commercial structures were nevertheless the equivalent of the Butler claim, and they embodied the mechanical principles which were described in the Butler patent." (91 Fed.

(2d) 757, 766.)

The Eighth Circuit Court of Appeals did not say anything which was in any wise inconsistent with these views as thus expressed by the Seventh Circuit Court of Appeals.

SOME EXAMPLES OF THE PETITIONER'S MANY TIMES REITERATED MISREPRESENTATION THAT THE PLAINTIFFRESPONDENT'S ALEMITE HYDRAULIC EQUIPMENT INVOLVED A QUESTION IN ISSUE AND WAS HELD BY THE
EIGHTH CIRCUIT COURT OF APPEALS NOT TO EMBODY THE
INVENTION COVERED BY CLAIM 1 OF THE BUTLER PATENT.

Counsel for the petitioner have endeavored to contort the language in which the two courts of appeal have stated their agreement that the plaintiff-respondent's commercial equipment does not correspond with the details of the drawings and specifications of the Butler patent, into a statement—many times repeated—that the Eighth Circuit Court of Appeals held that the plaintiff-respondent's Alemite Hydraulic equipment did not embody the invention set forth in claim 1 of the Butler patent.

Thus, on page 12, counsel for the petitioner say that the Eighth C. C. A.

"held that neither the accused Jiffy coupler nor indeed plaintiff's own commercial 'Alemite Hydraulic' coupler responded to the coupler part of the Butler claim-language for the above outlined reason."

Thus again, on page 15 of their brief, counsel for the petitioner refer to

"plaintiff-respondent's commercial form of coupler (the so-called 'Alemite Hydraulic' coupler) which the Court of Appeals for the Eighth Circuit in the Jiffy case held not to be the coupler of the Butler patent and to be outside the scope thereof."

The scope of the Butler patent is of course to be measured by its claims. There was no issue as to whether either claim described the plaintiff's "Alemite Hydraulic" equipment, and unavoidably, therefore, no decision upon that issue.

Again on page 16 of their brief, counsel for the petitioner say that

"The Court of Appeals for the Eighth Circuit " .

also clearly and expressly and necessarily excluded plaintiff-respondent's 'Alemite Hydraulic' coupler from the scope of the Butler patent."

Again on page 18 of their brief, counsel for the peti-

tioner say that

"Plaintiff-respondent's own commercial 'Alemite Hydraulic' coupler is not in fact the coupler defined in the coupler part of the Butler claim-language, for the reason relied upon by the Court of Appeals for the Eighth Circuit."

Still again, on the chart opposite page 19 of their brief, counsel for the petitioner present a picture of certain parts of the plaintiff's "Alemite Hydraulic" equipment, and apply a caption reading.

"Respondent's own coupler ('Alemite Hydraulic') held outside the scope of coupler part of Butler claim-

language."

This picture and this subcaption are placed beneath a main

caption reading.

"The devices before the Circuit Court of Appeals for the Eighth Circuit in Respondent's suit against Jiffy Lubricator Co., 81 Fed. 2d 786 (certiorari denied 299 U.S. 554).

Even in connection with their argument of wholly separate and distinct points, counsel for the petitioner repeat and reiterate their misrepresentation of the issues and of the decision of those issues by the Eighth Circuit Court of Appeals in the Jiffy case. Thus, for example, on page 31 of their brief, counsel for the petitioner say that

"The Court of Appeals for the 8th Circuit \* held that plaintiff-respondent's own allegedly Butlerwere not within the scope improved couplers

of the claim thereof."

This repeatedly reiterated misstatement cannot convert the agreement of the two courts upon the fact that the plaintiff-respondent's commercial equipment differed in

detail from the structures illustrated in the drawings and described in the specifications, into a conflict upon a question which was not even in issue in the Jiffy case, namely, the question whether the plaintiff-respondent's Alemite Hydraulic lubricating equipment comes within the scope of one or another of the claims of the Butler patent.

#### EVEN THE TYPOGRAPHY OF THE PETITIONER'S BRIEF IS AVAILED OF BY COUNSEL FOR PETITIONER TO AID IN THE SUSTAINED DISINGENUOUSNESS OF THEIR PRESENTATION.

The disingenuousness with which counsel for petitioner present the matter, is illustrated by another stratagem employed by them. In accordance with almost universal custom, the brief of counsel for the petitioner employs the convenient format of indenting the margins of extended quotations. This aid to clarity is first employed on page 3 of the petitioner's brief, in connection with the quotation of certain statutes, and is then uniformly followed throughout the brief.

On page 12 of their brief, they similarly indent some twelve lines of printed matter. But in this lone instance this matter is not quoted from anything at all. It is the original language of counsel for the petitioner. Yet the device of this indented margin is employed in a context and in such a manner as almost inevitably to convey the impression that the language of counsel for the petitioner is that of the Circuit Court of Appeals for the Eighth Circuit. The paragraph of petitioner's counsel runs as follows:

"In the Jiffy case, the Circuit Court of Appeals for the Eighth Circuit held that plaintiff-respondent's 'Alemite Hydraulic' coupler is not the coupler defined by the coupler part of the Butler claim-language for the reason that:" Then follows the indentation in which the Circuit Court of Appeals appears to say:

"the coupler part of the claim-language requires that the nipple-engaging means (the three radially-movable locking jaws 40) be compressively actuated. The only means of 'compression' disclosed, are Butler's resilient spring fingers 42, which do subject the radially-movable locking jaws 40 to spring-compression. Plaintiff-respondent's commercial 'Alemite Hydraulic' couplers do not have any such spring fingers nor any other resilient or spring-like or 'compressive' jaw-actuating means. Instead, the jaws of the 'Alemite Hydraulic' coupler are actuated by an unyielding cam or wedge surface."

Although the typography uniformly employed throughout the brief of counsel for the petitioner, coupled with the introductory colon and the context, would lead one inevitably to regard this passage as a quotation from the opinion of the Eighth Circuit Court of Appeals, the fact of the matter is that the indented language is solely and originally that of counsel for the petitioner.

This sort of disingenuousness would doubtless not be worthy of such extended comment, except for the fact that the same disingenuousness permeates the entire petition and the entire brief in support of it.

THE REAL TEST OF CONFLICT OR LACK OF CONFLICT IN THE DECISIONS OF THE TWO COURTS OF APPEAL IS TO BE FOUND IN A COMPARISON OF THE DECREES OF THE TWO COURTS.

The decree of the Eighth Circuit Court of Appeals in the Jiffy case was that

"the defendant, Jiffy Lubricator Company, has not infringed claim 1 of said Butler Patent No. 1,593,791, by the manufacture and sale of lubricating apparatus exemplified by Plaintiff's Exhibits 10, 11, 12, 13 and 14, and Defendant's Exhibit A, and as illustrated in the drawings Plaintiff's Exhibits 20, 21, 22, 23 and 32." The decree affirmed by the Seventh Circuit Court of Appeals in the Lincoln case was

"That the defendant Lincoln Engineering Co. of Illinois has contributorily infringed claim 2 of said Butler patent No. 1,593,791, by the sale of "Lincoln-Kleenseal' nipples or fittings of the types illustrated in Bulletin 111 of the Lincoln Engineering Co. of Missouri, Defendants' Exhibit A-53 herein, and exemplified in Plaintiff's Exhibits 27a and 27b herein, "" (R. 441.)

and that defendant be permanently enjoined

"from using, or making or selling for use within the United States lubricating-receiving nipples or fittings of the kind illustrated in Bulletin 111 of the Lincoln Engineering Co. of Missouri, and exemplified by Defendants' Exhibit A-53 and by Plaintiff's Exhibits 27a and 27b herein, " " (R. 442.)

These two decrees did not even relate to "the same matter." (Rule 38, Sec. 5 (b).)

THE LINCOLN COMPANY COULD MAKE, USE, AND SELL DE-VICES IDENTICAL WITH THOSE MADE AND SOLD BY THE JIFFY COMPANY AND IN ISSUE BEFORE THE EIGHTH C. C. A., WITHOUT VIOLATING THE DECREE OR THE INJUNCTION OF THE SEVENTH C. C. A.

The whole subject is put at rest by the simple fact that the Lincoln Engineering Company could make, use, and sell devices identical with those made and sold by the Jiffy Company and in issue before the Eighth Circuit Court of Appeals without violating the decree or the injunction in the Lincoln case. Any attempt on the part of the plaintiff to restrain the Lincoln Company from manufacturing and selling the Jiffy Company's type of equipment would necessarily involve the commencement of a new suit directed against this new and different matter. Such a new suit would necessarily have to be brought under a different claim of the Butler patent, i. e., claim 1 rather than claim 2. In such a new suit, the plaintiff could not even claim a res judicata against the Lincoln Company.

### IN SUMMARY, THEN, RELATIVE TO THE PETITIONER'S "POINT I".

The questions in issue before the Eighth Circuit Court of Appeals involved claim 1 only.

The questions in issue before the Seventh Circuit Court of Appeals involved claim 2 only.

In the Eighth C. C. A. the issue of infringement had to do solely with the Jiffy Company's combination of its coupler and compressor with a straight-sided cylindrical fitting. In the Seventh C. C. A. the issue of infringement had to do solely with the Lincoln Company's nipple having a head, a throat, and a shoulder.

These very features were enumerated by the Eighth Circuit Court of Appeals in distinguishing the disclosure of the Butler patent from the lubricating equipment manufactured and sold by the Jiffy Company. These very features were incorporated in the Lincoln Company's device.

The Eighth Circuit Court of Appeals held that the Jiffy Company's product did not infringe claim 1. The Seventh Circuit Court of Appeals held that the Lincoln Company's product did infringe claim 2.

Both courts agreed in holding that the Butler patent was valid.

Both courts agreed that the plaintiff's Alemite Hydraulic equipment was not made in accordance with the details of any of the figures shown in any of Butler's drawings or described in any of Butler's specifications.

The Seventh Circuit Court of Appeals had before it the issue whether the plaintiff-respondent's Alemite Hydraulic equipment came within the scope of claim 2 of the Butler patent. It held that it did. There was no such issue before the Eighth Circuit Court of Appeals, either as to claim 1 or as to claim 2 and the Eighth Circuit Court of Appeals did

not pass nor attempt to pass upon that issue relative to either of these claims.

The lack of any conflict between the decision of the Seventh C. C. A. and that of the Eighth C. C. A. is demonstrated by the fact that the Lincoln Company could make, use, and sell devices identical with those made and sold by the Jiffy Company without violating the decree or injunction in the Lincoln suit.

RELATIVE TO PETITIONER'S "POINT II": THE MISNOMERS EMPLOYED BY COUNSEL FOR THE PETITIONER DO NOT DESCRIBE RITHER THE CASE WHICH WAS PRESENTED BY THE PLAINTIFF-RESPONDENT OR THE CASE WHICH WAS DECIDED BY THE SEVENTH CIRCUIT COURT OF APPEALS.

The petitioner's very statement and argument of its Point II begs the question which was decided by the Seventh Circuit Court of Appeals, and which the petitioner seeks to have reviewed by this Court.

Over and over and over again, counsel for the petitioner refer to the nipple element of the Butler combination as an old nipple, or an old fitting, or an old-style grease cup, etc., etc. The alleged oldness of this element is reiteratedly contrasted with what counsel choose to call "an improved hose coupler," "a novel combination of coupler composing elements," the "improved chuck type hose coupler," etc., etc.

The allegedly old grease cup or nipple or fitting is referred to as being "admittedly" old. What counsel refer to as the improved coupler is generally referred to as the "assertedly" novel or improved hose coupler.

All of these adjectives and misnomers are insinuatingly employed as though they represented the contentions of the plaintiff-respondent, and as though they represented the conclusions reached by the Seventh Circuit Court of Appeals. These misnomers do not describe either the case which was presented by the plaintiff-respondent or the case which was decided by the Seventh Circuit Court of Appeals.

THE OPINION OF THE SEVENTH CIRCUIT COURT OF APPEALS
REFERS TO AND DISCUSSES THE DECISION OF THIS COURT
IN ROGERS VS. ALEMITE, AND EXPRESSLY RECOGNIZES IT
AS STATING THE LAW WHICH IS TO BE OBSERVED, RESPECTED, AND APPLIED BY THE LOWER COURTS.

The decision of this Court in the cases of Rogers v. Alemite, and Bassick v. Hollingshead, 298 U. S. 415, was of course pressed upon the attention of the Seventh Circuit Court of Appeals and upon the District Court in which the case was originally decided. The opinions of the District Court and the opinion of the Court of Appeals all refer to it. They all discuss it. They all distinguish the facts of the instant case from the facts of the cases of Rogers v. Alemite and Bassick v. Hollingshead. All of these decisions of the lower courts expressly recognize the decision of this court as stating law which must be observed, respected, and applied by the lower courts. Thus, for example, Judge Evans, in writing his opinion for the Seventh Circuit Court of Appeals, said:

"The uppermost question in this case is the controlling effect of the Bassick v. Hollingshead opinion, supra. We are not disposed to limit it in order to bring about an avoidance of any new principle it may announce. Nor are we inclined to give it an effect which was not intended, if it does not follow from a fair construction of its language." (91 F. (2d) 757, 761.)

In this same opinion, his Honor Judge Evans said further, relative to the opinion of this Court in the Rogers and Hollingshead cases:

"While going no further than is necessary to defeat

the patent in the present case, the conclusion from appellant's brief is unavoidable, that Bassick v. Hollingshead, supra, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. This revolutionary concept was accepted and applied by the District Court (in Pennsylvania) in Stewart-Warner v. Universal Co., 15 F. Supp. 410." (91 F. (2d) 757, 760.)

Judge Evans went so far as to say:

"While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling." (91 F. (2d) 757, 761.)

It would be impossible to acknowledge more clearly than the Seventh Circuit Court of Appeals has done, the authority of this Court's decision in the Rogers and Hollingshead cases.

In its opinion, the Seventh Circuit Court of Appeals said explicitly, in just so many words,

"We accept, of course, without question, this opinion as applied to the facts in the case that was before the Supreme Court." (91 Fed. (2d) 757, 762.)

THE SEVENTH CIRCUIT COURT OF APPEALS EMPHASIZED BY THE USE OF ITALICS THAT PART OF YOUR HONORS' DECISION IN THE ROGERS AND HOLLINGSHEAD CASES WHICH DISTINGUISHES, RECONCILES, AND HARMONIZES IT WITH THE AGE-OLD LAW WHICH HAS BEEN OBSERVED AND APPLIED BY ALL OF THE FEDERAL COURTS.

The opinion of the Seventh Circuit Court of Appeals not only refers to but quotes extensively from the opinion of this Court in the Rogers and Hollingshead cases. In so doing, the Court of Appeals emphasized by the use of italics, the sentence which reconciles and harmonizes your Honors' opinion in the Rogers and Hollingshead cases with

the age-old law which has been observed and applied by this Court and by all of the federal courts throughout the United States. This quotation as italicized and thus emphasized by the Seventh Circuit Court of Appeals is as follows:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler and grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.) He further claimed the combination between his patented pir fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. (Claims 14 and 15.) The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts." (91 F. (2d) 757, 761.)

In the Rogers and Hollingshead cases, your Honors found and held that the patentee, Gullborg, had "improved one element of an old combination whose construction and operation is otherwise unchanged."

It was these characteristics which distinguished the disclosure of the Gullborg patent from the disclosures of the many, many other patents in which the furnishing of one element with knowledge and intent that it was to be incorporated into the combination claimed in the patent in suit, had been held by this Court and by all of the federal courts to constitute an act of contributory infringement. THE SEVENTH CIRCUIT COURT OF APPEALS DETERMINED AS A MATTER OF FACT THAT BUTLER BROUGHT TOGETHER A NEW COMBINATION OF OLD ELEMENTS IN SUCH A WAY AS TO INVOLVE A NEW CONSTRUCTION, A NEW MODE OF OPERATION, AND A NEW AND UNITARY RESULT, AND THAT HE DID NOT MERELY "IMPROVE ONE ELEMENT OF AN OLD COMBINATION WHOSE CONSTRUCTION AND OPERATION IS OTHERWISE UNCHANGED."

Everybody concedes that Butler brought together for the first time the seven elements enumerated and described in claim 2 of the Butler patent. Everybody concedes that "Butler was the first to devise a lubricating system in which the sealing of the joint between the end of the nipple and coupler and the mechanical grip were effected automatically by the pressure of the lubricant, which pressure was produced by the normal pumping operation of the compressor." Such was the finding of fact by the District Court as adopted by the Court of Appeals and as quoted by it in its opinion.

In the instant suit against the Lincoln Engineering Company, the District Court, and later the Court of Appeals made it their task to determine as a matter of fact whether Butler, like Gullborg, had merely "improved one element of an old combination whose construction and operation is otherwise unchanged," or whether Butler, like Berliner (the patentee in Leeds & Catlin v. Victor, 213 U. S. 301 and 325), had brought together a new combination of old elements in such a way as to involve a new construction, a new mode of operation, and a new and unitary result.

Judge Lindley in the District Court, and Judge Evans and Judge Sparks and Judge Major in the Seventh Circuit Court of Appeals, made independent determinations of this factual question. All came to the conclusion that as a matter of fact Butler had not merely improved one element of an old combination whose construction and opera-

tion is otherwise unchanged, but that he had brought together a new combination of seven elements, each generically old but each and every one so related to and affected by the presence and coaction of all of the others as to produce the new and unitary result which the courts have ascribed to Mr. Butler and which not even the petitioner attempts to detract from him.

AS AGAINST THE PETITIONER'S PRETENDED STATEMENT OF THE FACTS, WE CONTRAST THE REAL FACTS AS DETER-MINED BY THE SEVENTH CIRCUIT COURT OF APPRAIS,— AND SOLELY IN THE LANGUAGE EMPLOYED AND ADOPTED BY THAT COURT.

Counsel for the petitioner have pretended to state the facts in their own language. Let us state the facts in the language employed in the decisions of the Courts. It will promptly become apparent that the facts as determined by the courts are radically at variance with the facts as presented to your Honors by counsel for the petitioner.

In its opinion, the Seventh Circuit Court of Appeals pointed out that

"The District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the defenses, the state of the art, as well as other material issues." (91 Fed. (2d) 757, 758.)

At page 759 of its opinion, the Court of Appeals adopted Judge Lindley's characterization of the Butler invention, saying:

"Judge Lindley, describing the patent, said:
"" Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler and the mechanical grip between the nipple and the coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, the advantage of this

combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure."

A little later in the opinion of the Seventh Circuit Court of Appeals, his Honor Judge Evans quoted in extenso what he called "the substance of the more important findings of the trial court."

The Court of Appeals approved and adopted Judge Lindley's factual determinations. The Judges of the Court of Appeals pointed out, however, that they had not done so either blindly or carelessly. They said expressly,

"It is only after observation of the various lubricating systems that we have come to the same conclusion as was reached by the District Court." (91 Fed. (2d) 757, 765.)

Before quoting further from the opinion of the Court of Appeals relative to the facts which distinguish the instant suit, let us turn first to the factual situation as found by the District Court and subsequently approved and adopted by the Court of Appeals. The defendant's various petitions subsequent to the filing of an original opinion by the District Court, led Judge Lindley to supplement his original opinion with two further opinions. Counsel for the

petitioner have been careful to omit these subsequent proceedings and opinions from the record presented by them in this Court. Judge Lindley's first opinion is reported at 15 Fed. Supp. 571. His second opinion is reported at 16 Fed. Supp. 778. His third opinion is reported at 31 U. S. P. Q. 195. All of these opinions, as also the opinion of the Court of Appeals, are reprinted in a pamphlet which accompanies this brief.

Here, then, are the facts as determined by the District Court and as subsequently adopted and approved by the Court of Appeals. In his first opinion, Judge Lindley said:

. "Claim 2 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nipples. The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such manner as to cause the locking or gripping jaws to clutch or grab aboutor upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat, carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing or clutching of the nipple is effected automatically, and engagement of the seal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the coupler and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for performing them. Yet each of the two functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable variation in the precise dimensions in the forms and parts involved.

"Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, an opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws." (15 Fed. Supp. 571, 571.)

Regarded generically, each of these seven elements is just as old as counsel for petitioner assert the nipple to be. On the other hand, the precise conformation of the nipple whereby it is enabled to knit itself into the cooperative unit involving all of the seven elements, is just as new as each and every other element of this combination. Judge Lindley himself adverted to these facts. He said in this connection:

"Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to

accomplish a new result.

"The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with grease and then to be coupled in succession to each of the nipples in order to inject grease into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car." (15 Fed. Supp. 571, 572.)

Then, after thus setting forth that the Butler invention involved was an entirely new structure, different in construction and operation from the prior art, the District Court addressed its consideration to the opinion of this Court in the Bassick cases, and said:

"From an examination of the Leeds opinion I believed that the basis of the decision relative to the Gullborg patent was that this inventor of pin fitting, part of the complete combination, part of which had already been separately patented, did not bring about any new mode of operation or cooperation in or among the other elements thereof. It did not alter or modify br give new functions to any of the other parts of the combination; and, therefore, the old parts did not participate in a new way in the accomplishment of a new

and unitary result.

"The ground for decision appearing in these opinions is not applicable to the Butler patent, claim 2. Here the question is whether Butler produced a combination which achieved a new and unitary result by the cooperation of all the elements, whether all the elements have new or modified functions as a result of changes or substitutions, or whether the old elements have only the old functions operating and cooperating in the old way to produce only an old result. We have seen that the combination consists of seven elements, all of which are old; that invention arises not from any one element, but from the new unitary result. Defendant insists that the essence of the combination is the coupler, but we have seen this is a fallacious theory, for if it were correct and available to excuse the use of the nipple to cooperate in the combination, one person might make the nipple, another, the cylinder; another a group of jaws, another the sealing seat; another the piston. Each of these are old; each of them sell separately. The purchaser could quickly assemble them and then claim that each part had an independent status apart from that in the Butler combination. There could then be no infringement.

"The headed nipple, which cooperates with the sealing seat and jaws of the coupler and thus with the piston and cylinder, is just as essential a part of the Butler invention as any of the several elements of the coupler. There is cooperation between the nipple and the jaws. which produces the operation of the seal, which in turn effectuates the operation of the gripping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of the direct cooperation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In detaching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the

coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

"Butler was the first to utilize a headed nipple and a compressor as cooperating elements of a combination whereby a grease-tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping

operation of the compressor alone.

"The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new, useful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and cooperated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg case (56 S. Ct. 787, 791, 80 L. Ed, .....) is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. as the Supreme Court said of the Berliner patent, 'each element was necessary to the operation of the other.' ". (15 F. Supp. 571, 578, 578-579.)

Upon petition for rehearing, the District Court delivered a second opinion in which Judge Lindley said:

"We may well again refer to the character of the Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip be-

tween the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Former devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of these, some leakage occurred, and physical manipulation entailing some labor was necessary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable pressure, and with the saving of labor resulting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and . automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure. This, I have said, was a step forward in the greasing of automobiles. No one had ever taken it, though the art is full of grease guns and nipples. It remained for Butler to devise an easy operable combination in which the nipple and the coupler automatically cooperate, each contributing its part to the one result of high pressure grease delivery through a sealed connection, effected automatically and increasing in efficiency with the increase of the pressure. This, I said, was invention and the combination, I held, became, therefore, a pioneer invention in the sense that the Supreme Court used that word in the Leeds & Catlin case." (16 F. Supp. 778, 781.)

"So, here, Butler introduced into the art the idea of an automatic sealing connection achieved by the size and character of elements, which, in themselves, were old. But he employed a different mode of operation. He achieved his object by means of a different force and according to a different and new conception. His invention then was not an improvement but a new and separate invention and, within the reasoning of the Supreme Court in the Leeds & Catlin and the Hollingshead and Rogers cases, a pioneer. In the latter two cases the court was not dealing with a combination patent wherein, by the use of a nipple of a certain particular form and shape and dimensions cooperating with the gripping jaws of a coupler of special form and shape, an automatic unbreakable connection was achieved, making possible that highly desirable thing in automobile greasing, unlimited pressure. did not combine a certain coupler with any nipple. He did not combine a certain nipple with any coupler. He was not, as the Supreme Court believed Gullborg had done, trying to extend his patent to a combination of a certain nipple with any kind of grease gun. Quite to the contrary, he demonstrated conception of a new creative thought, the achievement of a new valid combination in which not only the coupler was essential, but in which also the nipple of peculiar shape and dimension was essential. He produced a new combination, a new arrangement of known elements, by virtue of which he produced an entirely new and beneficial result. He developed new functions and new properties and achieved novelty, resulting in great commercial success.

"In this situation, defendant entered the field and developed its nipple of equivalent form, shape, and dimensions, which it sold, obviously, for use with Alemite guns, supplanting in the combination of Butler the nipple essential to his success. It is a striking fact that a nipple of this shape and dimension was not necessary to the operation of defendant's grease gun or of any guns other than those of plaintiff or of infringers or licensees of plaintiff—a fact of tremendous significance in determining the purposes and intent of defendant. It sold grease guns which operated with straightheaded nipples as well as with nipples with head and

shoulders. It first made straight-headed nipples and exhibited them to General Motors Corporation, but it sold to that company only nipples of infringing character, a character not essential to any combination other than plaintiff's." (16 F. Supp. 778, 782.)

In his third opinion in this same suit, his Honor Judge Lindley said in part:

"I have the conviction that this patent is valid. I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a continuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary—the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that tort in the protection of the defendant's interests, I am not disposed at this time, in view of the time that has elapsed since the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals.

"I don't approve of the assignment of errors, for they put into my words something which I expressly disclaimed in my memoranda, and I don't want the Court of Appeals to be misled as to what I did hold. I have tried to make it clear in the two memoranda which I prepared in this case, and I shall not be misquoted without an expression of my disapproval of the form of the assignment of errors." (31 U. S. P. Q. 196.)

After making its expressly independent determination of the facts, and after approving and adopting Judge Lindley's determination of the facts as set forth in the foregoing quotations from the three opinions of the District Court, the Seventh Circuit Court of Appeals set out to state and apply the law.

WE VENTURE TO SUGGEST THAT NO COURT HAS EVER MORE CAREFULLY, MORE ACCURATELY, OR WITH GREATER CLARITY, STATED THE LAW OF CONTRIBUTORY INFRINGEMENT AND THE LAW OF PATENTABLE COMBINATION, THAN IN THIS OPINION OF THE SEVENTH CIRCUIT COURT OF APPEALS BY HIS HONOR JUDGE EVANS.

In its opinion, the Court said:

"In the instant case, Butler does not seek to extend the monopoly of a patent for a pin fitting or to preclude the use of a grease gun in any apparatus not embody-

ing the improvement described in the patent.

"Two questions are determinative: First, did Butler set forth a valid patentable combination when he wrote his claim No. 2? Second, did the sale of a headed nipple or a lubricant compressor made for the sole purpose of being used in connection with the apparatus made according to the Butler patent, constitute infringement?

"Combination or Aggregation. As we view claim 2 of the Butler patent, it spells combination, not aggregation. It is not the names of the various parts that determine this question. If there be coaction of elements so as to make a single unitary structure, we have a combination. The nipple head may be a non-composite apparatus. It may be the subject of a valid patent claim. Likewise, it may be part of a combination.

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old. Nevertheless, if it is an element in an otherwise valid combination (due to the novel coupling method), it is a unit of said combination and a third party supplying it, if other necessary facts are shown, may thereby infringe.

"Whether the supplier of headed nipples or other elements of the combination set forth in claim 2 is a contributory infringer depends first on whether the

element supplied is a part of a valid combination (as distinguished from an aggregation), and second, on whether the producer so constructs it that it can be said that it was knowingly made with the intention that it would be used in connection with the patented combination.

"There is an exception to this statement—If an element of a patented combination in the very nature of its use wears out and a new one is supplied, it may be furnished without the producer's infringing. Heyer v. Duplicator Mfg. Co., 263 U. S. 100; Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 325. But. where the intent is present, as here, to supply separate units of a patented combination and not as a renewal of a wornout part, contributory infringement is disclosed.

"The findings of the District Court on this question respecting the dimensions of appellant's headed nipple clearly show an intention to make parts which could only be used in connection with the patented combination. If, then, the Butler claim No. 2 disclosed a valid combination, infringement was shown.

"In dealing with this subject of contributory infringement, it might be observed that we are dealing with a phase of the general subject of torts. An infringer is a tort feasor. A contributory infringer is one whose action contributes to the infringement.

"Because of the statute, the owner of a patent is entitled to exclude others from making, selling, or using the patented product. Violation of any of these rights makes the violator a tort feasor, an infringer. Making, buying or selling a non-patented article is not of itself infringement. It only becomes so when said maker, seller or user does so knowing that the non-patented element is to be used in connection with other elements in a valid combination covered by a valid patent. This is the doctrine on contributory infringement.

"In the instant case, the court has made findings, and the facts leave no doubt as to the soundness of such findings, to the effect that the non-patented parts made by appellant were not only intended for use in connection with Butler's patented combination but they could hardly be used otherwise. The size and dimensions of the fittings most conclusively demonstrate this

fact.

"It might be asserted that appellant did not infringe when it manufactured one element of the product for it could have been sold to one who would use it other than in the Butler patent combination. However, when it appears that such products were made by the appellant and sold to garages and it further appears that the fittings were of such measurement as to preclude their use except on appellee's patented apparatus, contributory infringement both in selling and in using is established.

"To establish contributory infringement the following facts must appear: (1) a valid patent; (2) ordinarily in the case of a product patent covering a combination; (3) the alleged infringer must make or supply one or more of the elements of the combination with the knowledge and intention that the same is to be used in

the patented combination.

"Contributory infringement is the outgrowth or result of the application of the following legal propositions:

"(1) A patentable combination is a unit in the con-

templation of the law.

"(2) Some elements of the combination may be old and others new, or all old, or all new.

"(3) One who makes, sells or uses the combination without permission of the patentee is an infringer.

"(4) One may be a contributory infringer although he makes, sells or uses an element that is old and not

covered or coverable by a patent.

"(5) When the manufacturer makes, uses or sells an unpatented (an old) element, he becomes a contributory infringer only when the element is knowingly, made, sold or to be used as a part of a patentable combination without patentee's express or implied consent.

"(6) Implied consent exists when in the ordinary use of the patentable combination one element constantly and frequently wears out and must be replaced. Heyer v. Duplicator, supra. Whether there is a consent is often a fact issue, but not involved in the instant suit.

"In the last analysis this question of contributory infringement in the instant suit must be determined by the existence or absence of a valid combination where in one of the essential elements was a product made

by appellant. If the elements do not spell a combination, but are merely an aggregation, there is of course

no contributory infringement.

"For obviously, infringement can exist only when there is a valid patent. No valid patent can cover a group of elements which are correctly termed an aggregation and which do not conform to the correct legal definition of a combination. There is a valid combination only when the element—headed nipple—co-acts with the lubricant compressor and the coupling member. If two of these elements do not co-act and the third element does not likewise co-act with one of the other two members, we do not have a case of valid combination.

"Doubt over this issue can only arise when one of the elements may in itself serve a multiple of purposes. It may be used outside the combination of the patent. If so, its use is valid and legitimate. The determining fact issue is the intent and the purpose it serves, and was intended to serve when made or sold. If made, sold or used as an intended element in the combination which is the basis of the patent claim, it is a case of contributory infringement, otherwise not." (91 F.

(2d) 757, 762-764.)

In further exposition of the law as understood and applied by the Seventh Circuit Court of Appeals to the facts of the instant suit as determined by it, Judge Evans, in

his opinion, said:

"If the (Supreme) court announced a rule in the Bassick case as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the validity of patents then Leeds & Catlin v. Victor Talking Machine Co., 213 U. S. 301, is overruled. However, instead of stating that the Leeds & Catlin opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

"Until and unless there is an express repudiation of the Leeds & Catlin v. Victor Talking Machine Co. case, we can not accept the Bassick v. Hollingshead opinion as being inconsistent with the views stated in the former opinion. In other words, we must apply to the instant case the rules of law which govern and apply the tests which have long been applied to determine whether the Butler combination is a patentable invention.

"In dealing with product patents and their validity it might be observed that the word 'combination' is somewhat unfortunate. A combination contemplates a plurality of units, yet patentable invention can only reside in a combination when it (the combination) is considered as a unit. For convenience's sake, courts speak of elements in a combination as units in and of themselves. It is only for the sake of convenience that reference is made to such elements as 1, 2, 3, 4 and 5. Each and every valid claim of a patent covers a unit. although in a combination claim the unit may have five parts or elements. When we so consider a claim it is clear that one unit must differ from another unit if one element, say element three in one combination is different from element three in another combination. To illustrate: If one mixes five different colored paints in stated proportions, he would have a product which might be denominated X. X must be viewed as a unit. If the same individual mixed in the same proportions five different colored paints, four of which were similar to the ones in the first combination but one was different, the final product would not be the same. In testing the validity of any machine or product patent, then, whether it be what is commonly called a combination, or a single, a non-composite substance, the following propositions may be accepted as sound:

All the elements may be old but if they have never appeared together in combination and they coact so as to avoid the charge of aggregation, the unit

may constitute a valid claim of a patent.

"2. Where a combination consists of five elements— 1, 2, 3, 4, and 5—and the inventor uses four old elements-1, 2, 3, and 5,-in the same way and for same purpose as in the previous combination, but substitutes a new element 4 for old element 4 of the old combination and obtains desirable results, the new combination may be the subject of a valid claim. It is not anticipated by the previous combination.

"3. Likewise, one may substitute for element 4 an old and well-known element but which has never been used in combination with elements 1, 2, 3, and 5, and these elements being presented in the new combination for the first time may be the subject of a valid patent.

"In stating these propositions, we have used the word 'may' for there are other factors to be considered in determining patentability. For instance, the novelty may not be patentable. The advance may represent the skill of the artisan or the mechanic, not the genius of the inventor. Perhaps it would be better to say that the objection that the combination is lacking in novelty is not sound under the conditions enumerated.

"Equally clear is the law which denies to anyone the

right to repatent an old combination.

"Accepting the foregoing principles as sound and applying them to the instant case, we have no difficulty in distinguishing any of the prior art. Nor are we troubled by the decision in the Bassick case. The Butler coupling member and his nipple head are novel. Their structures are clearly distinguishable from the prior art. Whether the other mentioned elements are old is immaterial.

"The only validity questions left relate to combination as distinguished from aggregation and the character of the discovery—whether it marks patentable novelty or mechanical skill. In passing, it might be observed that if a new product is found to be patentably novel, it is immaterial whether said patentable novelty is of the pioneer type or 'the mere improvement type' of invention." (91 F. (2d) 757, 761-762.)

Compare this exposition of the law in Judge Evans' opinion for the Seventh Circuit Court of Appeals, with those famous and now classic statements of the law which were cited and reaffirmed by this Court in its decision of the Rogers and Hollingshead cases!

The opinion of the Seventh Circuit Court of Appeals will not be found to be lacking in insight or in clarity or in accuracy or in conformity. We refer, of course, to the two notable passages in the opinions of this Court by Mr. Justice McKenna in the two cases of Leeds & Catlin v. Victor. In the first of these opinions the Court said:

"A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same

patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. that they must be united under the same cooperative law. Certainly, one element is not the combination nor in any proper sense can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. making a combination an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of the patent laws. It is in accordance with the policy of Sec. 4887 of the Revised Statutes, which is urged against it." (Emphasis ours.) Leeds & Catlin v. Victor, 213 U. S. 301, 318.

The second of these classical statements of the law is to be found in the opinion in the second case of *Leeds & Catlin* v. *Victor* (No. 2), 213 U. S. 325, 332. Here Mr. Justice McKenna said:

"A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or non-composite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or non-infringement of a combination that one of its

elements or all of its elements are unpatented. For instance, in the case at bar the issue between the parties would be exactly the same, even if the record disc were a patented article which petitioner had a license to use or to which respondent had no rights independent of his right to its use in the combination. In other words, the fact that the disc sold by petitioner is unpatented does not affect the question involved except to give an appearance of a limitation of the rights of an owner of a Victor machine other than those which attach to him as a purchaser. The question is, What is the relation of the purchaser to the Victor Company? What rights does he derive from it? To use the machine, of course, but it is the concession of the argument of petitioner that he may not reconstruct it." (Emphasis ours.)

The opinion of the Seventh Circuit Court of Appeals, when matched against these classics, will not be found to be lacking on the score of clarity. The opinion of the Court of Appeals has indeed the advantage of concrete amplification and exemplification.

Upon this petition for a writ of certiorari, the important consideration is, of course, that the Seventh Circuit Court of Appeals has stated the law which it applied to the facts of the present case. It stated the law in such a way that no one can be heard to challenge it.

NOT EVEN COUNSEL FOR THE PETITIONER ADVANCE A SIN-GLE WORD IN CRITICISM OF THE LAW AS FULLY AND EXPLICITLY STATED IN THE OPINION OF THE SEVENTH CIRCUIT COURT OF APPEALS.

It is perhaps a sufficient answer to the petition for the writ of certiorari that not even counsel for the petitioner advance a single word in criticism of the law as stated in the opinion of the Seventh Circuit Court of Appeals. Counsel do not even refer to the explicit statement of the law which the Seventh Circuit Court of Appeals said that it applied to the facts of the instant case.

IT IS ONLY BY ASSUMING THAT THE FACTS ARE AS STATED BY COUNSEL FOR THE PETITIONER RATHER THAN AS STATED BY THE COURT OF APPEALS THAT COUNSEL PUT THEMSELVES IN POSITION TO ASSERT, AS THEY DO, THE CONCLUSION THAT THE COURT OF APPEALS HAS RENDERED A DECISION WHICH IS "IN DIRECT CONFLICT" WITH BOTH THE RECENT DECISIONS OF THIS COURT AND THE EARLIER DECISIONS OF THIS AND OTHER FEDERAL COURTS ON A POINT OF LAW.

The attack by counsel for the petitioner seeks to gain the advantage of a flanking movement. Counsel say that the facts of the instant case are utterly at variance with those which were explicitly determined, adopted, and stated by the Court of Appeals. It is only by assuming that the facts are as stated by counsel for the petitioner rather than as stated by the Court of Appeals, that counsel put themselves in position to assert, as they do, the conclusion that the Court of Appeals has rendered a decision which is "in direct conflict" with both the recent decisions of this Court and the earlier decisions of this and other federal courts on a point of law. (Petitioner's Brief, p. 48.)

### WHAT ARE THE FACTS! THAT IS THE SOLE QUESTION.

Are the facts such as are asserted by counsel for the petitioner?

Or are the facts such as determined and stated by the Court of Appeals?

That, in the final analysis, is the sole question which counsel for the petitioner seek to have reviewed by this Court upon a petition for a writ of certiorari.

### RELATIVE TO THE PETITIONER'S "POINT III" VARIANT OF ITS "POINT II" CONTENTIONS.

The Court will find it difficult to determine just what constitutes the grounds alleged for the grant of the writ of certiorari.

At the outset of their petition, counsel state three grounds, i. e., an alleged conflict with the decision of the Eighth Circuit Court of Appeals, an alleged conflict with a decision by the United States District Court for the Western District of Pennsylvania, and an alleged conflict with the decision of this Court in Rogers v. Alemite. (Petition, p. 2.)

When they come to state the "Reasons Relied Upon for Allowing a Writ of Certiorari," on page 19 of their petition counsel do not rely at all upon the alleged conflict with the decision of the District Court for the Western District of Pennsylvania. They refer to it only parenthetically and by way of persuasion relative to the alleged conflict with the decision of this Court in Rogers v. Alemite.

Into the "Reasons Relied Upon," counsel for the petitioner have, however, interjected a new contention, namely, an allegation that the Seventh Circuit Court of Appeals "has decided an important question of federal law in a way which is untenable and in conflict with the weight of authority."

The "Reasons Relied Upon" then assert "an erroneous decision in the case at bar on an important question of federal law in direct conflict with Sec. 3 of • • • the Clayton Act," and also that the decision of the Circuit Court of Appeals "goes to the broad and general question of implied license by estoppel."

When we come to the brief in support of the petition, we find on page 37 the quotation:

### "ARGUMENT OF POINT III.

"Butler claim in suit invalid as drawn to (or because claiming) an old and exhausted combination of grease cup, pump and coupler; whereas patentee's improvement, if any, is merely in the assertedly improved coupler."

It is difficult to align this "Point III" with any of the grounds stated at the outset of the petition.

Addressing ourselves, however, to the "Point III" as it appears on pages 37 to 42 of the petitioner's brief, it is to be noted at the outset that this is another of the "in effect" contentions. It is said that,

"The Court of Appeals for the Seventh Circuit in the case at bar has erroneously held, in effect, that one who invents an improvement in one device normally useful in conjunction (or in an old combination) with other devices of the prior art, need not content himself with merely claiming his assertedly improved device, per se, but may validly claim his improved device in the old combination where it is normally to be used."

It is obvious that the assertion and argument of this "Point III" must hinge, and by the phraseology in which it is stated almost concededly hinges, upon the assertion that the facts are wholly different from those which were determined by the Seventh Circuit Court of Appeals and then made the basis of its decision under the law applicable to the determined facts.

In our discussion of the petitioner's "Point II", we have sufficiently contrasted the facts as determined by the Seventh Circuit Court of Appeals with the facts asserted on behalf of the petitioner. It will be unnecessary to recanvass them in connection with this third point variant of the petitioner's "Point II" contention.

Again the sole question is, What are the facts?

If the facts are such as were determined by the Seventh

Circuit Court of Appeals, then nobody can find fault with the law relied upon by the Seventh Circuit Court of Appeals in reaching its conclusion. Not even counsel for the petitioner have the hardihood to say that the Seventh Circuit Court of Appeals stated any such idea of the law as that which counsel first abstractly formulate and then complain of. Here again they say that the Seventh Circuit Court of Appeals "in effect" held so-and-so and so-and-so as intriguingly phrased by counsel for the petitioner.

What are the facts? What are the facts? That is the only real question which the petitioner seeks to have determined by this Court. Everyone knows and accepts and accurately states the law.

Did the Seventh Circuit Court of Appeals accurately determine the facts? That is the sole question which the petitioner would like to have answered by this Court.

UNDER POINT IV-a THE PETITIONER SEEKS TO SECURE A DE NOVO CONSIDERATION AND DECISION OF THIS COURT RELATIVE TO ALLEGED VIOLATIONS OF THE CLAYTON ACT,—A DEFENSE WHICH WAS NEVER PLEADED, NEVER OFFERED, NEVER URGED, NEVER CONSIDERED, NEVER DECIDED, NEVER MENTIONED, THROUGHOUT ALL OF THE PROCEEDINGS IN THE LOWER COURTS. IT NOW APPEARS FOR THE FIRST TIME AND YOUR HONORS ARE INVITED TO DECIDE THE CONTENTION WITHOUT HAVING THE BENEFIT OF ANY EVIDENCE BY ANY PARTY.

In view of the confusion between the petition and the brief in support of it, let us say that we refer here to the petitioner's "Point IV-a" as it appears on page 42 of the brief in support of the petition. It is with the two branches of this "Point IV" that counsel for petitioner conclude their petition for certiorari. In the petition, they reiterate their grounds for the issuance of the writ as theretofore discussed, concluding with a fourth asserted ground set forth in three pages. This is to the effect that the decision sought to be reviewed is

"an erroneous decision in the case at bar on an important question of federal law in direct conflict with Sec. 3 of the Act of Oct. 15, 1914; 33 Stat. L. 731, known as the Clayton Act, and in direct conflict with applicable decisions of this Court on the same matter, and in direct conflict with the applicable decisions of other Circuit Courts of Appeals, and in direct conflict with the applicable earlier decision of the same Court (C. C. A. 7) on the same matter."

This sweeping barrage behind which petitioner seeks to crawl into this Court is without any foundation or support in the record. No such issue was raised by the pleadings in the District Court (R. 7-10, 16-18, 26-29), or by the twenty-three assignments of error upon which the appeal was taken (R. 444-450), or in one hundred and fifty pages of argument filed in the Circuit Court of Appeals, or in the elaborate petition for rehearing filed in the Circuit Court of Appeals, and incorporated in the record before this Court (R. 647-718). No such issue is mentioned or disposed of in any of the four opinions filed by the District Court and the Circuit Court of Appeals in this case.

This specious assertion of a nonexistent reason for the issuance of a writ of certiorari is well in character with the remainder of the case as presented by the petition.

THE PETITIONER'S POINT IV-b IS THAT THE LINCOLN COMPANY WAS IMPLIEDLY LICENSED TO SELL THE VARIOUS
PARTS OF THE BUTLER INVENTION. THE DEFENSE OF LICENSE CANNOT BE MADE UNLESS PLEADED. IT WAS NEVER
PLEADED, NEVER SUGGESTED, NEVER URGED, NEVER CONSIDERED, NEVER DECIDED, NEVER MENTIONED PRIOR TO
THE ADVENT OF THIS PETITION IN THE SUPREME COURT.
PETITIONER IS ASKING FOR A DE NOVO CONSIDERATION
AND DECISION UPON A CONTENTION RELATIVE TO WHICH
NO PARTY HAS OFFERED ANY EVIDENCE WHATSOEVER.

The petitioner's argument of this point first appears on page 42 of the brief in support of the petition. The contention is otherwise stated on page 23 of the petition.

The contention is that the defendant, Lincoln Engineering Company, was impliedly licensed to sell the headed nipple part of the Butler invention.

Neither the original answer nor any amendment to any answer pleads an implied license or any license as a defense. The issue was not raised by any pleading in the District Court. (R. pp. 7-10, 16-18, 26-29.) The contention was not raised by any of the twenty-three assignments of error upon which an appeal was taken to the Seventh Circuit Court of Appeals. (R. 444-450.) No mention of the implied license defense was made in 150 pages of argument filed by the petitioner in the Circuit Court of Appeals. No mention of an alleged license of any kind was made in the elaborate petition for rehearing filed in the Circuit Court of Appeals. (R. pp. 647-718.)

The three opinions of the District Court and the opinion of the Court of Appeals bear internal evidence of the care and thoroughness with which they undertook to state and decide every question in issue. They can be searched in vain for any reference to the contention of an implied license.

### IN GENERAL, RELATIVE TO THE PETITIONER'S POINTS IV-a AND IV-b.

It is well settled that alleged violations of the Clayton Act may not be interposed as a defense to a patent infringement suit. Even if such violations could be made a matter of defense, they certainly must be pleaded as such.

The law is well settled that an alleged license must be explicitly pleaded as a matter of defense.

It goes without saying that if these defenses were to be relied upon, the parties should have had an opportunity to adduce evidence addressed to the contentions. The record is barren of any evidence by either party relative to these new contentions which are now advanced in this Court for the first time.

The petitioner is asking this Court to go into these contentions de novo, and to decide for the first time the questions which are thus raised. Your Honors are asked to decide these questions upon a record in which the alleged defenses were never pleaded, never made the subject of any evidence, never advanced to the lower courts, never considered by them, never decided by them.

We submit that a petition for a writ of certiorari does not provide the channel through which to secure a *de novo* adjudication of such contentions as are here advanced for the first time.

### IN CONCLUSION.

It is evident that what petitioner seeks by its petition is to secure a complete review of a simple patent case decided upon facts and upon law as to which there is no conflict of decisions either between Circuit Courts of Appeals or between the Seventh Circuit Court of Appeals and this Court.

In more than eighty pages in which the petition is presented and argued, no conflict is disclosed. No contention warrants the issuance of the writ of certiorari.

It is, therefore, respectfully submitted that the petition should be denied.

Respectfully submitted,

LYNN A. WILLIAMS,

Counsel for Respondent.

December 20, 1937.

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CHARLES ELMORE CROPLI

IN THE

### Supreme Court of the United States

OCTOBER TERM, 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,

Petitioner,

28.

STEWART-WARNER CORPORATION,

Respondent.

THE OPINION OF THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT, AND THE OPINIONS AND FINDINGS OF THE DISTRICT COURT, APPROVED AND ADOPTED BY THE COURT OF APPEALS.

Supplement to the Respondent's Brief in Opposition to Petition for Writ of Certiorari.

LYNN A. WILLIAMS, Counsel for Respondent.

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PAGE

### TABLE OF CONTENTS.

### SECTION I

Opinion of Judge Lindley Upon Merits of Case Delivered July 15, 1936 (R. 603-620).

Stewart-Warner Corporation v. Levally et al., 15 F. Supp. 571-580.

### SECTION II

Findings of Fact and Conclusions of Law Entered by Judge Lindley on July 15, 1936 (R. 431-437).

### SECTION III

Opinion of Judge Lindley Upon Petition for Rehearing Delivered October 5, 1936.

Stewart-Warner Corporation v. Levally et al., 16 F. Supp. 778-783.

### SECTION IV

Opinion of Judge Lindley Upon Application for Stay of Injunction Delivered October 26, 1936 (31 U. S. P. Q. 195-197).

### SECTION V

Opinion of United States Circuit Court of Appeals for the Seventh Circuit Delivered on June 29, 1937 (R. 628-644).

> Lincoln Engineering Co. of Illinois v. Stewart-Warner Corporation, 91 F. (2d) 757-766.

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Opinion of Judge Lindley Upon Merits of Gase Delivered July 15, 1936 (B. 608-620). Stewart-Warner Corporation v. Levally et al., 15 F. Supp. 571-580.

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15 F. Supp. 671

WART-WARNER CORPORATION V.LE.

No. 13955.

District Court, N. D. Illinois, E. D. July 15, 1938.

Famula (=25(1)

combination patent" may consist efer of one or more old elements, plus one more new elements; or of a plurality elements, all of which are old; or of purality of elements, all of which are

(pa Note.—For other definitions of Combination Patent," see Words & Phrases.)

Patents (== 26 (1%)

old elements in new valid combinaconstitute "invention" and are as much a unit in contemplation of law as a single or noncomposite instrument,

(Ed. Note. For other definitions of "invent; Invention," see Words & Phras-

1. Palent 6=28 (1%)

to one element 'of' combination patent in fat of combination, but it is the companied, co-ordinating, unified result, wherein the various elements contribute to one unitary result, which constitutes invention,"

4. Patents \$38 (2)

New combination of old elements, set of which contributes to new and interv result, is patentable.

J. Patents @= 260

Defendant in suit for contributory intraction of patent which did not bethe manufacture of infringing device until after commercial success was achieved by bitage of patent was estopped from asting that patentee's nonuse rendered must subject to strict construction.

4. Patents 6=328

Futler patent, No. 1,503,701, claim 2, describing combination for lubricating auties, held valid and contributorily intend by manufacturer of fittings which

were sold with knowledge and understanding that they were to be used in co-operation with one element of patented combination.

In Equity. Suit by the Stewart-Warner Corporation against John R. Le Vally and another, doing business as the Lincoln Engineering Company of Illinois, and another for contributory infringement of one claim of a patent.

Decree in accordance with opinion.

Williams, Bradbury, McCaleb & Hinkle, of Chicago, Ill., for plaintiff.

Wilkinson, Huxley, Byron & Knight, of Chicago, Ill., and Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., for defendants.

LINDLEY, District Judge.

Plaintiff, as assignee and owner of patent No. 1,593,791 to Butler, applied for February 19, 1923, and allowed July 27, 1926, sues the Lincoln Engineering Company of Illinois for contributory infringement of claim 2. The defenses are invalidity and noninfringement.

Claim 21 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nipples. The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such a manner as to cause the locking or gripping jaws to clutch or grab about or upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat, carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing, or clutching of

Claim 2. The combination with a besied aippie for receiving lubricant, of a lubricant compressor having a coupling number for connecting said compressor and sipple comprising a cylinder, a piston merable within the cylinder, and having as aperiore for the discharge of lubricant thereof, an apertured sealing seat carried by said piston for engagement with the and of the nipple, connecting the pis-

ton aperture with a passage through the nipple radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts.

the nipple is effected automatically, and engagement of the soal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the counier and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for performing them. Yet each of the two functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable variation in the precise dimensions in the forms and parts involved.

Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, an opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws. Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to accomplish a new result.

The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with greate and then to be coupled in succession to each of the nipples in order to inject greate into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car. manufacturer of the car buys the headed nipples and inserts them in the bearings. An automobile may require 25 to 60 such fittings. Some bearings can be conveniently greased with a straight nipple; others with an elbow nipple, at angles varying from 90° to 22%. Some of the nipples are long, sthers short, and they are screwed into holes tapped with different pipe thread sines. Consequently, the manufacturer of the device separately lists and prices each of the sizes of compressor which may be coupled to and used in conjunction with the nipples. Thus the purchaser may buy such nipples as, he desires and a compressor of small capacity or one of large capacity, or even a power-driven compressor. An automichile owner may hever the a comprision? He may have his car greased at a garage,

and in such case the combination componly when the car is greased.

In this respect the combination different that usually found in industry. On narily, a manufacturer makes and selection of high-pressure lubricating equipment in parts are necessarily sold separately. In prior to the commencement of this some 6,000,000 Alemite hydraulic gues a compressors claimed to have been embodishin the Butler patent were sold in plaintiff, and during the same period is distributed some 218,000,000 of its so-called Alemite hydraulic system nipples.

For seven years prior to January, its the Lincoln Engineering Company of a Louis, Mo., who is defending this suit, as who is treated herein as the real defeat ant, had manufactured grease guns a plaintiff. The latter took all of its protect Stewart-Warner had furnished couples and nozzles to Lincoln, and the latter in incorporated them in compressors, while it in turn sold to Stewart-Warner. The compressors and nozzles were used in compressors and nozzles were used in compressors and nozzles were used in compliantion with hundreds of millions of Gullborg pln fittings and Zerk push typittings manufactured and sold by plainting

Early in 1938, the Lincoln Company a cided to undertake the direct sale of h compressors to service stations and game and took steps to create a distributing or ganization for such purpose. Prior to the time, for many years, practically all Amer can-made automobiles had been equippe at their factories with pin fittings sold an manufactured by plaintiff under Gullhon or with push type fittings, manufacture and sold by plaintiff under Zerk. He dreds of millions of these nipples were i the field, practically to the exclusion of anything else adapted to lubrication of sa tomobile bearings. Consequently, the La coln Company, in order to sell its com pressors, found it necessary to incorporate a terminal of such character as would co nect with and co-operate satisfactorily will these Gullborg and Zerk nipples. At result it brought out its N-1 needle tr nousles.

In April, 1983, plaintiff through its sidiary the Alemite Corporation, put upon the market its new Alemite hydrad system involving the combination now it its upon. Soon thereafter the Line Company, in its advertising, claimed the compressors could be used not us with Guilborg fittings and Zerk push in

needes but also with the headed n'pple of the Alemite Corporation which plaintiff claims is protected by the Butler combina-

tion patent.

July, 1934, Lincoln's advertising In literature illustrated all three types of fittings as the various kinds of nipples with which the Lincoln compressor and nossle were intended to be combined and used. Thus far, however, the Lincoln Company had not manufactured or sold any nipples of any kind for use in the lubrication of automobiles. But in the summer or early fall of 1934, after the Alemite system had been on the market for one and a haif veers. Lincoln entered upon negotiations with General Motors Corporation to sell to it in lieu of Alemite hydraulic fittings, theretofore manufactured and sold to it by plaintiff, a new fitting to be manufactured for the first time by Lincoln. The negotiators had under discussion round-headed and straight-sided nipples, without head, shoulder, or peripheral groove, not adapted for co-operation with the gripping jaws of the Alemite hydraulic coupler, but properly adapted for use in conjunction with the Lincoln N-1 nozzle and Lincoln Snap-On coupler.

No straight-sided nipples, other than a few samples, were manufactured or sold. On the other hand, Lincoln began to manufacture a peripherally grooved, ahouldered, and headed nipple of form, size, and dimensions as to afford perfect co-operation with the gripping jaws of the Alemite hydraulic coupler. The first of these nipples were shipped to the Oldsmobile factory on November 24, 1934, and displaced the purchase and use of the Alemite fitting: Shortly thereafter, Cadillac, Buick, and Pontiac switched from the peripherally grooved; and headed nipples of plaintiff to those of Lincoln. These branches of General Motors, however, except as to cars sold in foreign countries, included no purchase of couplers.

For eighteen months plaintiff had attempted to put its new coupler into the hands of every garage and service station in the United States. On April 1, 1985, 2,885,148 such couplers had been sold. It appears clearly that the sale of Lincoln Ricenseal fittings dates from the shipment made to Oldsmobile and that the fittings satisfactority serves, with plaintiff's compressor. Thus, the purchasers of automobiles from General Motors divisions could have their cars, equipped with Kleenseal

fittings, greased with the Alemite hydraulic compressors and couplers then in the hands of the service stations and garages through the country.

Mr. Fox, an engineer for Lincoln, became familiar with plaintiff's headed nipple shortly after its first appearance dh the market in April, 1933. The automobile trade papers were, in that spring, summer, and fall, replete with advertisements and reading notices illustrating and describing every detail of plaintiff's hydraulic coupler, and Lincoln in July, 1934, illustrated in its circulars, Alemite headed nipples as being capable of combination with the Lincoln compressor. It is only a fair inference that during all of this period Lincoln, which seems to have been alert in its business, knew about and understood the Alemite compressor. At any rate, Mr. Fox admits that he became familiar with the coupler in January, 1935, and from that time on, Lincoln sold its peripherally grooved, shouldered, and headed nipples, adapted for satisfactory cooperation with the Alemite hydraulic compressor, with the knowledge that the purchasers of the Lincoln nipples could use them and would use them in conjunction and combination with the Alemite compressors and couplers. Furthermore, that company became familiar with the Alemite attings immediately upon their appearance in April, 1988, and when the Lincoln nipples were first put on the market in November, 1934, they were in some thirty odd styles having arbitrary dimensions corresponding with those of the Alemite headed nipples and having their structure of such size, form, and dimensions as to make them completely interchangeable with Alemite nipples.

On April 17, 1983, a representative of plaintiff went to the place of business of Lincoln in Chicago and said to the man behind the counter that he wanted to purchase some nipples to be used with a gun which he then produced, an Alemite hydraulic compressor and coupler. The man produced Lincoln fittings. The witness tried them in co-operation with the gun and that they co-operated with the found Alemite compressor and coupler; purchased the fittings and took them away with him. He subsequently made other purchases of similar fittings for the same purpose. It thus appears in evidence that Lincoln sold the fittings upon the express understanding that they were to be used in combination with affiliatiff's compressor

then exhibited to the salesman. At all times thereafter, Lincoln sold its peripherally grooved, headed, and shouldered fittings in commercial displacement of plaintiff's fittings with the knowledge and understanding that the Lincoln nipples thus sold could be used and would be used by the purchaser in conjunction with plaintiff's compressor and coupler part of the complete combination under the Butler patent.

This brings us, then, to the issue in this case; that of contributory infringement. If the combination of the Lincoln nipples with the plaintiff's hydraulic compressor and coupler embodies claim 2 of the Butler patent in suit and that claim is valid, then we have a clear case of contributory infringment.

The testimony shows a complete response of the combination of the Lincoln fittings and plaintiff's Alemite hydraulic compressor and coupler to claim 2 of the Butler petent. Every element included in claim 2 is included in such combination, and the demonstrations disclose that the co-operation and the functions thereof in this combination are the same as the combination of the plaintiff's compressor coupler, and fittings.

But defendant insists that claim is invalid. It relies largely upon the case of Stewart-Warner Corporation v. Jiffy Lubricator Co., 81 F. (2d) 786, 792 (C.C.A. There the court held claim 1 of the Butler patent, while valid, not infringed by the Jiffy Company's sale of a certain coupler intended for use in conjunction with the cylindrically projecting end of Alemite pin fitting. Claim 1 is not involved in this case. It included a fitting in the combination, and the claim is similar to claim 2, but the nipple is not headed. the Jiffy Case, the nipple Considered did not have head, throat, or shoulders. It was a perfectly smooth straight cylinder, and the Circuit Court of Appeals was of the opinion that the gripping action of the segmental jaws as disclosed in the Butler patent would not be sufficiently powerful to hold the coupler to such a plain, cylindrical nipple under the force of grease under pressure of several thousand pounds per square inch. The court mid;

"But when we turn to the Butler patent specifications disclosing the 'means' he had in mind for 'compressively engaging about the alpute for locking said parts together,' we find no reference to any elements cor-

responding to such positive wedging men as above described. He describes a nind having a head, a throat, and a shouldand segments adapted to alip over the less of such a nipple and embrace the three Then he specifies spring fire thereof. mounted on the forward face of the plate Ample room is left in the cylinder for the free play of the spring fingers. As the piston is moved forward by the pressure of the lubricant, the spring fingers do engue and press upon the segments so that the segments are pressed upon the throat of the nipple. But the nipple is not specific to be held against longitudinal displacement by the force of the gripping. The ha guage of the specifications is that the ments are held in position on the three by the spring fingers, but it is the thest der' on the nipple which 'prevents the n traction of the segments or pulling away from the nipple. We conclude from consideration of all the specifications and the drawing that the inventor excluded declosure of elements which would be actual ed by the forward movement of the pister to lock the coupler to the nipple by unyielding wedging action, but that he dis closed only such a yielding compression at should be accomplished by spring fingen

"We find the difference between the Butler patent and the Jiffy coupler substantial, in that the mechanical or engineering principle on which the Butler patent compresses the jaws of its chuck about the bearing nipple is different from that relied upon in the Jiffy structure. As they are not mechanical equivalents and as a does not appear that Butler invented a disclosed such a chuck as that made by Jiffy, there was no infringement."

Consequently, the opinion is of no all in the decision of this case. Here we are dealing with a nipple of the character described by Butler in claim 2, with a head a throat, and a shoulder. The coupler is corporates segments adapted to alip or the head of such a nipple and embrace of grasp the throat thereof. It is the sheet der on the nipple which prevents the m traction of the segments. The nipple discussed in the Jiffy Case, as the court point ed out, was not of such construction. It would not prevent longitudinal displace ment by the force of the gripping of compressor of Butler's type, although would co-operate with the Jiffy compression held not to infringe. It did not have the shoulder which prevents retraction of the segments or the pulling away from the nipole. Lincoln sells a headed nipple, to be substituted for the plaintiff's headed nipple. It has a head, a throat, and shoulders, and when used in conjunction with the Alemite hydraulic coupler, the segments of the coupler slip over the head of the defendant's nipple and embrace the throat thereof and clutch the head within the meaning of Butler's specifications and claims.

Defendant insists that this case is conirolled by the recent decisions of the Supreme Court in Bassick Manufacturing
Company v. R. M. Hollingshead Company
(G. S. Rogers et al. v. Alemite Corporation), 58 S.Ct. 787, 80 L.Ed. —, and it
becomes necessary to examine those decisions with some care.

These cases went to the Supreme Court when the Gullborg patent was about to expire. The question of validity of the patents involved had been raised in many District Courts and the patents held valid and infringed in various Circuit Courts of Appeala Unfortunately, the record was rather short. Plaintiff in the Hollingshead Case offered in evidence a sample of defendant's device and relied upon physical demonstration to show that uncoupling involved the suction effect of Gullborg.

From a decree finding infringement in the sale of the compressor and coupler of the type complained of, the Hollingshead Company appealed and argued that the device complained of had no suction ef-The Circuit Court of Appeals affirmed, 73 F.(2d) 543 (C.C.A.6). The Supreme Court took jurisdiction, and the question presented was as to the validity of the Gullborg patent, and whether the device complained of utilized the suction effect of the Gullborg claims. The Supreme Court held the claims valid; but said that the spction effect construction had not been proved and that the accused device did not involve the novel feature claimed in the patent. Clearly the case was determined upon a question of fact and the decision is of no help here, except in so far as it implies that if the device had been shown to be of the suction effect type, its manufacture and sale would have been held to constitute contributory infringement

The language of the opinion indicates as intention to upset or to reverse anything that had been previously announced

as to the character of a combination pat-Such an invention is defined by Mr. ent. Justice McKenna in Leeds & Catlin Co. v. Victor Talking Machine Co., 218 U.S. 325, at page 332, 29 S.Ct. 503, 505, 58 L. Ed. 816. as follows: "A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. can make no difference as to the infringement or noninfringement of a combination that one of its elements or all of its elements are unpatented."

In the companion case of Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, at page 318, 29 S.Ct. 495, 500, 53 L.Ed. 805, he said:

"A combination is a union of elementa, which may be partly old and partly new, or wholly old or wholly new. But, whether new or old, the combination is a means an invention distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To be come that they must be united under the same co-operative law. Certainly, one element is not the combination, nor in any proper sense, can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination, an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of patent laws. It is in accordance with the policy of § 4887 of the Revised Statutes, which is urged against ft."

I find nothing in the Hollingshead Case that purports in any way to disturb the previous announcements of the Supreme Court. Rather, it seems to me, the court reaffirms its adherence to its former helding.

8

[1-3] It is well to observe that there are three classes of combination patents as fellows:

- (1) One or more old elements, plus one or more new elements.
- (2) A plurality of elements, all of which are old.
- (8) A plurality of elements, all of which are new.

Obviously to any trial judge, in their final analyses, almost all patentable combinations are of the second class; namely, those in which all of the elements are of themselves old. The old elements in a new valid combination, as the Supreme Court says, constitute invention and are as much a unit in contemplation of the law as a single or noncomposite instrument. There is no one element that can be said to be the gist of the combination, but it is the co-operative, co-ordinating, unified result, wherein the various elements contribute to one unitary result, which constitutes invention. It is misleading, therefore, speak of any one element as the essence of the invention. Thus, in Automotive Parts Co. v. Wisconsin Axle Co., 81 F. (2d) 125, at page 126 (C.C.A.6), the court "The invention is for a composite thing, embracing several elements or parts, all of which are necessary to and co-operate in the operation of the patented unit. We cannot subscribe to the view that the test of contributory infringement in the furnishing of parts for a combination invention is whether the parts furnished constitute the gist or essence of the invention; indeed, we cannot see how it may be said that any one element or another marks the advance step or is the essence of such an invention. There are cases, it is true, in which the phrase 'essence of the invention' is used; but in our view, when the facts in those cases are considered, it cannot be said that the conclusions reached were the result of a logical selection of one or more elements of the combination as the gist or essence of the invention."

And the Supreme Court said in Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 29 S.Ct. 495, 500, 53 L. Ed. 805, "Certainly, one element is not the combination, nor, in any proper gense, can it be regarded as a substantive part of the invention represented by the combination."

The word "substative" means "an ecstation part" or "constitutent" or "relating to what is essential." [4] The question, of course, always whether there is a new patentable a nation which produces a new and me result. The operation and functioning all of the old elements of the new comb tion must be affected by their present the new combination and each part contribute its part to the unitary wi Otherwise, we have an unpatentable gregation. But if the operation or i tioning of each of the old elements some way affected by its presence h new combination in such a way as to tribute to the accomplishment of a new unitary result, then we have a valid m claim.

In the Rogers Case, apparently, in District Court the trial revolved about question of whether the defendant its products with the knowledge that would be used in conjunction with parts sold by plaintiff. But in the Supe Court this question of fact was abanda and the defendant's contentions were Gullborg patent was invalid and that plaintiff was illegally extending its nopoly. The court held that the plan might not extend the monopoly of its ent. But we do not understand that decision in any way sought to review prior announcement of the Supreme O upon the subject of contributory infri ment. The court did not so expressly h and I find in the opinion no such impl tion.

However, the court held that the dence was that the prior art embraced use in combination of a grease gun e posed of a chamber or pump, a hose, a l coupler, and a spring-closed fitting coupling being of the pin and slot or l onet type. This prior art arose from 9 borg's earlier patent, No. 1,307,733, the Seng French patent, No. 468,369. court obserted that the plaintiff's post was that when defendant furnished a a part of this old unpatented and entable combination, for use with the fitting of Gullborg, No. 1,307,783, It tributorily infringed claims 14 and 13 the patent in suit, because those claims scribe the combination of any greate with the patented pin fittings. For the vention of his fitting, Gullborg had ously applied for and obtained a pair No. 1,307,783, not then in suit. Chain of the Gullborg patent then in suit scribed a combination consisting of the fitting of Guilborg's patent, No. 1,000 with any grease ptimp having a bayoust t

The court said that the question then was whether claims 14 and 15, unless restricted to the combination of a grease gen and coupler and a pin fitting such as are described, in the specifications of the patent, are void as attempting to extend Gullborg patent, No. 1,307,783, to the use therewith of any grease gun not having the section device of the patent in suit. It had that though claims 14 and 15 are for combination using a device of a prior patent, with grease gun or coupler of any type, they must be read as claiming only a combination of pin fittings and a gun, with coupling device having the suction effect set forth in Gullborg's patent; otherwise, the claims would be void as unlawful attempts to extend the monopoly of the pin stting in patent 1,307,733.

The court observes that Rogers neither made nor sold pin fittings of the type covered by Gullborg. No. 1,307,733, and observed that the question was whether the patentee might further claim the combination between the patented pin fittings and any form of grease gun. He would thereby in effect be repatenting the old combination by reclaiming it with the improved element substituted for the old element. This the court maid could not be done.

The thought underlying the court's remarks was that except for the suction-effect coupler combination, Gullborg had made but one invention; namely, his particular form of pin fitting; that his right to patent protection had been exhausted in his patent 1,307,733; and that he could not be permitted to extend the monopoly of this old patent. The court, in effect, reaffirmed Leeds & Catlin Co. v. Victor Talking Machine Co., 218 U.S. 301, 325, 29 S.Ct. 495, ILEA. 805.

The rather startling feature of the Supreme Court's opinion is the announcement that the Leeds Case patent to Berliner, Na. 584,543, was a ploneer patent. sider this unimportant, because evidently the Supreme Court has extended, intentisually or otherwise, the meaning of the word "ploneer," for in the Leeds Case the two earlier patents, 372,786 and 382,790, scribed and claimed substantially everything in Berliner, 584,548, then being considered, in the way of disc, record, cabinet, and record in phonograph machines. WAR however, an improvement, jeh I shall later discuss. As a matter of fact, the original phonograph goes back to Edison's patent in 1878. Many

15 F.SUPP.--37

delvers in the art have procured patents since then, but Bell and Tainter, No. 841,-214, includes most of the prior art. As compared with that, the Berliner invention consisted in permitting the stylus of the reproducer to be propelled by and along the sound groove of the record tablet all the way from its outer circumference to its inner end. To accomplish this, it made use of a mounting for the reproducer which would permit it to travel freely throughout this distance. Berliner's invention resided in giving the reproducer a greater degree of freedom of movement to follow the groove in the record, and, by doing so, eliminating the necessity of providing means for relatively shifting the record and reproducer. The new thing was the unrestricted pivotal mounting. This was pointed out by Judge Hasel in the trial court (Victor Talking Machine Co. v. American Graphophone Co. [C.C.] 140 F. 880) and by Judge Hough in the Circuit Court of Appeals in Leeds & Catlin Co. v. Victor Talking Machine Co., 156 F. 58, 23 L.R.A.(N.S.) 1027. Consequently, the statement of the Supreme Court in the Leeds Case that the patent was a pioneer must be taken into consideration with the record disclosing its place in the history of the art.

In Leeds & Catlin Co. v. Victor Talking Machine. Co., 213 U.S. 301, 311, 29 S. Ct. 495, 53 L.Ed. 805, the court had to do with a combination consisting of the elements: (1). A traveling disc having a sound record formed thereon; (2) a reproducing stylus, shaped for engagement with the record and free to be vibrated and propelled by it. It was, therefore, a true mechanical combination device, producing by the co-operation of its constituents the result specified in the manner specified. The Leeds records were equally suitable for use in connection with the Victor machine as well as their own machines. The court held that there was contributory infringement.

The result was in general the old result of producing or reproducing articulate sounds. But the new and unitary result was the production of articulate sounds by the automatic swing of the stylus across the disc record; in this respect only the patent was a ploneer. Everything else was old. The new thing was the pivot or hinge for the stylus so that it might be propelled by the record all the way across the face of the record. The various elements per-

seased no utility without co-operation in combination. Each element was necessary to the operation of the whole.

From an examination of the Leeds opinion I believed that the basis of the decision relative to the Gullborg patent was that this inventor of pin fitting, part of the complete combination, part of which had already been separately patented, did not bring about any new mode of operation or co-operation in or among the other elements thereof. It did not alter or modify or give new functions to any of the other parts of the combination; and, therefore, the old parts did not participate in a new way in the accomplishment of a new and unitary result. As pointed out by Judge Thacher in the District Court in Bassick Mfg. Co. v. Adams Grease Gun Corporation 39 F. (2d) 904, 905, in discussing the Gullborg patent, where he says: "The novelty in Gullborg's fitting was merely. in the use of the same pin to furnish bearings for the slot and an abutment for the spring, and it was only this specific form of construction which was patentable. Lyman Mfg. Co. v. Bassick Mfg. Co. (C. C.A.) 18 F. (2d) 29. Thus it will be seen that there was no functional novelty in combining such a pin fitting with a bayonet coupler and a grease gun. The old combination of the gun, the bayonet coupler, and a pin fitting with ball and spring valve would work as well and accomplish precisely the same result. To extend the combination claims to cover the use of any old gun and any old coupler on a Gullborg fitting is clearly not permissible in view of the prior art, which limits novelty in the pin fitting to a specific form of construction and deprives the aggregation of elements of all patentable novelty as a combination. Whether its elements be old or new a combination is an invention distinct from them."

The ground for decision appearing in these opinions is not applicable to the Butler patent, claim 2. Here the question is whether Butler produced a combination which achieved a new and unitary result by the co-operation of all the elements, whether all the elements have new or modified functions as a result of changes or substitutions, or whether the old elements have only the old functions operating and co-operating in the old way to produce only an old result. We have seen that the combination compass of seven elements, all of which are old; that invention arises not from any one element, but from the

new unitary result. Defendant insists the essence of the combination is the cler, but we have seen this is a falled theory, for if it were correct and available to excuse the use of the nipple to earte in the combination, one person a make the nipple, another the cylin another a group of jaws, another the ing seat; another the piston. Inchese are old; each of them sell separate. The purchaser could quickly assent them and then claim that each part had independent status apart from that in Butler combination. There could the no infringement.

The headed nipple, which co-oper with the sealing seat and jaws of the pler and thus with the piston and cylin is just as essential a part of the Butle vention as any of the several element the coupler. There is co-operation tween the nipple and the jaws which duces the operation of the seal, which turn effectuates the operation of the ing jaws, making possible heretofore achieved pressures. The headed n has new functions arising out of d co-operation with the jaws. The 1 spreads the jaws of the coupler when latter is attached and thus prepares coupler for operation in bringing abou mechanically strong and lubricant In detaching the coupler the ! of the nipple engages and pushes the outwardly. These in turn push the pi backward, thereby effecting the releas the coupler from the nipple. The pres and the action of the nipple are essen because the nipple alone makes it pos to build up in the cylinder of the con a grease pressure which will force jaws into gripping enforcement with nipple. The nipple is not merely a ceptacle. It becomes an element w coacts to influence and make possible desired operation of the coupler me nism.

Butler was the first to utilize a her nipple and a compressor as co-operation of a combination whereby grease-tight and mechanically strong nection between compressor and bear were effected automatically in and by grease pumping operation of the pressor alone.

The high pressure delivery of graften the compressor to the interior of bearing, due to the strong and greatest attachment of the grease gun to the grassageway of the bearing, was a statement of the passageway.

15 F. Supp. 871

useful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operatod and co-operated in new ways in order to accomplish the single new result. invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new conbination. The situation is not one where the language of the Supreme Court in the Sullborg Case (56 S.Ct. 787, 791, 80 L.Ed. -) is applicable, for in the sense that the Supreme Court used the term pioneer, Sutler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. Just as the Supreme Court said of the Berliner patent, "each element was necessary to the operation of the other."

What has been said with reference to the Hollingshead and Rogers Cases is equally applicable to the recent decision of Judge Schoonmaker in Stewart-Warner v. Rogers, and Stewart-Warner v. Universal Lubricating System, Inc., 15 F.Supp. 410, in the District Court for the Western District of Pennsylvania.

Defendant insists that the history of flie wrapper is fatal to Butler's claim in view of the fact that the third claim was canceled and that the present claim construed as contended by plaintiff is equivalent to the rejected claim. I do not believe such result follows, for the plaintiff is not asking to have claim 2 interpreted or construed in such way as to include the mechanism of canceled claim 3. There is no estoppel as contended.

Defendant argues that to decree this combination valid is to deprive prior patentees of valid old elements included in the combination of their rights and to limit them and their uses. But we believe that the complaint is not well founded. Defendant is free to make and use the old articles, for use in the old manner taught by the prior art, but when these old elements are included in the new combination, achieving a new and unitary result, we may not deny validity; "then, indeed, the protection which is promised by the constitution and laws of the United States to inventors is a poor sham. Many of the most valuable patents are combinations nonpatentable elements, and the only effective mode of preventing infringement is by suits against those who, by furnishing

the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who, by advertisement of the sale of such parts and otherwise, intentionally solicit and promote such invasions of the patentse's rights." Thomson-Houston Electric Co. v. Ohio Brass Co., 80 F. 712, 721 (C.C.A. 6), opinion by Judge Taft.

Defendant argues at length that the sealing mechanism of Butler is not in combination with the gripping mechanism but constitutes mere aggregation. It is to be observed, however, that the operation of the gripping mechanism is absolutely dependent upon the operation of the sealing mechanism and that the operation of the latter is dependent upon the operation of the former. Each is dependent upon the other. Functioning in co-operation and co-ordination is necessary to produce the desired result. This is not aggregation.

A great deal of attention has been given to the argument that the Butler invention must be limited to a flimsy spring finger between the piston and the jaws of the coupler. Irrespective of the decision of the Circuit Court of Appeals for the Eighth Circuit (Stewart-Warner Corporation v. Jiffy Lubricator Co., 81 F. (2d) 786), the record of which is not before us, it is sufficient to say that the evidence here presented discloses clearly that the operability of the Butler invention was not dependent upon any particular degree of springiness; that device will operate satisfactorily to accomplish all the results described by Butler, if the piston is rigid or very springy, or only slightly so. Furthermore, there is nothing in the claim of the Butler invention which does not apply to the rigid assembly of Butler's original device, in evidence, in the same manner as it applies to the flexible sample made and produced by defendant. Butler in no place makes any claim which recognises as essential this factor. I cannot read into claim 2 any requirement of springiness or spring fingers.

Defendant cites certain prior art. Newton patent, No. 1,118,876, discloses a device for use in testing under pressures of 100 or 150 pounds per square inch the air brake hose couplings of cars in railroad trains. It includes no headed nipple, lubricant compressor, aperture for discharging gresse, apertured scaling seat carried by a piston for engagement with the nipple, and nothing whereby the pres-

sure of the lubricant on the piston will move the said element to compress forcibly while the lubricant is passing through the connecting parts. It teaches nothing of what Butler achieved. The modified structure produced by the defendant I believe does not follow the teaching of Newton. It is impractical for Newton's purposes, and does not teach what Butler taught.

Defendant insists that Lincoln cannot contributorily infringe the Butler patent because plaintiff's coupler part is not constructed according to the Butler patent, and claim 2 does not properly cover plaintiff's hydraulic apparatus. I believe the previses are not well founded, but that plaintiff's construction follows the teaching of claim 2.

[5] Defendant contends that nonuse of Butler device for some time renders the patent therefor subject to a strict construction, and that it should be construed so that it will not be infringed by Kleenseal fittings. It seems that Butler did not manufacture under his patent for two orthree years, but immediately upon the purchase of the patent, plaintiff began to manufacture under the same and put its product into the widest possible commercial use, and such use has grown to the extent that the combination is used on 99 per cent. of the automobiles made and sold in America. This success had been attained a year prior to the commencement of manufacture and sale of the nipple of defendant. There is no legal reason why, when commercial success has resulted and a late infringer seeks to defend, he should be allowed to my that the patent is limited in some way because in the first two or three years of its life no manufacture took place. There is estoppel where defendent did not begin its manufacture until after commercial success had been achieved by the new owner of the patent.

Defendant contends that its nipples may be used in association with compressors and nossles other than those of the Butler patent. To my mind this is an unimportant fact. The round-headed and straight-eided nipple which defendant first

designed could be used with all of to other compressors, but could not be with devices built in accord with Brown When defendant changed from a nofringing device which it could use to other nozzles, to infringing devices we could be used and were intended to used in combination with plaintiffs to plers, it began its infringement.

As Walker on Patents (6th Ed.) 554, said:

"But where the machine or other preserve thus furnished, is useful for so other purpose than to be a part of a pented combination, or to make a patenticle, or to be operated upon by a sented machine, or to be used in perform a patented process, and where he are Turnishes the property, does not intend know, when furnishing the same, that it to be thus used, he incurs no liability an action for infringement.

"But if he knew or intended that property furnished by him was to be us in either of the infringing ways, he cannot defeat an action for infringement, showing that the furnished property can have been used in some non-infring way.

"In the absence of specific proofknowledge or intent, the fact that a property furnished could be used with article or machine which in itself could be an infringement and that there many such articles or machines in use sufficient to absolve one who supples a property from the charge of infrishment."

[6] I conclude, therefore, that claim I a valid patentable combination; that defendant's fittings sold, with the knowledge and understanding that the same we to be used in co-operation with the Alexandressor, are a contributory inframent, and that there is nothing in defeant's contentions to avert the result consequences.

The findings of fact and conclusions law incorporated herein will be included in my formal findings and conclusion adopted this date.



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IN THE

### DISTRICT COURT OF THE UNITED STATES

FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION.

> STEWART-WARNER CORPORATION. · Plaintiff.

> > LEVALLY, ET AL., Defendants.

### FINDINGS OF FACT AND CONCLUSIONS OF LAW.

I find the facts to be as follows:

(1). Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder.

(2) Defendant Lincoln Engineering Company of Illinois is the distributor for the Chicago territory of lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation.

(3) The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St.

Louis, Missouri, a Missouri corporation.

(4) The Butler patent in suit No. 1.593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shouldered nipple or fitting is provided for attachment to each bearing of an automobile or other machine to be supplied with lubricant from a lubricant compressor or pump by successively attaching to the nipple, a coupler with which the nipple cooperates to make a lubricant-tight connection by engagement against the end of the nipple, and which coupler has jaws engageable about the throat of the

604 nipple automatically to grip the nipple when the com-pressor is operated in the customary way to deliver lubricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the

grip between the nipple and the coupler, are increased proportionately with increases in the pressure of the lubricant being supplied to the bearing.

(5) In practical operation grease pressures running up to thousands of pounds per square inch are frequently required in order to force the grease into the interstices of a bearing.

(6) When the compressor is operated to inject grease under these high pressures, the tendency is to burst the compressor, coupler and the nipple, and to break open the con

nection between the coupler and the nipple by forcing these

parts asunder.

(7) Because of the tremendous pressures which must be developed in a lubricating system, it is important in order to prevent leakage of lubricant to secure the maximum tightness of seal and the maximum mechanical grip. Both the strength of the grip and the tightness of the seal must be proportional to the pressure of the grease to be transmitted. If the seal is not sufficiently tight, the grease will escape,—and the requisite pressure cannot be developed. If the grip is not sufficiently strong, the parts will be forced asunder.

(8) In the Butler combination the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal

and grip becomes greater.

(9) In the Butler patent the end seal member is moveable and thus may adjust itself to fittings of slightly different dimensions.

605 (10) Any resiliency in part 42, referred to in the Butler patent as constituting "spring fingers," serves the purpose of compensating for any slight out-of-roundness

of the fitting.

(11) Butler, applicant for the patent in suit, presented to his solicitors for the purpose of preparing the application for the patent in suit, a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow cylindrical part, corresponding exactly to the disclosure in Fig. 2 of the Butler patent here in suit. Claim 2 of the patent describes this early sample of the invention.

(12) Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler, and the mechanical grip between the nipple and the coupler, were effected automatically by the pressure of the lubricant in and by the normal

pumping operation of the compressor.

(13) Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws, and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result.

(14) Prior to manufacturing and selling the Alemite Hy-

draulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent

No. 1,475,980.
606 (15) Plaintiff commenced selling the Alemite Hydraulic lubricating equipment exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive, in April, 1933.

(16) Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof.

(17) Of the 6,306,000 Alemite Hydraulic coupler parts

(17) Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April, 1933, to March, 1936, approximately 4,485,000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the cars at the factory.

(18) The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullborg and the Zerk lubricating equipment be-

cause:

(a) Under this equipment, it was not necessary to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting,—as was necessary in effecting a connection between a Gullborg coupler and fitting, and

(b) It was not necessary for the user to apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lubricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception

of the Duesenberg.

607 (19) The mechanism embodied in the means by which
the jaws are compressed about the nipple of the Alemite
Hydraulic system, is identical in its mechanical principles
with that disclosed in the Butler patent. It is a simple
equivalent involving a mere reversal of parts.

(20) The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent,

(21) The Lincoln Engineering Company of Missouri initially engaged in the business of making and selling automobile lubricating equipment in 1925, supplying its equipment exclusively to plaintiff. This relationship between the Lincoln Company and the plaintiff continued for several

years thereafter, until 1933.

(22) When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile lubricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or nozzles of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fitting.

(23) In May, 1933, Mr. A. P. Fox, the vice-president and designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraulic system. Although he had known of the compressor and coupler parts at an earlier date, he became familiar

with them at least as early as January, 1935.

(24) The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hy. draulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part of the plaintiff's nipple part.

608 (25) The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydraulic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of slightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make.

(26) The defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, sell

any Lincoln Kleenseal fittings.

(27) Defendants sold "Lincoln Kleenseal" fittings with the knowledge that they were to be used in combination with the compressor and coupler parts of the Butler combination as sold by the plaintiff for use with plaintiff's Alemite Hydraulic coupler equipped grease guns.

(28) The Lincoln Engineering Company of Missouri ex-

pected that automobiles equipped with the Lincoln nipple part of the combination and sold in the United States; would be lubricated at garages and services stations. The plaintiff had previously sold millions of the compressors and coupler parts of the combination, and had endeavored to supply every public garage and service station in the United States.

(29) The Lincoln Engineering Company of Missouri in its Kleenseal fittings, duplicated, fitting for fitting, all of the arbitrary dimensions of the entire line of Alemite Hydraulic

(30) The Lincoln Engineering Company did not sell any of its grease guns or nozzles to automobile manufacturers for tool kit equipment of automobiles sold in the United States, even though the automobiles were equipped with Lincoln

Kleenseal fittings.

(31) There is nothing in the Butler patent which requires the use of spring fingers which can yield a sub-

(32) The Lincoln Engineering Company initially submitted to the Standards Division of General Motors Corporation a fitting like the Kleenseal fitting, but without the peripheral groove or shoulder or head. But General Motors never purchased these ungrooved fittings. Instead, it purchased the Kleenseal fittings having the groove, and cooperable with Alemite Hydraulic couplers.

(33) The Alemite Hydraulic coupler will grip and form a sealed connection with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent describes one combination as well as the other.

(34) Defendant's model of Fig. 2 of the Butler patent does not accurately or fairly represent the invention of Butler.

(35) Defendants' Exhibit A-61 does not correspond to the alleged drawing thereof, Defendants' Exhibit C-21.

(36) Defendants' expert, stated, that none of the prior art except Winkley Reissue Patent No. 14,667 accomplishes the results obtained by the Butler patent.

(37) The Winkley Reissue patent No. 14,667 does not disclose the radially movable locking elements, the piston, or the means actuated by the piston for compressively clutching the locking elements upon the nipple, as Butler's invention is defined in claim 2 of his patent. The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in Butler's claim 2.

610 (38) The particular shape of the oil cup shown in the Richardson patent No. 8,251 has no significance of func-

tional utility.

(39) The patents to Paul No. 621,276, Ulleland No. 1,253, 309, and Pinel French No. 327,557, each discloses a construction readily distinguishable from that claimed by Butler in that in each of these prior art patents the locking elements are not actuated by any piston not automatically by the pressure of the grease.

(40) The patent to Newton No. 1,118,876 discloses a train hose testing appliance which was never intended to be used for high pressure lubrication and could not be used for such purpose without making a great many alterations of an inventive character in its construction. It does not embody the

combination of Claim 2 of the Butler patent.

(41) Defendants' representation, Exhibit A-68, differs in many material respects from the disclosure of the Newton patent No. 1,118,876, but even with all of the changes which have been incorporated in it in an endeavor to make it work, it is not a commercially feasible or practically operative device for high pressure lubrication.

My conclusions of law are as follows:

(1) This Court has jurisdiction of this suit and of all of the parties thereto.

(2) The Lincoln Engineering Company of Missouri is

bound by the decree herein.

(3) Defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, infringe claim 2 of the Butler patent, and the bill of complaint should be dismissed as to these parties.

(4) Claim 2 of the Butler patent No. 1,593,791 describes a new and useful improvement in lubricating apparatus.
 611 The combinations of elements set forth in this claim are

not anticipated by any combination disclosed in any patent, publication, or prior use antedating the application for the Butler patent.

(5) Butler was the first to have invented the combination

set forth in claim 2 of his patent No. 1,593,791.

(6) The Butler patent contains an adequate disclosure of a novel form of lubricating apparatus which could be made and used for the intended purpose by a mechanic skilled in the art of making lubricating apparatus.

(7) All of the parts of the lubricating system invented by Butler and disclosed in his patent, cooperate in a novel man-

ner to produce a new and unitary result. Each part is dependent upon the other for the performance of its functions, and each part performs new functions because of the presence and cooperation of the other parts.

(8) Claim 2 of the Butler patent No. 1,593,791 is valid.

(9) Defendants have contributorily infringed claim 2 of the Butler patent by their sales of Kleenseal nipples or fit-

tings exemplified in Plaintiff's Exhibits 27a and 27b.

(10) Plaintiff is entitled to a writ of permanent injunction enjoining and restraining the defendant Lincoln Engineering Company of Illinois, its officers, agents, employees, associates and confederates, from making, using, and selling lubricating apparatus, particularly fittings of the kind exemplified in Plaintiff's Exhibits 27a and 27b, or any other device or devices embodying the invention of claim 2 of Butler patent No. 1,593,791, or any of the parts thereof, or any of the coupler or fitting parts adapted and intended to be used in combinations embodying the invention of said patent, and from offering or

advertising so to do, and from aiding or abetting, or in 612 any way contributing to the infringement of said patent.

(11) Plaintiff is entitled to recover from the defendants the profits which said defendants have made, and the damages which plaintiff has suffered by reason of the said defendants' infringement of the Butler patent in suit, and to recover its costs and disbursements of this proceeding, in accordance with the statutes and rules in such cases made and provided.

I adopt as a part of these findings and conclusions of law and incorporate herein as a part hereof by reference all findings and conclusions of law included in my memorandum

opinion entered as of even date hereof.

day of July, A. D. 1936. Entered this . Walter C. Lindley, Judge.

Filed July 15, 1936.

Opinion of Judge Lindley Upon Petition for Rehearing Delivered October 5, 1936. Stewart-Warner Corporation v. Levelly et al., 16 F. Supp. 778-783.

### STEWART-WARNER CORPORATION v. LEVALLY et al.

No. 13955.

District Court, N. D. Illinoia, E. D. Oct. 5, 1938.

### 1. Equity \$\ightrianglerightarrow 392

Practice of rearguing issues previously determined in petition for rehearing is not to be encouraged.

### 2. Patents == 315

In patent infringement suit, reasonable diligence before hearing in procuring evidence offered as newly discovered, as ground for rehearing, held not shown, where such evidence consisted of statements made to Patent Office in course of solicitation of another patent which were available before trial.

### 3. Equity 4=392

Trial court cannot consider evidence on rehearing which could have been discovered with reasonable diligence before trial.

### 4. Patents 4=315

New evidence must be material or helpful in determining issues to constitute ground for granting rehearing in patent infringement suit.

### I. Patrate 4=818

Statements of counsel for plaintiff who prevailed in patent infringement suit as solicitors for another patent which were proffered as newly discovered material evidence, held not to warrant a rehearing.

### 6. Patents == 26(1)

New combination involving only a variation in method of reducing original idea to practice, or which varies idea of means without changing essential character, or giving substantial increase to practical efficiency, is mere change of form, not constituting invention.

### 7. Patents c=19

Change indicating introduction into the idea of means of a different force, a different object, or a different mode of application, is a separate invention.

### 8. Patents = 316

Decree enjoining manufacture and sale of nipple contributorily infringing patent beyond limits of United States held too broad and would be limited to operation within United States.

On petition for rehearing.

Rehearing denied, original decree vacated, and decree rendered in conformity with opinion.

For former opinion, see 15 F. Supp. 571. Williams, Bradbury, McCaleb & Hinkle, of Chicago, Ill., for plaintiff.

Wilkinson, Huxley, Byron & Knight, of Chicago, Ill., Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., and Leonard L. Kalish, of Philadelphia, Pa., for defendants.

LINDLEY, District Judge.

Subsequent to the entry of decree herein, defendent Lincoln Engineering Company of Illinois filed its petition for rehearing, supported by affidavits and exhibits.
Plaintiff appeared in defense thereto and
filed its counter affidavits and exhibits.
Extended oral arguments were heard and
briefs of no inconsiderable length submitted.

[1] Defendant's first premise is the alleged discovery of additional material evidence; its second, alleged error by the court in its findings, conclusions and decree. Defendant's action in the latter respect is equivalent merely to an attempt to reargue issues previously determined, after a vol-

uninous record had been made a and complete briefs and argumen mitted. Such practice is not to be aged, for, if a court has once rende best efforts to arrive at proper soluquestions submitted, upon complete tation, it should not be subjected to mand to consider the same again, wise, litigation would never end; would become immortal, and the be postponed indefinitely." Jenkins dredge, Fed.Cas. No. 7,267, 3 Stor 305 (Story, J.).

[2, 3] Defendant alleges that, sin

trial, it has discovered additional evidence, consisting basically of sta made to the Patent Office in the co the solicitation of Bystricky pate 2,016,809, issued on October 8, plaintiff, as assignee. Aside fro question as to materiality, when the was issued on October 8, 1935, its and the file wrapper thereof becam able to the public, including de Any time thereafter any one cou obtained a complete transcript of ord in and about the application allowance of the patent. Moreover, time of the trial herein, defendant sel had in its possession a transcrip record of Stewart-Warner v. Rog Stewart-Warner v. Universal Lui Systems, Inc., et al., suits tried in trict Court for the Western Dis Pennsylvania, wherein defendants in evidence, the Bystricky pate wherein, according to the said tr arguments were submitted to the to its admissibility and testimony troduced regarding it, 29 pages in on October 30 and 31, 1985. Con defendant stated, at the trial of th in April, 1936, that he had five constituting the entire transcript said suit. Consequently, he was with notice of the contents thereof the fact that the Bystricky patent sued and that he had access to wrapper at any time. Furthermore ciate counsel, who now appears case, tried those cases in Penn Thus, there is utter failure to sh defendant exercised reasonable before the hearing in this cause, in ing the evidence now proffered a discovered. This essential lacking, cannot rightfully consider the Pittsburgh Reduction Co. v. Cow tric Smelting & Aluminum Co. ( 125; McLeed v. New Albany (C.C.A.) F. 878; Allis v. Stowell (C.C.) 85 F. Moneyweight Scale Co. v. Toledo esting Scale Co., 199 F. 905, 118 C.C. 256; Australian Knitting Co. v. 186; Health Underwear Co., 121 F.

Worcester Gaslight Co. (C.C.) 190

15. a rehearing was denied where the second claimed to have discovered that the patent anticipated the one in suit, the such patent was referred to in the such patent was referred to in the second patent was referred to in the second patent was referred to in the second patent, Similarly, because of the discovery of a mortgage on the patent, which is shown by the file wrapper then put in citimo. Money-Weight Scale Co. v. To-

However, despite the insufficient showin this respect, the court, at a sacrifice no inconsiderable time and labor, has sined the offered evidence and the suggestions of counsel with a view determining whether, had the plaintiff rised diligence, there is anything in newly offered evidence which would eve changed the result or which bore sterially upon the issues adjudicated. bylously, the first question to be deterd, is whether the new evidence sought be introduced would have been material helpful in determining the issues. its proffer is wholly futile. Section II, Walker on Patents; Munson v. New ork (C.C.) 11 F. 72; New York Grape par Co. v. American Grape Sugar Co. (C.C.) 35 F. 212; Bates on Fed. Procedure, 2 1 683; Foster's Fed. Practice (2d 11) 352.

The statement in the file wrapper, to the defendant directs the attention the court, was made by counsel for ntiff herein as solicitors for the Bytricky patent, in the course of argument to patentability of certain claims previir rejected, to the effect that the comstion there submitted, had, in the short it had been on the market, been unially accepted by manufacturers, and standard equipment upon automomade in the United States. It was the solicitor, therefore, that any as to patentability should be resolvor of the numiticant. In itself, of is whethy valueless in the states record, but it is separal by a followed to its logical comme

means that the Alemite Hydraulic System considered by the court in the present case was thereby admitted to be exclusively the invention of Bystricky.

Upon examination of the Bystricky patent and a re-examination of the record herein, although the validity of the patent is not before me, it seems obvious to me that Butler was a pioneer in the field of lubricant pressure in the sense that that term was used by the Supreme Court in the Leeds & Catlin Case (Leeds & Catlin Co. v. Victor Talking Machine Co.), 213 U.S. 301, 29 S.Ct. 495, 53 L.Ed. 805, and that Bystricky invented an improvement upon the Butler construction. The findings of fact and conclusions of law heretofore entered, which I see no occasion to modify, pointed out Butler's invention and found that the Alemite System embraced the Butler invention. Nothing now urged moves me in the slightest degree to conclude otherwine.

Another statement of the solicitors in the file wrapper is that the Bystricky coupler was not "practically operative except in combination with a compressor of a certain definite type, in which means are provided to relieve or partially relieve pressure in the discharge conduit so as to facilitate disconnection of the coupler from the fitting." It is contended that this argument clearly indicated that the Alemite System does not embody the Butler invention, but rather Such statement is in that of Bystricky. nowise inconsistent with the record herein, for, as we have seen, Bystricky is merely an improvement upon Butler and used the same means for release of pressure. I that the proferred conclude, therefore, evidence, if received, would be immaterial, but if material, would not have affected the result.

The contention that the court has misconstrued the decision of the Supreme
Court in Bassick Mfg. Co. v. B. M. Hollingshead Co. (Rogers v. Alemite), 298 U.
S. 415, 56 S.Ct. 787, 80 L.Ed. 1251, is clearly reargument of something fully presented
at the original hearing. But I have again
examined the opinions of the Supreme
Court and have had submitted to me a
transcript of the record of the Hollingshead Case in that court, as an exhibit in
answer to the petition for rehearing. I
adhere to what I have said in my opinion,
findings, and conclusions in that respect.

In my memorandum, I made a statement to the effect that the record in the Counsel for defendant disagree. The word is one of comparative counctation. The transcript shows 181 pages of testimony, which is a short record as compared with the present one. But whether the record was short or long, is, after all, wholly immaterial. The important thing was the limited character of the issue presented to the court.

Due to some mental aberration, in the original opinion, I made the statement that the Court of Appeals for the Sixth Circuit "affirmed" the holding of the lower court. Obviously the court did not affirm the decision of the district court, but did agree with its conclusions in the respects underconsideration when I used the expression.

The word "affirmed" should have been "agreed." If we attribute to the word "affirm" its strict legal significance, the error, in the words of counsel for plaintiff, was merely lapsus linguae.

We may well again refer to the character of the Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip between the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Former devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of those, some leakage occurred, and physical manipulation entailing some labor was neces sary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable prossure, and with the saving of labor re-sulting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in a way that, when pressure is exerted and the greate passes from the coupler in-

to the fitting the coupler grabs hold of the projecting shoulder of the nipple with jaws and automatically, as the pressure the grease increases, simultaneously, power, force, and closure of the con tion increases, so that it is impossible grease to escape and any desired preof grease may be transmitted with breakage of parts or leakage of material All this was accomplished without further manipulation other than the easy, almo automatic, attachment of the coupler to the nipple and the application of the pressure This, I have said, was a step forward h the greasing of automobiles. No one ever taken it, though the art is full at grease guns and nipples. It remained by Butler to devise an easy operable combiation in which the nipple and the couple automatically co-operate, each contributing its part to the one result of high-pressure grease delivery through a sealed come tion, effected automatically and increasing in efficiency with the increase of the new sure. This, I said, was invention and the combination, I held, became, therefore a pioneer invention in the sense that the 85preme Court used that word in the Lees & Catlin Case.

[6, 7] Obviously, most modern invention are of combinations. Changes in the art are effected either by the addition of new elements, the withdrawal of existing elements, alteration in their qualities or arrangement or substitition of a new element for one previously employed. Each of these changes may effect a mere change of form, or an improvement of an old in vention, or a new invention. If the new combination involves only a variation b the method of reducing the original idea to practice or if, while varying the idea of means, it neither changes its essential chanacter nor gives substantial increase to its practical efficiency, it is a mere change of form, involving no invention. "If the change indicates the introduction into the idea of means of a different force, a different object, or a different mode of application, it is more than a change of form more even than an improvement; it is separate invention. If it preserves the sential characteristics of the original a vention, applying the same force to the same object by the same method, but a complishing results with higher excellen or with greater economy of time or pow and is not the product of mechanical skill alone, it is an improvement." Robinson of mts, vol. I, ch. 11, § 215, p. 299. (Ital-

Where the apparent variation in the invention produces no change in enets or in the economy of time or if the factors and the mode of oper-of the original and improved invenare the same, the variation must be ambodiment alone; if different, the in-Where the effects produced by the contion in its changed condition differ in ture from those accomplished by it in the the change has passed beyond the lime of a mere improvement and has resulted a new invention. If the effects, although same in nature, are so enhanced in exstate that the original idea of means, in form of embodiment, could have proseed them, the change is more than foral but may be either an improvement or new original invention. In this case, as that wherein no change occurs in the efthe original and improved inventions be compared as operative means and ramined in their mode of action as well as the subordinate idea of which each is omposed. If this examination discloses a phetantial-difference, either in the nature f the operation or the means, the two inentions are distinct; otherwise the latter mere improvement on the earlier." lebinson on Patents, vol. 1, ch. 11, § 216. Italies mine.)

So, bere, Butler introduced into the art idea of an automatic sealing connecion achieved by the size and character of lements, which, in themselves, were old. but he employed a different mode of operaion. He achieved his object by means of different force and according to a differat and new conception. His. invention hen was not an improvement but a new and separate invention, and, within the sesoning of the Supreme Court in the ceds & Catlin and the Hollingshead and legers Cases, a ploneer. In the latter two the court was not dealing with a mbination patent wherein, by the use of supple of a certain particular form and hape and dimensions co-operating with the gripping jaws of a coupler of special and shape, an automatic unbreakable maction was achieved, making possible hat highly desirable thing in automobile a unlimited pressure. Butler did est combine a certain coupler with any e. He did not combine a certain nipis with any coupler. He was not, as the

Supreme Court believed Gullborg had done, trying to extend his patent to a combination of a certain nipple with any kind of grease gun, Quite to the contrary, he demonstrated conception of a new creative thought, the achievement of a new valld combination in which not only the coupler was essential, but in which also the nipple of peculiar shape and dimension was sential. He produced a new combination, a new arrangement of known elements, by virtue of which he produced an entirely new and beneficial result. He developed new functions and new properties and achieved novelty, resulting in great commercial success.

In this situation, defendant entered the field and developed its nipple of equivalent form, shape, and dimensions, which it sold, obviously, for use with Alemite guns, supplanting in the combination of Butler the nipple essential to his success. It is a striking fact that a nipple of this shape and dimension was not necessary to the operation of defendant's grease gun or of any guns other than those of plaintiff or of infringers or licensees of plaintiff-a fact of tremendous significance in determining the purposes and intent of defendant. It sold grease guns which operated with straightheaded nipples as well as with nipples with head and shoulders. It first made straight-headed nipples and exhibited them to General Motors Corporation, but it sold to that company only nipples of infringing character, a character not essential to any combination other than plaintiff's.

Despite the fact that the court would have been justified in denying the petition" for rehearing because nothing therein constituted newly discovered evidence and because the record shows that the defendant failed to exercise reasonable diligence to discover the evidence claimed to be newly discovered and despite the inclusion in certain affidavits of improper, well-nigh scandalous, irrelevant averments, I have examined everything submitted, re-examined the authorities, and again endeavored to make myself clear. Clearly, no new material evidence has been suggested. The attempt to reargue the merits of the case, though not exactly praiseworthy upon the part of counsel, has been met by a reexamination of the record and of my in ings and conclusions. The patition for hearing is denied.

[8] It appears that the decree was too broad in enjoining the manufacture and 987

### STEWART-WARNER CORPORATION v. LEVALLY

16 F. Supp. 778

sale of the nipple contributorily infringing, beyond the limits of the United States. Accordingly, the original decree is vacated, and a decree properly enjoining defendants only within the United States and in conformity with my findings of fact and conclusions of law and this memorandum will be entered.



District Court, N. D. Illinois STEWART-WARNER CORPORATION

IN R. LE VAILY and FREDERICK A. FAVILLE, doing business as Lincoln Engineers into Company of Illinois, and Lincoln Engineerine Co. of Illinois Equity No. 13955 Decided Oct. 26, 1986

-Injunction-In general-

Whether court shall grant supersedeas lies within its discretions and that discretion ould not be abused; supersedeas is denied where infringement is clear and can be sided readily by slight change which defendant is already prepared to make.

Appeals to Circuit Court of Appeals—In general—

District Court approves bond on appeal, enters order and citation, but does not prove assignment of errors which put into its words something expressly dissimed in its memoranda; court does not tell clerk what shall be incorporated in cord or go in praccipe.

On defendant's petition for supersedeas and stay of injunction.

(See also 30 USPQ 345 and 31 USPQ 171.)

LYNN A. WILLIAMS for plaintiff; DELOS G. HAYNES for defendants.

LINDLEY, District Judge.—It is obvious, of course, that whether the Court shall grant a supersedeas, lies within its discretion, and that discretion should not be abused.

This case has been before the Court for some time and a rather extensive record was made up on the trial of the case. The Court expended a great deal of time, care and study in the preparation of its memoranda, its findings of fact and con-clusions of law, and a decree was en-tered [30 USPQ 343]. A petition for rehearing was filed and an assignment of errors upon the part of the Court, and on September 12th, a rather extensive hearing was heard upon that, and again, the Court made a scrutiny of the record and again gave its best efforts to the examination of the record and the decisions which it was contended he had a complete misapprehension of, and again a memorandum was prepared and submitted to Counsel, and again a decree entered, modifying in one particular a provision of the decree which was obviously too wide [31 USPQ 171].

Now, it is desirable that litigation be ended: it is desirable that there be some diligence toward the prosecution of an appeal and the early disposition of it. I have the conviction that this patent is I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a centinuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary - the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that

tort in the protection of the defendants interests, I am not disposed at this time in view of the time that has elapsed sine the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals. That Court may grant a supersedeas. I want this case heard on appeal and heard som and I think if I deny supersedeas, I can speed matters up so that it can be heard at the January session. I can't see that this defendant can be injured in any way. Of course, it is a selling agency, but in selling agency is allied with the manfacturer and the manufacturer defended the case. . They can make their nipples as they proposed, with a straight side: they can eliminate the head and should they can do that overnight. They der; they can do that overnight. They have their drawings all made—they have had them for several years. They started out with the straight side nipple but the Oldsmobile people wouldn't take them.

The prayer for supersedeas will be anied, bond for the appeal to be fixed at Three Hundred (\$300.00) Dollars, and the form of the order will be the form submitted by Mr. Williams.

I don't approve of the assignment of errors, for they put into my words something which I expressly disclaimed in my memoranda, and I don't want the Court of Appeals to be misled as to what I did hold. I have tried to make it clear in the two memoranda which I prepared in this case, and I shall not be misquoted without an expression of my disapproval of the form of the assignment of errors, and I shall not tell the clerk at this time what shall be incorporated in the record and what shall go into the praccipe, be cause that is pre-judgment. The rule is that that should be made up when the praecipe is filed.

The bond for the appeal in this case shall be fixed at Three Hundred Dollars (\$300.00) and the citation be issued as of this date, and I suppose you can get service upon Mr. Williams at this time, since he is present.

Mr. Williams: I accept service right now.

The Court: You have your bond, Mr. Haynes?

Mr. Haynes: It will be less effort to file a bond for One Thousand Dollan than Three Hundred Dollars, as I have a bond for that amount.

The Court: Very well, I will make it One Thousand (\$1,000.00) Dollars, we that you will have it. The Massaciusetts Bonding and Insurance Company is a recognized bonding company? Mr. Haynes: It has been signed by an attorney-in-fact who tells me his name is registered in the Court in Chicago.

The Court: I approve the bond. Let the record show the bond approved, order entered and citation issued.

Opinion of United States Circuit Court of Appeals for the Seventh Circuit Delivered on June 29, 1937 (2, 828-844).

Lincoln Engineering Co. of Illinois v. Stowart-Warner Corporation, 91 F. (2d) 767-768.

### NCOLN ENGINEERING CO. OF ILLI-NOIS T. STEWART-WARNER CORPORATION

No. 6103.

Court of Appeals, Seventh Circuit. June 29, 1987.

Rehearing Denied Sept. 15, 1937.

### Patenta == 26(1)

a "combination" contemplates a pluralof units, but patentable invention can by redde in a "combination" when it is seldered as a unit.

Toubhation (In Patent Law)," see

### Patento C=41

If all elements of unit are old but have an appeared together in combination, and or coact so as to avoid charge of aggregaon the combination is not lacking in novelso as to bar patentability.

### Patents 0=42

Where combination consists of five elecits and inventor uses four elements in ine way and for same purpose as in preous combination, but substitutes new eleent for remaining element of old combinaon and obtains desirable results, new comnation is not lacking in novelty so as to bar itentability.

### Palents 6=41

Where combination consists of five elecits and inventor uses four old elements have way and for same purpose as in release combination but substitutes for reaining element old and well-known eleest which has never been used in combinaon with such other four elements, new comments of the combination may be patentable.

### Palenta (== 26 (114)

As old combination may not be repat-

### Patents == 328

Patent No. 1,596,791, claim 2, dealing the lubricating apparatus, is not invalid atticipation by prior art.

### Patents 6-42

In a new product is found to be patunity novel; it is immaterial whether patmetric novelty is of pioneer type or mere provement type of invention.

### Talunta 0=328

Patent No. 1,593,791, claim 2, dealing

scribing a "combination," and not an "aggregation."

[Ed. Note.—For other definitions of "Aggregation," see Words & Phrases.]

### 9. Patents @== 26 (1%)

The names of various parts embodied in patent did not determine whether unit was "combination" or "aggregation," and if there was coaction of elements so as to make single unitary structure, there was a patentable "combination."

### 10. Patents \$259(2)

The supplier of an element in a valid combination embodied in a patent might be guilty of infringement, though element was not patentable, and was old.

### 11. Patents \$255

If element of patented combination in very nature of its use wears out, new element may be furnished without producer's infringing.

### 12. Patents == 226, 259 (1)

An infringer and a contributory infringer are tort-feasors.

### 13. Patents = 259 (1)

The maker, buyer, or seller of nonpatented article is guilty of "contributory infringement" only when it knows that nonpatented element is to be used in connection with other elements in valid combination covered by valid patent.

[Ed. Note.—For other definitions of "Contributory Infringement," see Words & Phrases.]

### 14. Patents @= 259 (1)

There can be no "contributory infringement" unless elements in question comprise a "combination," and not merely an "aggregation," since no valid patent can cover an "aggregation."

### 15. Patents \$25

As respects patents, the term "aggregation" defines a phase of general term "non-invention," and when claims compose plurality of elements and their individual or collective selection fails to evidence exercise of inventive faculty, it is not a patentable discovery, regardless of whether coaction of elements is present, but inventive concept may reside in selection of part or parts of numerous old elements, if selection is unusual and hitherto pressing unsolved problem is thereby overcome.

A PARTY AND A SECOND

Invention may be evidenced by modifying coaction of elements, but there may be invention without coaction.

### 17. Patents 4=25, 26(1)

As respects distinction between "combination," which is patentable, and "aggregation," which is not, a "combination" is present if there be correlation or co-ordination of elements which mutually contributes to accomplishment of some result, and there need be no interdependency in sense of one element being dependent on the others for functioning.

### 18. Patenta 4=45

As respects patentable novelty, evidence of wide and popular acceptance of patented apparatus is controlling in doubtful cases.

### 19. Patents 4=328

Patent No. 1,508,791, claim 2, dealing with a lubricating apparatus, is not invalid for lack of patentable novelty.

### 20. Patents 4=328

Patent No. 1,598,791, claim 2, dealing with a lubricating apparatus, was infringed.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

Patent infringement suit by the Stewart-Warner Corporation against the Lincoln Engineering Company of Illinois. From an adverse decree, defendant appeals.

Affirmed.

Leonard L. Kaliah, of Philadelphia, Pa., Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., and Milton T. Miller, of Chicago, Ill., for appellant.

Lynn A. Williams, of Chicago, Ill., for appellee.

Before EVANS, SPARKS, and MA-JOR, Circuit Judges.

EVANS, Circuit Judge.

Appellee is the owner of the Butler Patent, No. 1,593,791. Appellant is the distributor of the Lincoln Engineering Company of St. Louis, Missouri, which is conducting and controlling the defense to this litigation. It is charged with infringing the Butler Patent. The trial was a long one, and the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the

er material lasues. These findings favore the appellee.

Accompanying the findings was an ion which set forth the reasons for the clusions which the court reached. At three months later, upon a petition for hearing filed by appellant, the court file second opinion, which may be found Stewart-Warner Co. v. Levally (D.C.) F.Supp. 778. Three weeks later the o filed a third opinion which dealt with or tions raised by appellant. The third opi appears in 31 U.S.P.Q. 195. Reference made to the places where these opinions pear because it will, we think, justify a m abbreviated statement of the facts. Dis ent conclusions respecting the same d (No. 2) of this patent, so appellant am were reached by other Federal coe Stewart-Warner Corporation v. Jiffy Lone cator Co. (C.C.A.) 81 F. (2d) 786; Stewn Warner Corporation v. Rogers (D.C.) F.Supp. 410.

The decree subsequently entered grams an injunction that restrained future a fringements of the patent and directed accounting of profits and damages consioned by past infringements.

The application for the Butler pater was filed February, 1923, and the patent sued July 27, 1926. It related to Lubricate Apparatus.

Claim No. 2, the one in issue, reads a follows:

"2. The combination with a headed ple for receiving lubricant, of a lubrica compressor having a coupling member i connecting said compressor and nipple co prising a cylinder, a piston movable wi the cylinder and having an aperture for discharge of lubricant thereof, an apertal sealing seat carried by said piston for a gagement with the end of the nipple, necting the piston aperture with a pass through the nipple, radially movable local elements carried by the cylinder coast with the nipple and actuated by said pl for compressively clutching the ele upon the nipple whereby the pressure of lubricant on said piston will move the plat to forcibly compress said elements while t lubricant is passing through said connects parts."

The patent deals with a lubricating paratus. Butler's object, as stated by was "to provide a means of forcing which pressure fluid and semi-fluid lubrications."

and

sure

impounds into bearings, \* \* in that foreign material and used lubriherein may be forced out of the bearing may be forced out of the bearing and self a "co-operating bearing and self bearing lubricating valve, \* \* ing reservoir for lubricant and means automatically feeding the lubricant from to the bearing, \* \* " and matic and semi-automatic means of ction between the bearing valve and abricating pressure means \* \* " scribed.

e Lindley, describing the patent,

. . Butler was the first to proor to devise a lubricating system in the sealing of the joint between the of the nipple and the coupler and the inical grip between the nipple and the er were achieved automatically by the are of the lubricant in and by the norpumping operation of the compressor, · the advantage of this combination from the fact that in the greasing of poblies, in forcing grease into the bearbrough the narrow opening of the fitthousands of pounds of pressure are imes utilised . . . due to the peshape of this nipple, its head and ders couple with the gripping jaws of ouplet in such a way that, when presis exerted and the grease passes from pupler into the fitting, the coupler grabs of the projecting shoulder of the nipple its jaws and automatically, as the presof the grease increases, simultaneously, ower, force, and closure of the conincreases, so that it is impossible rease to escape and any desired presof grease may be transmitted without age of parts or leakage of material. his was accomplished without further sulation other than the easy, almost natic, attachment of the coupler to the and the application of the pressure." short, the asserted superiority and of the Butler lubricating apparatus vofold: (a) The apparatus permits of pplication of thousands of pounds of are with no loss of grease, and (b) an operable device wherein the coupler's increases with the pressure of the

substance of the more important gs of the trial court is:

In practical operations, grease presrunning up to thousands of pounds persquare inch are frequently required in order to force the grease into the interstices of a bearing.

- 2. When the compressor is operated under these high pressures, the tendency is to burst the compressor, coupler, and the nipple, and to break open the connection between the coupler and the nipple by forcing these parts asunder. To avoid this break or separation of coupler and nipple, the maximum tightness of seal and the maximum mechanical grip must be obtained and must be proportional to the pressure of the grease to be transmitted.
- 3. In the Butler apparatus, the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal and grip becomes greater. Butler's seal member is movable and thus may adjust itself to fittings of slightly different dimensions.
- 4. In the Butler combination the end seal and automatic grip both become more effective as the lubricant pressure increases. The end seal member is movable and thus may adjust itself to fittings of slightly different dimensions. Any resiliency referred to in the patent as constituting spring fingers serves the purpose of compensating for any slight out of roundness of the fitting.
- 5. Butler presented to his solicitor a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow, cylindrical part corresponding exactly to the disclosure of Figure 2 in the Butler patent.
- 6. Butler was the first to devise a lubricating system in which the scaling of the joint between the end of the nipple and coupler and the mechanical grip were effected automatically by the pressure of the lubricant, which pressure was produced by the normal pumping operation of the compressor.
- 7. Claim 2 is the only one in issue and describes a combination of seven elements:
- (a) nipple, (b) a compressor, (c) cylinder,
- (d) piston, (e) aperture, (f) jaws, (g) sealing seat. "Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result."
- 8. Appellee began selling Butler lubricating equipment in April, 1988, and prior thereto sold apparatus covered by the Gullborg and Zerk patents. From April, 1988,

to March, 1986, it sold 281,555,000 fitting parts of the Butler combination, and 6,806,000 coupler parts. Over half of the latter were sold with the associate compressors to automobile manufacturers, to be put in the tool kits at the factory. Within eight months after its introduction, the Butler system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States with one exception.

- 9. "The mechanism embodied in the means by which the jaws are compressed about the nipple of \* \* \* (appellee's) system is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts."
- 10. Appellee's system comprises a combination of elements, as set forth in claim 2 of the Butler patent.
- 11. Prior to 1938, appellant was engaged in the business of making and selling automobile lubricating eqquipment to appellee. In 1933, it began selling lubricating apparatus to others. It made and sold couplers and nozzles with the expectation that they would be used with appellee's apparatus. Its nipples were sold with the knowledge that they could, and would, be used as part of appellee's combination. The dimensions of appellant's fittings are exactly such as to fit appellee's coupler. If they did not select exact dimensions such cooperation would have been impossible. Appellant's "Lincoln Kleenseal Fittings" were sold to be used in combination with the compressor and coupler parts of the Butler combination as made and sold by appellee. Appellee sold its compressor and coupler, parts of the combination to public garages and service stations in the United States, and appellant offered its fitting parts to be used by the said garages in connection with the Butler combination, Appellant duplicated fitting for fitting all of the arbitrary dimensions of the entire line of appellee's fittings.
- 12. The Butler patent does not require the use of spring fingers which can yield a substantial amount.
- 18. Appellant's model of Figure 2 of the Butler patent does not accurately or fairly represent the invention of Butler.
- 14. Claim 2 of the Butler patent describes both a "Lincoln Kleenseal" fitting, appellant's product, and "Alemite Hydraulie" atting, appellee's product.

As conclusions, the court found:

That claim 2 of the patent is valid, defendant contributorily infringed it by sale of "Kleenseal" nipples or fittings, emplified in plaintiff's Exhibits 27a and 2 and that appellee is entitled to an injure and to an accounting.

Appellant challenges the decree on the separate, distinct grounds, stating each as commendable frankness, brevity, and ty:

- (1) Butler's hose coupler can not he validly claimed in combination with a sepatented lubricant receiving nipple or and compressor, particularly where his consequence is not merely to monopolize the secoupler, but to include in the monopoly admittedly old device which is used wit. To support this position appellant reupon Bassick Manufacturing Co. v. R. Hollingshead Co. (Rogers v. Alest Corp.), 298 U.S. 415, 56 S.Ct. 787, 791, L.Ed. 1251.
- (2) The coupler of the Butler pains shown in Figure 2 is not the so-called "lamite Hydraulic" coupler. Supporting apposition, appellant relies upon the factorist brought out by the evidence and the holin Stewart-Warner v. Jiffy Lubricator (C.C.A.) 81 F. (24) 786.
- (3) The Butler multi-jaw chuck to hose coupler is not a patentable impression ment over the multi-type hose coupler of a prior art. As bearing upon this issue, contends that the evidence does not super the findings of validity because the Bush hose coupler as described by Butler both Figure 2 and in his claim never went a commercial use. It likewise argues that tensive use where the trade was so domined by Stewart-Warner is not persuasive validity.

The importance of the suit and the of the Bassick opinion upon the whole of patent law make it impossible for all dispose of the case in an opinion of design and satisfactory brevity.

While going no further than is necessary to defeat the patent in the present can the conclusion from appellant's brief as avoidable, that Bassick Mfg. Co. v. R. Hollingshead, supra, revolutionized the of patents and repudiated the position of patents and repudiated the position of patents and repudiated the position of patents, including many decisions is circuit, long accepted as the law in cases. This revolutionary concept was cepted and amplied by the District Court of

Pennsylvania) in Stewart-Warner v. Universal Co., 15 F.Supp. 410.

The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick Mfg. Co. v. R. M. Hollingshead opinion.

The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling.

The uppermost question in this case is the controlling effect of the Bassick Mfg. Co. v. R. M. Hollingshead opinion, supra. We are not disposed to limit it in order to bring about an avoidance of any new principle it may announce. Nor are we inclined to give it an effect which was not intended, if it does not follow from a fair construction of its language.

The novel proposition which appellant seeks to apply to the present case is to be found in the language on pages 424, 425, of 298 U.S., 56 S.Ct. 787, 791, 80 L.Ed. 1251. There it was said:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and z grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such. No. 1,307,733. Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and smbodled in the combination his improved form of coupler. No. 1,307,734, the patent in suit; claims 1-6, 8, and 10. He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. Claims 14 and 15. The question then is whether, by this

method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts."

The paragraph of the opinion which follows the quotation serves as a modifier of the strict letter of the rule thus announced. There, the court says:

"Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 325, 29 S.Ct. 495, 53 L.Ed. 805, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination."

If the court announced a rule in the Bassick Case as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the validity of patents then Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 29 S.Ct. 495, 53 L.Ed. 805, is overruled. However, instead of stating that the Leeds & Catlin opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

Until and unless there is an express repudiation of the Leeds & Catlin Co. v. Victor Talking Machine Go. Case, we can not accept the Bassick Mfg. Co. v. R. M. Hollingshead opinion as being inconsistent with the views stated in the former opinion. In other words, we must apply to the instant case the rules of law which govern and apply the tests which have long been applied to determine whether the Butler combination is a patentable invention.

[1] In dealing with product patents and their validity it might be observed that the word "combination" is somewhat unfortunate. A combination contemplates a plurality of units, yet patentable invention can only reside in a combination when it (the combination) is considered as a unit. For convenience's sake, courts speak of elements in a combination as units in and of them-

It is only for the sake of convenfence that reference is made to such elements as 1, 2, 8, 4, and 5. Each and every valid claim of a patent covers a unit, although in a combination claim the unit may have five parts or elements. When we so consider a claim it is clear that one unit must differ from another unit if one element, may element three in one combination is different from element three in another combination. To illustrate: If one mixes five different colored paints in stated proportions, he would have a product which might be denominated X. X must be viewed as a unit. If the same individual mixed in the same proportions five different colored paints, four of which were similar to the ones in the first combination but one was different, the final product would not be the same. In testing the validity of any machine or product patent, then, whether it be what is commonly called a combination, or a single, a noncomposite substance, the following propositions may be accepted as sound:

- [2] 1. All the elements may be old but if they have never appeared together in combination and they co-act so as to avoid the charge of aggregation, the unit may constitute a valid claim of a patent.
- [3] 2. Where a combination consists of five elements—1, 2, 3, 4, and 5—and the inventor uses four old elements—1, 2, 3, and 5,—in the same way and for same purpose as in the previous combination, but substitutes a new element 4 for old element 4 of the old combination and obtains desirable results, the new combination may be the subject of a valid claim. It is not anticipated by the previous combination.
- [4] 3. Likewise, one may substitute for element 4 an old and well-known element but which has never been used in combination with elements 1, 2, 3, and 5, and these elements being presented in the new combination for the first time may be the subject of a valid patent.

In stating these propositions, we have used the word "may" for there are other factors to be considered in determining patentability. For instance, the novelty may not be patentable. The advance may represent the skill of the artisan or the mechanic, not the genius of the inventor. Perhaps it would be better to say that the objection that the combination is lacking in novelty is not sound under the conditions enumerated.

- [5] Equally clear is the law which denies to anyone the right to repatent an old combination.
- [6] Accepting the foregoing principles as sound and applying them to the instant case, we have no difficulty in distinguishing any of the prior art. Nor are we troubled by the decision in the Bassick Case. The Butler coupling member and his nipple head are novel. Their structures are clearly distinguishable from the prior art. Whether the other mentioned elements are old is immaterial.
- [7] The only validity questions left relate to combination as distinguished from aggregation and the character of the discovery—whether it marks patentable novelty or mechanical skill. In passing, it might be observed that if a new product is found to be patentably novel, it is immaterial whether said patentable novelty is of the pioneer type or "the mere, improvement type" of invention.

Appellant also relies upon the Bassick Case as authority for its contention that contributory infringement is not disclosed upon a showing that it furnished nipples and grease guns, even though made in such a way as to be used as an element in the Butler combination.

The last paragraph of the Bassick opinion is cited in support of appellant's position. It reads as follows:

"We are of the opinion that the owner of the patents cannot extend the monopoly of its patent for a pin fitting to preclude the use therewith of any grease gun not embodying the improvement in the coupling device evidenced by the patent in suit; and cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting which does not infringe the fitting patent, 1,307,783, with a gun having a coupler such as that claimed in the patent in suit."

We accept, of course, without question this opinion as applied to the facts in the case that was before the Supreme Court.

In the instant case, Butler does not seek to extend the monopoly of a patent for a pin fitting or to preclude the use of a grease gun in any apparatus not embodying the improvement described in the patent.

Two questions are determinative: First, did Butler set forth a valid patentable combination when he wrote his claim No. 2? Second, did the sale of a headed nipple or a

91 F. (94) 797

of being used in connection with the pursus made according to the Butler patnt constitute infringement?

8, 91 Combination or Aggregation. As view claim 2 of the Butler patent, it s combination, not aggregation. It is of the names of the various parts that deraine this question. If there be coaction dements so as to make a single unitary tracture, we have a combination. The niphe head may be a non-composite apparatus. t may be the subject of a valid patent claim. Rewise; it may be part of a combination. 10 In the instant case, it is conceded that he headed nipple was not patented. More, inot patentable. It will be assumed that was old. Nevertheless, if it is an element in otherwise valid combination (due to he novel coupling method), it is a unit of aid combination and a third party supplying t, if other necessary facts are shown, may hereby infringe.

Whether the supplier of headed nipples of other elements of the combination set orth in claim 2 is a contributory infringer tepends first on whether the element supplied is a part of a valid combination (as listinguished from an aggregation), and econd, on whether the producer so contracts it that it can be said that it was mowingly made with the intention that it would be used in connection with the patnied combination.

11) There is an exception to this statement—If an element of a patented commination in the very nature of its use wears ut and a new one is supplied, it may be furnished without the producer's infringing. Herer'v. Duplicator Mfg. Co., 263 U.S. 100, H S.Ct. 31, 68 L.Ed. 189; Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 325, 29 S.Ct. 503, 53 L.Ed. 816. But, where the intent is present, as here, to supply separate units of a patented combination and not as a renewal of a worn out part, catributory infringement is disclosed.

The findings of the District Court on the question respecting the dimensions of appellant's headed nipple clearly show an intention to make parts which could only be used in connection with the patented combination. If, then, the Butler claim No. 2 disclosed a valid combination, infringement shown.

(12) In deating with this subject of contributory infringement, it might be observed that we are dealing with a phase of the general subject of torts. An infringer is a tert feasor. A contributory infringer is one whose action contributes to the infringement.

[18] Because of the statute, the owner of a patent is entitled to exclude others from making, selling, or using the patented product. Violation of any of these rights makes the violator a tort feasor, an infringer. Making, buying or selling a non-patented article is not of itself infringement. It only becomes so when said maker, seller or user does so knowing that the non-patented element is to be used in connection with other elements in a valid combination covered by a valid patent. This is the doctrine of contributory infringement.

In the instant case, the court has made findings, and the facts leave no doubt as to the soundness of such findings, to the effect that the non-patented parts made by appellant were not only intended for use in connection with Butler's patented combination but they could hardly be used otherwise. The size and dimensions of the fittings most conclusively demonstrate this fact.

It might be asserted that appellant did not infringe when it manufactured one element of the product for it could have been sold to one who would use it other than in the Butler patent combination. However, when it appears that such products were made by the appellant and sold to garages and it further appears that the fittings were of such measurement as to preclude their use except on appellee's metented apparatus, contributory infringement both in selling and in using is established.

To establish contributory infringement the following facts must appear; (1) a valid patent; (2) ordinarily in the case of a product patent covering a combination; (3) the alleged infringer must make or supply one or more of the elements of the combination with the knowledge and intention that the same is to be used in the patented combination.

Contributory infringement is the outgrowth or result of the application of the following legal propositions:

- (1) A patentable combination is a unit in the contemplation of the law.
- (2) Some elements of the combination may be old and others new, or all old, or all new.
- (8) One who makes, sells or uses the combination without permission of the patentee is an infringer.

- (4) One may be a contributory infringer although he makes, sells or uses an element that is old and not covered or coverable by a patent.
- uses or sells an unpatented (an old) element, he becomes a contributory infringer only when the element is knowingly made, sold or to be used as a part of a patentable combination without patentee's express or implied consent.
- (6) Implied consent exists when in the ordinary use of the patentable combination one element constantly and frequently wears out and must be replaced. Heyer v. Duplicator Mfg. Co., supra. Whether there is a consent is often a fact issue, but not involved in the instant suit.
- [14] In the last analysis this question of contributory infringement in the instant suit must be determined by the existence or absence of a valid combination wherein one of the essential elements was a product made by appellant. If the elements do not spell a combination, but are merely an aggregation, there is of course no contributory infringement.

For obviously, infringement can exist only when there is a valid patent. No valid patent can cover a group of elements which are correctly termed an aggregation and which do not conform to the correct legal definition of a combination. There is a valid combination only when the element—headed nipple—co-acts with the lubricant compressor and the coupling member. If two of these elements do not co-act and the third element does not likewise co-act with one of the other two members, we do not have a case of valid combination.

Doubt over this issue can only arise when one of the elements may in itself serve a multiple of purposes. It may be used outside the combination of the patent. If so, its use is valid and legitimate. The determining fact issue is the intent and the purpose it serves, and was intended to serve when made or sold. If made, sold or used as an intended element in the combination which is the basis of the patent claim, it is a ease of contributory infringement, otherwise not.

In disposing of the defense of aggregation, we have accepted the rather common meaning of that word and, for the purpose of the argument only, assumed it to be a valid defense in patent cases when established. We have adopted this meaning for

the purpose of the argument only, for wise we would hesitate before accept

In our opinion the defense of agtion is considerably overworked. The "aggregation" is usually preceded having ments which fall far short of inventing used quite loosely to define various tures which fail to embody patentable coveries.

To illustrate, it is used then a mech with a series of independent units perform their functions separately an influenced by the action of any other the being considered. In other cases, it madopted when a mechanism is compount units, but their selection discall for the exercise of the inventive fall such a case, the discovery may applied the selection of the inventive fall such a case, the discovery may applied the selection of the selection of the selection of the selection.

[15] We believe the better view is cept the term "aggregation," if used a as defining a phase of the general "non-invention." When claims are con ed which are composed of a plurality of ments and their individual or colle selection fails to evidence the exercise ventive faculty, it is of course not a pai ble discovery regardless of whether cos of elements is present or absent. Or other hand, an inventive concept may a in the selection of a part or parts of m ous old elements. If the selection is un and a hitherto pressing unsolved proble thereby overcome, it answers the tes the statute.

[16] Invention may be evidenced by modifying coaction of the elements. is, the coaction may furnish the satisfa evidence of the patentability of the diery. It is hardly logical, however, to without it (coaction) there can be no it tion.

It is one who "has invented or discording new and useful art, machine, main ture, or composition of matter, or any or useful improvements thereof, etc.," is, under the statute, entitled to the inventor, and under prescribed circulations is entitled to a patent which protect his invention. The term "aggrition" is not used. It has been adopted by legal profession as descriptive of a macor composition of matter, etc., that short of invention usually because the ments of the composition do not of

orts, too, have recognized it as applicable her the machine or composition of matter a short of invention, because it manifests skill of the mechanic rather than the his of the inventor. This has led to emiss on the term "coaction" of elements him applied to said composition or ma-

then among the group of elements there correlation or co-ordination of elements high mutually contribute to the same result, we may be invention, notwithstanding are many decisions which have arbitrary announced that patentable discovering are not present unless there is coaction felements which results in a new or better reduct.

We are convinced that where there is corelation, cooperation, or co-ordination enling in mutuality of achievement of a comon purpose and contributing to accombination may well be present. Nor is it proper a say that the correlation or cooperation the other elements.

If] In short, in attempting to restrict agregation to its proper field, it might be said that a combination is present if there be correlation or co-ordination of elements which mutually contributes to the accomplishment of some result and there need be no interdependency in the sense of one element being dependent on the others for functioning.

We are inclined to go still further and question the wisdom of necessitating the presence of a coaction of parts to constitute a valid combination. True, absence or presere of coaction may bear upon the characto of the skill required to solve the problem. It is entirely possible to conceive of a case where the selection of the elements which are to act together to produce a desirable or advantageous result, would invoke the elercise of the inventive faculty. While this view may not harmonize with many of the decisions, and it is not applied in the instant cise, it seems to us the more logical one. hr when we attempt to distinguish between liventive faculty and the skill of the meclanic, we must admit that the former often ads expression in the selection of the partrular element and it is the selection of elements that solved the problem, improved the product, or brought about the desired econmies in production costs. Its cooperation th the other elements may be very limited, in fact, limited to mutuality of effect or nctioning to a common purpose.

Patentable Novelty of the Butler Apparatus. Appellant argues as one of its three major grounds for reversal of the decree that the advance or improvement which Butler made over the prior art did not constitute invention, but merely evidenced the skill of a mechanic confronted by an ordinary mechanical problem.

Upon this issue the District Court found squarely against the appellant and in fts opinion pointed to the differences between the prior art structures and the Butler apparatus.

We are not convinced that the discovery belongs to the pioneer class. It was an improvement, but not an outstanding advance. Whether that improvement was such as to justify the issuance of a patent may well be and is seriously debated.

[18] We are not impressed by the evidence of wide and popular acceptance of the patented apparatus which is so controlling in doubtful cases. Wahl Clipper Corp. v. Andis Clipper Co. (C.C.A.) 66 F. (2d) 162.

Appellee occupies such a position in this lubricating field that any lubricating system it might offer to the garages' and automobile manufacturers would result in enormous sales of parts. There is no doubt but that the figures appearing in the court's findings, standing alone, are impressive. A sale of 280,000,000 fitting parts in three years, by any company at any time, is quite startling. They would be more impressive if we knew how many parts were sold under the Zerk patent or under the Gullborg patent, both owned by appellee. The number of automobiles in the United States and the number of parts necessary to supply all of them are both enormous. A company, like the appellee, is apparently able to have its product made part of the standard equipment of most automobile companies, and therefor would naturally sell millions of parts of a lubricating system throughout the entire. United States. It is for this reason that we have not allowed the sale figures to influence our judgment on this issue of validity of the patent.

It is only after observation of the various lubricating systems that we have come to the same conclusion as was reached by the District Court. If the advance which Butler made was merely the solution of a mechanical problem, we are at a loss to understand why that solution was so long delayed. Holding one part of the lubricating system against another while pressure was applied and grease squirted in all directions, or mak-

ing the connection by the pin and slot or bayonet type while crawling under cars and reaching between spokes of a wheel, was so unsatisfactory as compared to the Butler method that the delay in producing this new method of connection is explainable only upon the theory that the problem was beyond the solution of the mechanic skilled in the art.

What was the problem which confronted the maker of lubricating systems? First and foremost was the need of high pressure apparatus. The pressure had increased in the passing years. First 500 to 750 pounds was considered high, then 1500 to 2000 pounds. The Butler system permits of pressure up to 7500 pounds. It is apparent that high pressure was extremely desirable. The difficulty to be overcome in the making of a high pressure system was in the connection between the coupler and the pin head. Butler's solution was most satisfactory because the higher the pressure, the tighter the connection—the better the fitting.

Another problem which confronted the manufacturer was easy connection. Crawling under the car or reaching points rather inaccessible was unsatisfactory.

[19] The trial judge found, and there is testimony to support this position, that in the lubricating field the method adopted had never been used before. It was novel in the lubricating field. It may not have been wholly new in the entire field of mechanics, but it was novel in this particular field. Its conception or its selection, under all the circumstances, we conclude was invention and entitled to the protection of a patent.

Appellant argues, as an additional ground for reversal, that claim 2 of the Butler patent and Fig. 2 of the drawings accompanying the same do not cover its accused nipple. It likewise argues that appellee's "Alemite Hydraulic" coupler is not the coupler of the Butler patent.

The District Court found squarely against appellant on this issue.

The question has been elaborately argued both on the oral argument and in the brief. To reproduce the drawings and set forth the positions of the two sides would almost double the length of this opinion, and we fear we would not add much to the statement of our conclusions respecting these conflicting positions.

The question is not whether Fig. 2 of drawings fully represents the concept of Figures which accompany inventor. patents are often presented merely to date the thought expressed in the speci Their study is decidedly helpfor tions. most cases, but it can hardly be expe that all of the possible variations in a tures will be set forth in specifications drawings. Frequently the improved type described in detail. True, there are stances where specificity is necessary in der to distinguish the invention from prior art. More frequently however, fi the principle of operation which is be illustrated rather than an effort to con the invention to the exact figures shows drawings.

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This seems to have been the thought Judge Lindley when he said:

"The Alemite Hydraulic System (aplee's) comprises the combination of elements of forth in claim 2 of the Butler pates."

There is nothing in the Butler patent which requires the use of spanningers which can yield a substantial amount of the Alemite Hydraulic compatible of the Alemite Hydraulic compatible of the Alemite Hydraulic fitting as well as well as well as the Butler patent described one combination was well as the other."

He further stated:

"The mechanism embodied in the menty which the jaws are compressed about nipple of the Alemite Hydraulic system, identical in its mechanical principles withat disclosed in the Butler patent. It is simple equivalent involving a mere rever of parts. The Alemite Hydraulic system comprises the combination of elements forth in claim 2 of the Butler patent."

[20] Our conclusion is that such deptures from the Butler patent as were main the commercial structures were new theless the equivalent of the Butler chi and they embodied the mechanical princip which were described in the Butler pate. In other words, we agree with the Distriction Court that appellee's Alemite Hydrau system was an embodiment of claim 2 of Butler patent.

The decree is

Affirmed

### FILE COPY

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MAR 7 1938

OHARLES ELMORE CROPLEY

IN THE

### Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

ve.

STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

RESPONDENT'S BRIEF.

LYNN A. WILLIAMS,

Counsel for Respondent.

### ALADOLTED AND AVEROVED BY THE BEVENUE OROTHE-COURT OF APPEAUS IN THE SEVENUE OROTHE-COURT OF APPEAUS TREAS FOLLOWS:

In the right hand margin opposite each of these findings, we have indicated the page of our brief at which the particular finding is discussed. In our brief we have in each instance referred to the evidence upon which the particular finding was based.

	rating and contract the second war, there are	
	The Courts' First Finding of Fact Was That:  'Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder'	16
100 Sept. 100 Sept. 11 11 11 11 11 11 11 11 11 11 11 11 11	The Courts' Second Finding of Fact Was That:  "Defendant Lincoln Engineering Company of  "Old Allinois is the distributor for the Chicago	
a Charles and a second	factory of Inbricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation"	40
	The Courts' Third Finding of Fact Was That:  "The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St. Louis, Missouri, a	16
Section 18	Missouri corporation". The Courts' Fourteenth Finding of Fact Was	16
	"Prior to manufacturing and selling the Alemite Hydraulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent No.	
25.53	1,475,980''	16

"The Lincoln Engineering Company of Missouri initially engaged in the business of insking and selling automobile hibricating compared in 1925, supplying its equipment of falls that exclusively to plaintiff of his trelationship it between the Lincoln Company and the plaintifant tiff continued for several years thereafter, until 1933"

4. 20

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THE TRUE PROPERTY OF THE POST AND ROWING MET MET

The Courts' Fourth Finding of Fact Was That The Butler patent in suit No. 1,593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shouldered and nipple or fitting is provided for attachment in materials bearing of an automobile of other sessionachine to be supplied with lubricant from . man a lubricant compressor or pamp by successively attaching to the mipple; a coupler with which the nipple cooperates to make a Inbricant-tight connection by engagement against the end of the nipple, and which doupler has jaws engageable about the throat of the hippie automatically to grip the nieple when the compressor is operated a such the customary way to deliver intricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the grip between the nipple and

the coupler are increased proportionately with increases in the pressure of the lubricrant being supplied to the bearing.

The Course Fista Finding of Fact Was That:

In practical operation, grease pressures running up to thousands of pounds per square man are frequently required in order to force the grease into the interstices of a bearing.

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이 이렇게 있어요? 이렇게 있는데 이번 이번 사람이 되었다면서 아무리를 받는데 이번 사람들이 되었다. 그렇지 사람들은 사람들이 되었다면서 하는데 그렇게 되었다면 하는데 그렇게 되었다.	
The Courte Sinth Finding of Fact Wes That:  'When the compressor is operated to inject grease under these high pressures, the tendency is to burst the compressor, coupler and the nipple, and to break open the connection between the coupler and the nipple by foreing these parts asunder.'	31
Because of the tremendous pressures which must be developed in a lubricating system it is important in order to prevent leakage of lubricant to secure the maximum tightness of seal and the maximum mechanical grip.  Both the strength of the grip and the tightness of the seal must be proportional to the pressure of the grease to be transmitted. If the seal is not sufficiently tight, the grease will escape—and the requisite pressure cannot be developed. If the grip is not suffi-	
ciently strong, the parts will be forced asunder".  The Courts' Eighth Finding of Fact Was That:  "In the Butler combination the automatic end seal and the automatic grip both become more effective as the Inbricant pressure increases and the need for a more effective	31
The Courts' Ninth Finding of Fact Was That:  "In the Butler patent the end seal member is movable and thus may adjust itself to fittings (nipples) of slightly different dimensions."	31
The Conets' Tenth Finding of Fact Was That: "Any resiliency in part 42; referred to in the Butler patent as constituting spring fingers, serves the purpose of compensating for any slight out-of-roundness of the fitting?"	32

Butler patent here in suit. Claim 2 of the Butler patent here in suit. Claim 2 of the patent want to the disclosure in Fig. 2 of the patent want to the disclosure in Fig. 2 of the patent here in suit. Claim 2 of the patent describes this early sample of the invention.

32

The Courts' Twelfth Finding of Fact Was That:

"Butlar was the first to propose or to devise a
lubricating system in which the scaling of
the joint between the end of the nipple and
and the coupler, and the mechanical grip
between the nipple aml the coupler, were
effected automatically by the pressure of the
lubricant in and by the normal pumping opcration of the compressor".

The Courts' Thirteenth Finding of Fact Was

That:

"Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result"

The Courts Twentisth Finding of Fact Was That:
"The Alemite Hydraulic system comprises
the combination of elements set forth in
claim 2 of the Butler patent."

The Courte Fifteen is Finding of Fact Was That ! Plaintiff commenced selling the Alemite Hydraulic lub meating equipment camplified in Plaintiff's Exhibit 13 to 2J and 22 to 25, inclusive, in April, 1933". The Courts' Sixteenth Finding of Fast Was That: \* Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof".... The Courts' Seventeenth Finding of Fact Was Ze That's "Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April. 1933, to March, 1936, approximately 4,485,-000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the care at the factory 44 The Courts' Eighteenth Finding of Fact Was "The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullberg and sloon, the Zerk lubricating equipment because (a) Under this equipment, it was not military to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting, as was necessary in effecting a connection between a Gullborg coupler and fitting, and

apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lubricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception of the Duesenberg"...

The Courts' Nineteenth Finding of Fact Was

"The mechanism embodied in the means by which the jaws are compressed about the nipple of the Alemite Hydraulic system, is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts"

The Courts' Thirty-first Finding of Fact Was

There is nothing in the Butler patent which requires the use of spring fingers which can yield a substantial amount?

The Courte' Pwenty second Finding of Fact Was

When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile labricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or negales of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fittings?

302

That:

dent and designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraelic system. Although he had known of the compressor and coupler parts at an earlier date, he became familiar with them at least-as early as January, 1935.

The Courts' Twenty-fourth Finding of Fact Was

"The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hydraulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part or the plaintiff's nipple part?"

The Courts' Twenty-fifth Finding of Fact Was

"The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydraulic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of alightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make."

Phe Capital Dugiculary and all Phinting of Fact Was (Defendants sold Lincoln Kleenzan) fittings with the knowledge that they were to be used in combination with the compressor and coupler parts of the Butler combination as sold by the plaintiff for use with plaintiff's Alemite Hydranic coupler equipped grease MINE Alleman exercis our control have corre-The Courts Twenty-eighth Finding of Fact Was That is a second drant spin of them ) out "The Lincoln Engineering Company of Missouri expected that automobiles equipped with the Lincoln sipple part of the combination and sold in the United States, would be lubricated at garages and service stations. The plaintiff had previously sold millions of the compressors and coupler parts of the combination, and had endeavored to supply every public garage and service station in 50 The Courts' Twenty-ninth Finding of Fact Was That: The Lincoln Engineering Company of Missouri in its Kleenseal fittings, duplicated, fitting for fitting, all of the arbitrary dimensions of the entire line of Alemite Hydranlie Cathanar Sport H. Jantia The Courts Thirtieth Finding of Fact Was That; The Lincoln Engineering Company did not sell any of its grease guns or nozzles to automobile manufacturers for tool kit equipment of automobiles sold in the United States, even though the automobiles were quipped with Lincoln Kleenseal fittings".

The Courts' Thirty-third Finding of Fact White

The Alemies Hydraulie esopies will strip and form a scaled connection with a Lincoln Kleenscal fitting as well as with an Alemite Hydraulie fitting and claim 2 of the Butler patent describes one combination as well as the other?

The Courts' Thirty-fourth Finding of Fact Was

Defendants' model of Fig. 2 of the Butler patent does not accurately or fairly represent the invention of Butler'....

The Courts' Thirty-fifth Finding of Fact Was

"Defendants' Exhibit A-61" does not correspond to the alleged drawing thereof, Defendants' Exhibit C-21".

The Courts' Thirty sixth Finding of Fact Was

"Defendants' expert stated that none of the prior art except Winkley Reissne patent No. 14,667 accomplishes the results obtained by the Butler patent".

The Courts' Thirty-seventh Finding of Fact Was

1365

"The Winkley Ressue patent No. 14,667 does not disclose the radially movable locking elements, the piston for compressively sintching by the piston for compressively sintching the lucking elements upon the mapie, as Butter's invention is defined in older 2 of his patent, 'The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in Butler's claim 2"

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PAGE

## INDEX.

# CASES CITED.

PA	GE
Foreword	1
The Petitioner's Statement of the Case Is Quite Mis- representative. It Does Not Once Cite or Refer to	
Any of the Testimony	1 %
Typical of All of Its Pages	2
A Restatement of the Case as Derived from the Record	5.
As Against the Petitioner's Pretended Statement of the Facts, We Wish to Contrast the Real Facts as De- termined by the Lower Courts and as They Appear	-
in the Record	5
Court of Appeals	5
The Three Opinions of the District Court and the	
One Opinion of the Court of Appeals	7
Some of the Facts ac Set Forth in the Opinion of the District Court and as Subsequently Adopted and	
Approved by the Court of Appeals	8
The Invention of the Butler Patent	.8
Generically Old Elements	9 .
Butler Accomplished a New and Unitary Result by the New Relationships and the New Functions of	
All of the Several Parts of the Combination	10
In the Following Statement of the Facts, We Have	
Adopted as Our Captions the Several Findings of Fact as Determined by the District Court and Sub-	
sequently Approved by the Court of Appeals	15
Argument	68

#### L

The Supreme Court Has Not Recently Abolished the	
Age-Old Law of Joint Torts as Applied to the In-	
fringement and Contributory Infringement of Patent	
Rights. There Has Been No Such Revolution in the	
Law of Patents as Is Advocated by Counsel for the	
Petitioner	.68
The Petitioner's Contentions Baise a Question of	
Paramount Importance	68
For the Purposes of our Discussion of This Ques-	
tion of Contributory Infringement, We Shall	
Assume That the District Court and the Court of	
Appeals Were Fully Justified in Their Conclu-	
sions (1) That the Butler Patent in Suit Was	
Not Anticipated by the Prior Art; (2) That It	
Involved the Exercise of Invention; (3) That the	
Lubricating Apparatus Manufactured and Sold	
by the Stewart-Warner Corporation Does Em-	
body the Invention of the Butler Patent; (4)	
That Claim 2 of the Butler Patent Describes a	
Patentable Combination,—Not an Unpatentable	
Aggregation; (5) That There Is No Issue of Alleged Clayton Act Violation; and (6) That	
There Is No Issue of License to the Defendant-	
Petitioner	Mo
	.00
The Petitioner's Theory Would Abolish All of the Law of Joint Liability for the Tort of Patent	
Infringement, and Would Destroy the Practical	
Value of the Vast Majority of Patents	76
In Each of the Following Cases, the Defendant's Sale of an Unpatented Article, With the Knowl-	
edge and Intention That It Be Employed in the	
Construction of a Patented Combination or in	1
the Use of a Patented Process, Was Held to Con-	
stitute a Contributory Infringement	81

the state of the s	
The Four Supreme Court Cases Out of Which the Petitioner Endeavors to Spell a Practical Abolishment of the Law of Joint Torts as Applied to the Tort of Patent Infringement	
The Petitioner's Theory Means Necessarily That Every Infringement Must Be a Complete and Direct Infringement,—That There Can Be No Such Thing as a Contributory Infringement	86
It Is Impossible to Derive the Petitioner's Formula of So-Called Contributory Infringement from Anything and Everything Which the Supreme Court Has Said	95
The Very Decisions of This Court Upon Which the Petitioner Relies, Expressly Recognize That There Still Is Such a Thing as Contributory Patent Infringement	95
The Infringement of a Patent is a Tort; a Contributory Infringer Is a Joint Tort Feasor	97
The Cases of Rogers vs. Alemite and Bassick vs. Hollingshead Turned Upon Questions of Validity and Proof of Direct Infringement, and Did Not, Therefore, Involve the Determination of Any Question of Contributory Infringement	99
In the Hollingshead Case, the Court Found That the Ports Furnished by the Hollingshead Com- pany Did Not Embody the Suction Effect Coupler Claimed in the Gullborg Patent in Suit.	00
In the Rogers Case, Claims 14 and 15 of the Gull- borg Patent Were Held to Be an Attempted Double Patenting of Gullborg's Earlier Patent	99
No. 1,307,733 1	00

,	In the Rogers Case, Claims 1-6 and 8 and 10 of the Gullborg Patent Did Not Involve a True and En-	
	forceable Combination Because "the Construc-	
	tion and Operation" of the Compressor and	
	Suction Effect Coupler Parts Were Unchanged	
	by the Pin Fitting or the Form of Pin Fitting	
	Associated Therewith	
	The Law of Contributory Infringement Is Not	
	Clarified by the Twelve Cases Cited in a Foot-	
	note to the Opinion in Rogers vs. Alemite	106
	A Brief History of the Restrictions and Attempted	
	Monopolies in Well-Known and Staple Articles	
	of Commerce Leading Up to the Decisions in the	
	Carbice Case and in the Barber Asphalt Case	110
	A Classification of the Contributory Infringement	
	Cases and the Assertedly Contributory Infringe-	
	ment Cases Which Preceded the Decision in the	
	Carbice Case	112
	What Were the Grounds of the Decision in the	
	Carbice Case	120
	The Correct Interpretation and Application of the	
	Decision of This Court in the Dry Ice Case as	
	Expressed by Counsel for the Petitioner in	
	Their Brief in the Case of Leitch vs. Barber	134
	The Opinion of the Supreme Court in the Case of	
	Leitch v. Barber, 82 L. Ed. 276, Further Em-	
	phasizes the Broad Equitable Principle Upon	400
	Which the Dry Ice Case Was Decided	139
	In Its Opinion in the Case of Letich vs. Barber the	
	Supreme Court Explained Why the Barber	4
	Company's Attempted Distinctions Were of No	445
0	Legal Significance	
	Judge Wilkerson's Understanding of the Decision	
١	in Leitch vs. Barber as Expressed in His Opinion	
	of February 16, 1938 in the Case of Lecithin vs.	
	Warfield	140

V

Summarizing Then, Relative to the Decisions in the	
Carbice Case and in the Case of Leitch vs.	
Barber: Nothing in These Decisions Can Prop-	
erly Be Interpreted as Granting Immunity to a	
Joint Participant in the Tort of Patent Infringe-	
ment,-Provided, of Course, That the Conduct	
of the Patentee Has Not Been Such as to De-	
prive Him of the Right to Any Relief in a Court	
of Chancery	150
The Facts of the Instant Case Exactly Parallel the	
Facts of Leeds & Catlin v. Victor, 213 U. S. 301	
and 325,-from Which the Supreme Court Dis-	
tinguished the Carbice Case and the Leitch Case	152
In Our Previous Discussion of the Leeds & Catlin	
Case, We Have Asserted the Fact to Be That In	
and Of Itself, the Record Disc Was Not a Novel	1.
Element of the Combination of the Berliner	
Patent in Suit No. 534,543. We Propose Now to	
Show in Some Detail That It Was In and Of It-	
self an Old and Well-Known Element	165
The Real Distinction Between the Leeds & Catlin	
Case on the One Hand and the Carbice and	1
Leitch vs. Barber Cases on the Other Hand,	
Does Not Involve the Distinction Between the	
Sale of a New and Separately Patentable Ele-	
ment in the One Case and the Sale of an Old and	12-1
Separately Unpatentable Element in the Other	
Cases, as Contended by the Petitioner. It De-	1
pends Wholly Upon the Radical Difference Be-	1
tween the Business Methods Which the Victor	
Company Employed in the Use of Its Patent and	
the Business Methods Employed by the Dry Ice	
Company and by the Barber Company in the Use	
그는 항 보다가 있으면 하는데 있으면 없는 것이 없는데 하는데 하는데 하는데 하는데 하는데 하는데 하는데 하는데 하는데 하	180

The Business Methods Employed by the Stewart- Warner Corporation in the Use of Its Patent Are Identical With Those Employed by the	
Victor Company	180
п.	
The Headed Nipple Is a Necessary and Proper Element of the Combination Invented by Mr. Butler.	
When Combined With the Other Elements of Butler's Combination, the Headed Nipple Has New Functions and New Coactions Which No Headed Nipple Ever Had Had Before the Date of Butler's Invention. The Headed Nipple Contributes Its New and Essential Factor of Cooperation Toward the Accomplishment	
of a Wholly New and Unitary and Advantageous	
Result  The Essence of the Distinction Between the True Combination of Butler's Claim 2 in the Instant Suit, and the Unenforceable Aggregations of the Gullborg Patent as Determined in Rogers v.	182
Alemite, 298 U. S. 415	189
Rogers v. Alemite and Bassick v. Hollingshead (298	
U. S. 415, 80 L. Ed. 782)	189
Bassick v. Adams, 39 Fed. (2d) 904	194
The state of the s	

The Lubricating Apparatus Manufactured and Sold by	
the Respondent, Stewart-Warner Corporation, Does	
Embody the Invention of Claim 2 of the Butler Pat-	
ent in Suit. The Combination of the Petitioner's	
Headed Nipple With the Other Parts of the Com-	
bination as Manufactured and Sold by the Stewart-	
Warner Corporation, Embodies the Invention of	
Claim 2 of the Butler Patent in Substantially the	
Same Way. The Lincoln Company's Sale of the	
Headed Nipple Part of the Combination, With the	
Knowledge and Intent That the User Shall Combine	
It With the Other Parts as Furnished by Stewart-	
Warner, Is a Contributory Infringement of the But-	
ler Patent in Suit	
Stewart-Warner v. Jiffy, 81 Fed. (2d) 786	199
The Structure and Function of Butler's Mechanism for Compressively Actuating the Locking Jaws	201
The Function of the Spring Fingers	
The Form and Shape of Butler's Spring Fingers	208
There Is Identity of Function and Result No Mat- ter What May Be the Form and Shape of the Spring Fingers Within the Limitations of Butler's Drawing	220
The Claim in Issue Is Not Directed to a Coupler	
Having Spring Pressed Jaws	221
The Decision of the Eighth Circuit Court of Appeals Does Not Conform to the Holding of the Patent Office, Whereas the Decision of the Seventh Circuit Court of Appeals Is in Agreement	
with the Patent Office	222

Butler Invention Is Not Limited to a Coupler Having Spring Fingers and That the Respondent's Commercial Apparatus Embodies the Invention of the Butler Patent	223
A Brief Summary of the Concurring Evidence of Both Parties to the Effect That the Inconsequen- tial Dictum of the Eighth Circuit Court of Ap- peals Was in Error, and That the Stewart-	
Warner Corporation's Hydraulic Lubricating Apparatus Does Embody the Construction and Operation of the Invention of Claim 2 of the Butler Patent in Suit. All of the Testimony and	
Exhibits of Both Parties to This Suit Reject the Views Entertained by the Eighth Circuit Court of Appeals, and Force the Conclusion That Claim 2 of the Butler Patent in Suit is Embodied	
in Any Combination of the Petitioner's Headed Nipple with the Respondent's Compressor and Coupler	229
IV.	, -
Nothing in the Prior Art Anticipates and Therefore Invalidates the Butler Patent in Suit	232
Butler Was the First to Have Devised a Lubricating System of Any Kind Whatsoever in Which the Two Halves of the Connector Mechanism Were Auto- matically Gripped Together, and in Which the End of the Nipple Half Was Automatically Sealed to the	
Coupler Half of the Connector by the Normal Operation of the Compressor While in the Act of Injecting Grease Into an Associated Bearing, and in Which the Headed Nipple Part Automatically Cocked and Reset	
the Gripping and End Sealing Mechanism of the Coupler Parts for Cooperation With a Second Nipple Upon Disconnecting the Coupler from a First Nipple (and If Need Be Upon Initial Connection With the	14 -
Second Nipple)	232

ability or the Possibility of Such a Lubricating Ap-	
paratus in Any Form Whatsoever	232
<b>V</b> .	
The Best Evidence That the Butler Patent Discloses a Real Invention Over Anything and Everything in the Prior Art, Is the Record of the Defendant's Unsuccessful Effort in Brass and Iron to Incorporate Such Changes and Modifications as Would Reconstruct Newton's Air Brake Hose Testing Device Into the Lubricating Apparatus of the Butler Patent	233
VI.	
The Defendant's Answer Does Not Plead or Raise Any Issue With Respect to the Petitioner's Claims Now	
Made in This Court for the First Time That the	
Plaintiff Has Violated the Clayton Act (a Matter Which Is Not in Any Event a Permissible Defense	
to a Bill for Patent Infringement), or That the De-	
fendant Has Been Licensed by the Conduct of the	1.15
Plaintiff to Manufacture and Sell the Headed Nipple	
and of the Butter Combination	234
In Conclusion	238

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Automotive Parts Co. v. Wisconsin Axle Co., 81 Fed. (2d) 125, 126
Bassick v. Hollingshead, 298 U. S. 415, 425 96
Bliss v. Brooklyn, 3 Fed. Cas. 707 (Federal Case No. 1546)
Carbice Corporation of America v. American Patents Development Corporation and Dry Ice Corporation of America, 283 U. S. 420, 51 Sup. Ct. 49695, 97, 108, 120
Dick Case, 224 U. S. 1, 56 L. Ed. 645, 32 Sup. Ct. Rep. 364
Elishewitz & Sons Co. v. Bronston, 40 F. (2d) 434 (C. C. A. 2—1930)
Ex parte Jones, 343 O. G. 4, 1926 C. D. 100 88
General Electric Co. v. Ohio Brass Co., 277 Fed. 917 107
Heald v. Rice, 104 U. S. 737, 753 107
Harvey Hubbell, Inc. v. General Electric Co., 267 Fed. 564
Harvard Law Review, Volume XXXI, No. 2, for December, 1917
Heyer v. Duplicator Co., 263 U. S. 100, 44 Sup. Ct. 31 (1923)
Henry v. Dick, 224 U. S. 1, 56 L. ed. 645, 32 Sup. Ct. Rep. 364
In re Farrow, 2 O. G. 57, 1872 C. D. 148
Loggie v. Puget Sound, 194 Fed. 158, 164
Langan v. Warren Axe & Tool Co., 184 Fed. 720 107
Leitch v. Barber, 82 L. Ed. 27696, 127, 132, 134
Leeds & Catlin v. Victor, 213 U.S. 301 and 325 152

	Lion Fastener, Inc. v. Hookless Fastener Co., 72 F. (2d) 985 (C. C. A. 3—1934)
	Miller v. Eagle, 151 U. S. 186; 38 L. Ed. 121
	Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 14 S. Ct. 627 (1894)
	Motion-Picture Patents Case, 243 U. S. 502, 61 L. Ed. 871
	Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co., 152 U. S. 425, 431, 432
	New York University Law Quarterly Review (Vol. 11, page 48, September, 1933)
	Nordenfelt v. Maxim-Nordenfelt Guns and Ammunition Co., [1894] A. C. 535
	Professor Cooley, Torts, Vol. I, sec. 75, page 238 (4th Ed.) 98
	Rapp v. Central, 158 Fed. 440, 442 89
	Rogers v. Alemite and Bassick v. Hollingshead, 298 U. S. 415
	Radio Corporation v. Lord, 28 Fed. (2d) 257 108
	Section 4884 of the Revised Statutes, U. S. C. Title 35, Patents, Sec. 40
-	Section 4888 of the Revised Statutes (U. S. C. Title 35,
1	Troy Wagon Works Co. v. Ohio Trailer Co., 274 Fed.
1	Undament - C-1 story close
-	Wall Pump & Compressor Co. v. Gardner Governor
7	Wagner Typewriter Co. v. Webster Co., 144 Fed. 405, 409

And the following cases in which the defendant's sale of an unpatented article, with the knowledge and intention that it be employed in the construction of a patented combination or in the use of a patented process, was held to constitute a contributory infringement.	
Wallace et al. v. Holmes et al., 9 Blatchf., 65; 29 Fed. Cas. No. 17,100. (C. C. D. Conn., Sept. 19, 1871, Woodruff, D J.)	82
Richardson v. Noyes, 20 Fed. Cas., No. 11,792. (C. C. D. Mass., Sept. 1, 1876, Lowell, D. J.)	82
Bowker v. Dows, 3 Fed. Cas., No. 1,734. (C. C. D. Mass., Oct. 9, 1878, Lowell, D. J.)	82
Holly v. Vergennes Machine Co., 4 Fed. 74, 77, 82. (C. C. D. Vet., Oct. 5, 1880, Wheeler, D. J.)	82
American Cotton Tie Co. v. Simmons, 106 U. S. 89, 93-95; 27 L. Ed. 79, 80, 81. (Appeal from C. C. D. R. I. reversing 1 Fed. Cas. No. 293—Nov. 6, 1882, Blatch-	
ford, Justice)	82
Schneider v. Pountney, 21 Fed. 399, 402, 403. (C. C. D. N. J., Aug. 30, 1884, Nixon, D. J.)	82
Travers v. Beyer, et al., 26 Fed. 450. (C. C. N. D. N. Y., Jan. 28, 1886, Wallace, D. J.)	82
Schneider v. Missouri Glass Co., 36 Fed. 582, 583, 584. (C. C. E. D. Mo., Oct. 31, 1888, Thayer, D. J.)	82
Stearns et al. v. Phillips et al., 43 Fed. 792, 795. (C. C. E. D. Mich., July 7, 1890, Brown, D. J.)	82
Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co., 75 Fed. 1005, 1007, 1008, 1010.	)
(C. G-A. 2, July 29, 1896, Shipman, C. J.)	82
Thomson-Houston Electric Co. v. Ohio Brass Co., et al., 80 Fed. 712, 713, 720-722, 730. (C. C. A. 6—May 17,	
1897—Taft, C. J.)	.82

New York Filter Mfg. Co. v. Jackson, 91 Fed. 422, 425, 426. (C. C. E. D. Mo., E. D., Dec. 27, 1898, Adams, D. J.)	82
German-American Filter Co. of New York v. Loew Filter Co., et al., 103 Fed. 303. (C. C. N. D. Ohio, E. D., June 30, 1900, Day, C. J.)	82
John R. Williams Co. v. Miller, DuBrul & Peters Co., 107 Fed. 290, 293. (C. C. S. D. N. Y., Feb. 4, 1901, Wheeler, D. J.)	83
Rumford Chemical Works v. New York Baking Powder Co. et al., 136 Fed. 873. (C. C. S. D. N. Y., Jan. 3, 1905, Lacombe, C. J.)	83
Johnson, et al. v. Foos Mfg. Co., 141 Fed. 73-75, 85,	
87, 88. (C. C. A. 6, Nov. 29, 1905, Lurton, C. J.) Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 Fed. 266, 274-275. (C. C. E. D. Wis., June 2, 1906, Quarles, D. J.)	83
Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 325, 332, 333, 337; 53 L. Ed. 816, 819, 820, April 19, 1909, McKenna, Justice. (On cetriorari to C. C. A. 2, affirming 154 Fed. 58.)	83
Victor Talking Mach. Co. v. Duplex Phonograph Co., 177 Fed. 248. (C. C. W. D. Mich., S. D., May 27, 1909, Knappen, D. J.)	
Parsons Non-Skid Co. v. Seneca Chain Co., 192 Fed. 46. (C. C. S. D. N. Y., Nov. 18, 1911, Lacombe, C. J.)	
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1915, L. Hand, D. J.) Affirmed, 232 Fed. 475	83

Solva Waterproof Glue Co. et al. v. Perkins Glue Co. 251 Fed. 64, 73. (C. C. A. 7, Jan. 2, 1918, Kohlsas	
C. J.)	
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C. J.) Affirming 263 Fed. 719	
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C. J.)	84
Trico Products Corporation v. Apco-Mossberg Coporation, 45 Fed. (2d) 594, 599. (C. C. A. 1, Nov. 2	26,
1930, Wilson, C. J.)	
Graham Paper Co. v. International Paper Co., 46 Fe (2d) 881, 882, 885, 886, 887. (C. C. A. 8, Feb. 17, 193	31,
Kenyon, C. J.)	
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Bundy Incubator Co. v. George Cugley, et al., 30 U. S.	84
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IN THE

## Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

vs.

STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

RESPONDENT'S BRIEF.

#### FOREWORD.

THE PETITIONER'S STATEMENT OF THE CASE IS QUITE MISREPRESENTATIVE. IT DOES NOT ONCE CITE OR REFER TO ANY OF THE TESTIMONY.

Paragraph 2 (d) of Rule 27 requires that the petitioner's brief shall contain "a concise statement of the case, containing all that is material to the consideration of the

questions presented, with appropriate page references to the printed record, e. g. (R. p. 12)."

The first half of petitioner's 90-page brief is devoted to a purported statement of the case. The printed record comprises more than 700 pages, of which some 275 pages comprise the narrated testimony of the witnesses upon the trial.

Except for the identification of various documents and papers, such, for example, as the opinion of the Court of Appeals, and copies of certain patents, the petitioner's brief does not, throughout the whole of its 90 pages, make one single reference to or citation of the record. Not one word of the testimony contained in it is cited or referred to.

## The First Page of the Petitioner's Brief Is Typical of All of Its Pages.

The petitioner's purported statement of the case is an ingeniously contrived misrepresentation of the facts. Petitioner's brief starts off on the first page with the statement that

"The Circuit Court of Appeals held that the sale by the petitioner of an old grease-cup, constituted 'contributory' infringement of the patent in suit, even though the patent in suit is based upon an alleged improvement in an entirely different device, towit, an alleged improvement in a coupler. The patent in suit, while based upon an alleged improvement in the internal construction or mechanism of a coupler, claims the allegedly improved coupler in so-called 'combination' with the old grease-cup and the old pump with which the allegedly improved coupler is intended to be used." (The emphasis is that of counsel for the petitioner.)

The Butler patent in suit neither describes nor claims nor alludes to anything which is called a "grease-cup."

Neither the patent in suit nor the respondent nor anyone

else has ever alleged or contended that the patent in suit describes or claims an "improved coupler" or an "improvement in a coupler" or "an improvement in the internal construction or mechanism of a coupler." One of the elements of the combination claimed in the patent in suit is a "lubricant compressor" (see claims 1 and 2, R. p. 470). Counsel for petitioner choose to re-name this element as a "pump." No lubricant compressor prior to the advent of Butler's invention ever performed the functions of Butler's compressor. Yet counsel for the petitioner choose in the opening paragraph of their brief to refer to this lubricant compressor as "the old pump."

Butler describes and refers to one part of his unitary lubricating mechanism as a "headed nipple." In their very first breath, counsel for the petitioner apply a new name to this part; they call it a "grease cup." Although no nipple which existed prior to the advent of the Butler invention,—although no "grease cup" which existed prior to the advent, of the Butler invention had either the mode of operation or the functions of the "headed nipple" part of the Butler combination,—counsel for the petitioner immediately dub this re-named part with the appellation "old."

The plaintiff, Stewart-Warner Corporation, purchased the Butler patent from the Cincinnati Ball Crank Company (R. p. 36), and in April, 1933, began for the first time to manufacture and sell the lubricating device described and claimed in this Butler patent. It was not until a year and a half later,—in October, 1934, that the defendant, Lincoln Engineering Company, devised and began to sell the headed nipple part of the Butler invention. (R. p. 124) The Lincoln Company's headed nipple was newly and specially contrived for the sole purpose of enabling it to be incorporated as a part of the lubricating mechanism

of the Butler patent in suit, as manufactured and sold by Stewart-Warner. No such "headed nipple" had ever existed until more than a year after the Stewart-Warner Corporation began to market the Butler invention in April, 1933.

Nevertheless, counsel for the petitioner, on the first page of their brief, refer to this new and specially contrived nipple as an "old grease cup."

The petitioner's misrepresentations as to what is alleged by the respondent to constitute the real invention of the Butler patent, the misnomers, and the nonapplicable adjectives with which counsel for the petitioner begin their brief, are reiterated and repeated throughout some 90 pages. Every succeeding page contains similar misrepresentations of the facts. We could devote the whole of a long brief to a criticism and correction of the factual background upon which petitioner's counsel attempt to carry their argument.

Any such word-by-word criticism and correction of the factual assumptions of the petitioner's brief would be wearisome to us and wearisome to the Court. Let us turn rather to the record itself.

# A RESTATEMENT OF THE CASE AS DERIVED FROM THE RECORD.

AS AGAINST THE PETITIONER'S PRETENDED STATEMENT OF THE FACTS, WE WISH TO CONTRAST THE REAL FACTS AS DETERMINED BY THE LOWER COURTS AND AS THEY APPEAR IN THE RECORD.

Counsel for the petitioner have pretended to state the facts in their own language. Let us state the facts in the language employed in the decisions of the Courts. It will promptly become apparent that the facts as determined by the courts are radically at variance with the facts as presented to your Honors by counsel for the petitioner.

The Facts As Determined by the Seventh Circuit Court of Appeals.

In its opinion, the Seventh Circuit Court of Appeals pointed out that

"the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the defenses, the state of the art, as well as other material issues." (91 Fed. (2d) 757, 758.)

At page 759 of its opinion, the Court of Appeals adopted Judge Lindley's characterization of the Butler invention, saying:

"Judge Lindley, describing the patent, said:
"" Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler and the mechanical grip between the nipple and the coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping opera-

the advantage of this tion of the compressor. combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the eoupler to the nipple and the application of the pressure."

A little later in the opinion of the Seventh Circuit Court of Appeals, his Honor Judge Evans quoted in extenso what he called "the substance of the more important findings of the trial court."

The Court of Appeals approved and adopted Judge Lindley's factual determinations. The Judges of the Court of Appeals pointed out, however, that they had not done so either blindly or carelessly. They said expressly,

"It is only after observation of the various lubricating systems that we have come to the same conclusion as was reached by the District Court." (91 Fed. (2d) 757, 765.)

Before quoting further from the opinion of the Court of Appeals relative to the facts which distinguish the instant suit, let us turn first to the factual situation as found by the District Court and subsequently approved and adopted by the Court of Appeals. The defendant's various petitions subsequent to the filing of an original opinion by the District Court, led Judge Lindley to supplement his original opinion with two further opinions.

The Three Opinions of the District Court and the One Opinion of the Court of Appeals.

Judge Lindley's first opinion is reported at 15 Fed. Supp. 571. His second opinion is reported at 16 Fed. Supp. 778. His third opinion is reported at 31 U. S. P. Q. 195. All of these opinions, as also the opinion of the Court of Appeals, are reprinted in a pamphlet which accompanied the respondent's brief in opposition to the petition for writ of certiorari.

SOME OF THE FACTS AS SET FORTH IN THE OPINION OF THE DISTRICT COURT AND AS SUBSEQUENTLY ADOPTED AND APPROVED BY THE COURT OF APPEALS.

Here, then, are the facts as determined by the District Court and as subsequently adopted and approved by the Court of Appeals.

### The Invention of the Butler Patent.

In his first opinion, Judge Lindley said:

"Claim 2 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nip-The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such manner as to cause the locking or gripping jaws to clutch or grab about or upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat, carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing or clutching of the nipple is effected automatically, and engagement of the seal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the coupler and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for performing them. Yet each of the two functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable

variation in the precise dimensions in the forms and

parts involved.

"Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, on opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws." (15 Fed. Supp. 571, 572.)

# The Butler Invention Is a New Combination of Generically Old Elements.

Regarded generically, each of these seven elements is just as old as counsel for petitioner assert the nipple be. On the other hand, the precise conformation of the nipple whereby it is enabled to knit itself into the cooperative unit involving all of the seven elements, is just as new as each and every other element of this combination. Judge Lindley himself adverted to these facts. He said in this connection:

"Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to

accomplish a new result.

"The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with grease and then to be coupled in succession to each of the nipples in order to inject grease into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car." (15 Fed. Supp. 571, 572.)

Butler Accomplished a New and Unitary Result by the New Relationships and the New Functions of All of the Several Parts of the Combination.

Then, after thus setting forth that the Butler invention was an entirely new structure, different in construction and operation from the prior art, the District Court went on to say:

"Here the question is whether Butler produced a combination which achieved a new and unitary result by the cooperation of all the elements, whether all the elements have new or modified functions as a result of changes or substitutions, or whether the old elements have only the old functions operating and cooperating in the old way to produce only an old result. We have seen that the combination consists of seven elements, all of which are old; that invention arises not from any one element, but from the new unitary result. Defendant insists that the essence of the combination is the coupler, but we have seen this is a fallacious theory, for if it were correct and available to excuse the use of the nipple to cooperate in the combination, one person might make the nipple, another, the cylinder; another a group of jaws, another the sealing seat; another the piston. Each of these are old; each of them sell separately. The purchaser could quickly assemble them and then claim that each part had an independent status apart from that in the Butler combination. There could then be no infringement.

"The headed nipple, which cooperates with the sealing seat and jaws of the coupler and thus with the piston and cylinder, is just as essential a part of the Butler invention as any of the several elements of the coupler. There is cooperation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the gripping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of the direct cooperation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In de-

taching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

"Butler was the first to utilize a headed nipple and a compressor as cooperating elements of a combination whereby a grease-tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping

operation of the compressor alone.

"The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new, useful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and cooperated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg case (56 S. Ct. 787, 791, 80 L. Ed., 1251) is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. Just as the Supreme Court said of the Berliner patent, each element was necessary to the operation of the other.'" (15 F. Supp. 571, 578, 578-579.)

Upon petition for rehearing, the District Court delivered a second opinion in which Judge Lindley said:

"We may well again refer to the character of the

Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip between the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Former devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of these, some leakage occurred, and physical manipulation entailing some labor was necessary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable pressure, and with the saving of labor resulting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure. This, I have said, was a step forward in the greasing of automobiles. No one had ever taken it, though the art is full of grease guns and nipples. It remained for Butler to devise an easy operable combination in which the nipple and the coupler automatically cooperate, each contributing its part to the one result of high pressure grease delivery through a sealed connection, effected automatically and

increasing in efficiency with the increase of the pressure. This, I said, was invention and the combination, I held, became, therefore, a pioneer invention in the sense that the Supreme Court used that word in the Leeds & Catlin case." (16 F. Supp. 778, 781.)

"So, here, Butler introduced into the art the idea of an automatic sealing connection achieved by the size and character of elements, which, in themselves, But he employed a different mode of operation. He achieved his object by means of a different force and according to a different and new conception. His invention then was not an improvement but a new and separate invention and, within the reasoning of the Supreme Court in the Leeds & Catlin and the Hollingshead and Rogers cases, a pioneer. In the latter two cases the court was not dealing with a combination patent wherein, by the use of a nipple of a certain particular form and shape and dimensions cooperating with the gripping jaws of a coupler of special form and shape, an automatic unbreakable connection was achieved, making possible that highly desirable thing in automobile greasing, unlimited pressure. did not combine a certain coupler with any nipple. He did not combine a certain nipple with any coupler. He was not, as the Supreme Court believed Gullborg had done, trying to extend his patent to a combination of a certain nipple with any kind of grease gun. Quite to the contrary, he demonstrated conception of a new creative thought, the achievement of a new valid combination in which not only the coupler was essential, but in which also the nipple of peculiar shape and dimension was essential. He produced a new combination, a new arrangement of known elements, by virtue of which he produced an entirely new and beneficial result. He developed new functions and new properties and achieved novelty, resulting in great commercial success.

"In this situation, defendant entered the field and developed its nipple of equivalent form, shape, and dimensions, which it sold, obviously, for use with Alemite guns, supplanting in the combination of Butler the nipple essential to his success. It is a striking fact that a nipple of this shape and dimension was not necessary

to the operation of defendant's grease gun or of any guns other than those of plaintiff or of infringers or licensees of plaintiff—a fact of tremendous significance in determining the purposes and intent of defendant. It sold grease guns which operated with straightheaded nipples as well as with nipples with head and shoulders. It first made straightheaded nipples and exhibited them to General Motors Corporation, but it sold to that company only nipples of infringing character, a character not essential to any combination other than plaintiff's." (16 F. Supp. 778, 782.)

In his third opinion in this same suit, his Honor Judge Lindley said in part:

"I have the conviction that this patent is valid. I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a continuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary—the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that tort in the protection of the defendant's interests, I am not disposed at this time, in view of the time that has elapsed since the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals."

IN THE FOLLOWING STATEMENT OF THE FACTS, WE HAVE ADOPTED AS OUR CAPTIONS THE SEVERAL FINDINGS OF FACT AS DETERMINED BY THE DISTRICT COURT AND SUBSEQUENTLY APPROVED BY THE COURT OF APPEALS.

We have, in the foregoing quotations, stated certain of the facts said by the Court of Appeals to have been independently determined by it and in part as determined by the District Court and expressly adopted by the Court of Appeals.

In his third opinion in this case (31 U. S. P. Q. 195), his Honor Judge Lindley said:

"This case has been before the Court for some time and a rather extensive record was made up on the trial of the case. The Court expended a great deal of time, care, and study in the preparation of its memoranda, its findings of fact, and conclusions of law, and a decree was entered."

At the outset of its opinion, the Seventh Circuit Court of Appeals said:

"The trial was a long one, and the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the defenses, the state of the art, as well as other material

issues. These findings favored the appellee.

"Accompanying the findings was an opinion which set forth the reasons for the conclusions which the court reached. About three months later, upon a petition for rehearing filed by appellant, the court filed a second opinion, which may be found in Stewart-Warner Co. v. Levally (D. C.) 16 F. Supp. 778. Three weeks later the court filed a third opinion which dealt with questions raised by appellant. The third opinion appears in 31 U. S. P. Q. 195. Reference is made to the places where these opinions appear because it will, we think, justify a more abbreviated statement of the facts."

Each of the following subcaptions quotes one of the findings of fact by the District Court and as approved by the Circuit Court of Appeals. All of these findings of fact are incorporated at pages 431 to 437 of the record. We have supplemented each of the Court's findings of fact with references to the parts and pages of the record showing the evidence upon which each particular finding was based.

# The Courts' First Finding of Fact Was That:

"Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder." (R. pp. 35-36.)

# The Courts' Second Finding of Fact Was That:

"Defendant Lincoln Engineering Company of Illinois is the distributor for the Chicago territory of lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation." (R. p. 35.)

# The Courts' Third Finding of Fact Was That:

"The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St. Louis, Missouri, a Missouri Corporation." (R. p. 35.)

The lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis and sold by the defendant herein is marketed under the trade name Lincoln (R. pp. 141, 391-401).

Its infringing nipples are sold under the trade name Lincoln "Kleenseal" (R. pp. 87, 141, 397-399).

#### The Courts' Fourteenth Finding of Fact Was That:

"Prior to manufacturing and selling the Alemite Hydraulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent No. 1,475,980."

The respondent, Stewart-Warner Corporation, through its subsidiaries and predecessors, Alemite Corporation and Bassick Manufacturing Company, has been engaged since 1918 in the manufacture and sale of lubricating apparatus, first under Gullborg patent 1,307,734, and later under Zerk patent 1,475,980 and under many other patents. This lubricating apparatus of various kinds has always been sold under the trade name and mark "Alemite" (R. p. 38 and pp. 341-369).

# The Courts' Twenty-first Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri initially engaged in the business of making and selling automobile lubricating equipment in 1925, supplying its equipment exclusively to plaintiff. This relationship between the Lincoln Company and the plaintiff continued for several years thereafter, until 1933."

Relative to the same matter Judge Lindley said in his opinion of July 15, 1936:

"For seven years prior to January 1933, the Lincoln Engineering Company of St. Louis, Missouri, who is defending this suit, and who is treated herein as the real defendant, had manufactured grease guns for plaintiff. The latter took all of its product. Stewart-Warner had furnished couplers and nozzles to Lincoln, and the latter had incorporated them in compressors, which it in turn sold to Stewart-Warner. These compressors and nozzles were used in combination with hundreds of millions of Gullborg pin fittings and Zerk push type fittings manufactured and sold by plaintiff." (R. p. 605 and R. pp. 39, 79-80, 115-120.)

# The Courts' Fourth Finding of Fact Was That:

"The Butler patent in suit No. 1,593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shouldered nipple or fitting is provided for attachment to each bearing of an automobile or other machine to be supplied with lubricant from a lubricant compressor or pump by

successively attaching to the nipple, a coupled with which the nipple cooperates to make a lubricant-tight connection by engagement against the end of the nipple, and which coupler has jaws engageable about the throat of the nipple automatically to grip the nipple when the compressor is operated in the customary way to deliver lubricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the grip between the nipple and the coupler, are increased proportionately with increases in the pressure of the lubricant being supplied to the bearing."

In his opinion of July 15, 1936, Judge Lindley supplemented his above-quoted finding of fact in description of the Butler invention. (R. p. 616.)

The Butler patent in suit appears at R. p. 464. The drawings contain several figures, but Figures 1 and 2 alone illustrate the subject-matter of claim 2, which alone is involved in this suit. We have reproduced these Figures 1 and 2 of the Butler patent on a colored chart attached to the back cover of this brief. We shall describe the construction and mode of operation of the Butler invention by reference to this colored chart, on which we have applied the same reference characters as those of the patent drawing.

In this colored reproduction of the Butler drawings, there is shown a lubricant compressor 9 which, together with its flexible discharge conduit, is colored yellow. This flexible discharge conduit terminates in a coupler represented generally by C and shown on an enlarged scale relative to that of the compressor and conduit 9. The coupler is shown in engagement with the blue nipple 35, which is threaded at the right end for attachment to the bearing of an automobile. There is an inwardly opening check-valve at the inlet end of the nipple, with a spring holding it to its seat. The coupling C comprises a green

shell providing a cylinder 50, in which there is a reciprocatingly mounted purple piston composed of a cup leather 45 and a metal backing part 43. The cup leather 45 makes a grease-tight seal against the inner wall of the cylinder 50 so as to prevent the leakage of grease around the piston. (R. pp. 51-54, 467-470.)

The right-hand end of the piston member 43, 45 comprises also a tubular or cylindrical extension which terminates at its right-hand end in an inclined female conical surface which engages the conical male surface or surfaces of the three red segmental jaws 40 (R. pp. 51-54, 467-470).

When a bearing is to be lubricated, the two halves of the interconnecting mechanism are brought together by the operator. The right-hand end of the coupler is pushed over the head of the nipple, thereby causing the head of the nipple to wedge its way into the space between the jaws. In so doing, the head of the nipple 35 spreads the jaws 40 of the coupler. These jaws cannot, however, be pushed radially outward without engaging the conically tapered cam surface at the forward end of the piston member. The result of the outwardly wedging action of the head of the nipple upon the jaws of the coupler is therefore to push the purple piston mechanism 46, 43, 42 to the left. It is necessary that the purple piston mechanism be pushed to its left-hand position in order that it may subsequently be pushed to the right by the pressure of the grease in order to effect the compression of the jaws of the coupler around the throat of the nipple. It is therefore the wedging action of the head of the nipple between and upon the jaws of the coupler which "cock" the coupler mechanism, thereby putting it in condition to respond subsequently to the pressure of the grease to effect the automatic gripping of the headed nipple to the coupler mechanism. It requires only a very small force on the part of the operator to slip the end of the coupler half of the

connector over the nipple half of the connector, in order to cause the head of the nipple to push and wedge its way into the space between the jaws. Only a small force is required because the piston 43, 45 is mounted to reciprocate freely and easily in the well-greased bore of the coupler shell 50.

The gripping mechanism of the coupler having thus been cocked by the headed nipple as it enters the space between the jaws of the coupler, the result is that when the compressor 9 is actuated to force grease into the space 50 behind the piston 43, 45, this piston will tend to move forwardly, i. e., toward the right. The inclined female surfaces at the right-hand end of the purple piston engage the outer conical surface of the three red jaws 40, thereby compressing or forcing these jaws inwardly against the throat of the blue nipple 35. When the piston 43, 45, 42 is pushed toward the right by the force of the grease pressure, the three red jaws 40 are prevented from moving toward the right with the piston itself by the perpendicular end wall of the cylinder as formed by the inturned flange of the green coupler shell.

As soon as the inner surfaces of the jaws engage about the throat of the nipple the nipple itself exerts its reaction in such a way as to prevent the further forward movement of the piston 45, 43, 42. The result is that the red jaws 40 are compressed between the inclined or tapered surface at the right-hand end 42 of the purple piston and the perpendicular surface of the adjacent end wall of the green coupling shell and the throat of the blue nipple 35. (R. pp. 51-54, 467-470).

The force which the inclined surfaces at the right-hand end of the piston exert on the three jaws, and consequently the force with which the three jaws grip the throat of the nipple just beneath its head is determined by the resistance which the bearing offers to the ingress of grease through the bore of the nipple 35,—because the pressure of the lubricant, acting at the rear 50 of the piston 45 is dependent upon and limited to the amount of such resistance. The action of the nipple, limiting, as it does, the forward movement of the piston 42, 43, 45, and transmitting, as it does, the resistance of the bearing to the interior of the coupler, sets the stage for the operation of the automatic end sealing device. (B. pp. 51-54, 467-470.)

This automatic end sealing device comprises an orange colored sealing disc or washer 51. As soon as the reaction of the nipple has stopped the further forward movement of the piston 42, 43, 45, and thus brought about the development of an increased grease pressure in the compressor and conduit 9, the grease begins to force its way through the small aperture 48 in the piston, and thus into the space behind or at the left side of the sealing disc 51. (R. pp. 51-54, 467-470.)

The tubular extension 42 of the purple piston constitutes a small cylinder in which this orange colored sealing disc 51 can slide in an axial direction toward the end of the nipple under the influence of the lubricant pressure behind it. The result is that the sealing disc 51 is pushed forward into engagement with the end of the nipple to seal the joint between the grease filled passages of the coupler and the generally tubular wall of the nipple. It will be seen that the construction and operation are such that the sealing disc 51 will be caused to slide forwardly a greater or less distance until it engages the end of the nipple, no matter what the length or the position of the end of the nipple may be (within reasonable limits) as determined by such slightly different lengths of the nipples as will result from wear or from the cheap and slightly inaccurate methods of quantity production which may advantageously be employed

# The Courts' Ninth Finding of Fact Was That:

"In the Butler patent the end seal member is movable and thus may adjust itself to fittings (nipples) of slightly different dimensions." Butler patent, page 2, line 126 (R. p. 468), and R. p. 53.

### The Courts' Tenth Finding of Fact Was That:

"Any resiliency in part 42, referred to in the Butler patent as constituting spring fingers, serves the purpose of compensating for any slight out-of-roundness of the fitting."

# The Courts' Eleventh Finding of Fact Was That:

"Butler, applicant for the patent in suit, presented to his solicitors for the purpose of preparing the application for the patent in suit, a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow cylindrical part, corresponding exactly to the disclosure in Fig. 2 of the Butler patent here in suit. Claim 2 of the patent describes this early sample of the invention."

R. pp. 36, 37, 54-56, 245-257, Plaintiff's Exhibits 8, 62, 63, Defendant's Exhibit A-61.

See in this connection, Judge Lindley's Finding of Fact No. 31 (R. p. 435).

And see our argumentative discussion of the proposition that the Stewart-Warner Company's lubricating apparatus does embody to the invention of its own Butler patent. This cylindrical extension was, in the defendant's sample, slitted in several places at its forward end so as to provide such resiliency as would admit of the appellation "spring fingers" (Defendant's Exhibit A-61, Fox testimony, R. pp. 101-103).

In essence this slifting of the cylinder 42 conforms exactly with the plaintiff's views as to the disclosure of the Butler patent. It was, however, directly in conflict with the views

# The Courts' Twelfth Finding of Fact Was That:

"Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler, and the mechanical grip between the nipple and the coupler, were effected automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor."

The plaintiff's expert testified very cogently relative to the great advantages which Butler's invention had over the Gullborg and Zerk systems, which had previously filled the market, but which were completely displaced upon the commercial advent of the Butler system. See particularly R. pp. 45-8 and 50-1.

This testimony points out that in the operation of the lubricating equipment of the Gullborg patent, it was necessary for the mechanic to hold the grease gun in say the left hand and to hold the coupler in the right hand. The mechanic reached in with his right hand until he could push the coupler over the pin fitting. He then rotated the coupler with his right hand in order to effect the necessary bayonet lock between coupler and fitting. He then removed his right hand and used it, together with his left hand, in actuating the grease gun. In order to remove the coupler from the pin fitting, it was necessary for the mechanic to reach in again until he could get hold of the coupler, and then to rotate the coupler to disengage the bayonet locking mechanism.

Mr. Williams testified that most of the bearings of an automobile are necessarily located in positions which are difficult of access:

"If you have ever greased a car you know many of the fittings are located in very inaccessible positions, and that becomes more and more pronounced as they streamline them and put all sorts of shields and hoods underneath and on the sides, making it more and more difficult to get at the fittings, so that it is more and more difficult to get your hand in there to make that connection." (R. pp. 50-51.)

The lubricating equipment of the Zerk patent was intended to overcome the difficulties involved in attaching the coupler of the Gullborg patent to and detaching it from the pin fittings associated with the bearings. The Zerk equipment comprised "push type" fittings. A nozzle was rigidly attached to the end of the grease gun. The arrangement was such that if the nozzle were pushed and held against the fitting with sufficient force, then grease could be delivered from the grease gun through the fitting and into the associated bearing.

This Zerk equipment had the advantage that the mechanic could hold the grease gun in one hand and then poke the nozzle in, through and around intervening obstacles and up against the end of the push type fitting,—all without the necessity of getting his hand into the inaccessible position in which the fitting might be located. It was this Zerk system to which his Honor Judge Evans referred when he spoke of "holding one part of the lubricating system against another while pressure was applied and grease squirted in all directions." It was the Gullborg system to which he referred when he spoke of "making the connection by the pin and slot or bayonet type while crawling under cars and reaching between spokes of a wheel."

The plaintiff's expert explained the reason for Judge Evans' subsequent reference to the squirting of grease in all directions in connection with the use of the Zerk equipment. The reason was that a man was not strong enough to hold the nozzle against the end of the fitting when any considerable grease pressures were required. Mr. Williams explained the tendency of the grease to burst the parts as

under (R. p. 47). Comparing the Zerk system with that of the Gullborg patent, Mr. Williams said:

"As contrasted with that (the Gullborg system) which is a two-hand operation which calls for the placing of the hand right on the fitting in an inaccessible, dirty, cramped place, we have the Zerk system which does not have any interlocking connections between the coupler parts and the fitting parts. That connection is made simply by manual pressure or holding the two parts together. That means that you can go in from some distance, get on to the fitting, make the contact, and by manual pressure make the seal, and then pump the grease and the grease can go in.

"That was an advantage over the Gullborg system, but it had a disadvantage which was quite serious, or became quite serious, and that was this, that there is always a tendency of the greasing pressure to disrupt the two parts that are making the sealed connection.

As a practical matter, with the Zerk system one can obtain pressures of, oh, perhaps 1500 to 2500 pounds. It depends upon how strong a man is, how strongly he can hold against that disrupting tendency and, of course, what he could hold for one instant he couldn't do all day, if he were in a greasing station.

"Now if I operate this Zerk gun against a Zerk fitting which is placed in this gauge block, you will see that if I operate it as hard as I can, I am getting about 3,000 pounds, and to do that I exerted all my effort. A stronger person could probably get a little more, but he couldn't do it all day." (R. pp. 46-47.)

Mr. Williams pointed out the great advantage in being able to develop pressures running up to five tons or 10,000 pounds per square inch. He demonstrated the ability of the Butler apparatus to inject grease into the interstices of a bearing at pressures of "some 7,500 to 8,000 pounds." (R. p. 50.) He demonstrated the "one hand" application of the coupler part of the connector to the nipple part of the connector in locations so cramped and inaccessible as to be almost beyond the reach of the operator of the Gullborg equipment, and he demonstrated the ease with which

the automatic gripping and the automatic end sealing of the Butler equipment made it possible to reach and grease all of the bearings of an automobile, no matter how difficult of access they would have been to the operator of the Gullborg equipment. (R. p. 50.)

# The Courts' Thirteenth Finding of Fact Was That:

"Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result."

Claim 2 of the Butler patent appears at R. p. 470. Judge Lindley quotes this claim in the margin of his opinion, and then discusses it very fully in his first opinion of July 15, 1936, beginning at R. pp. 603-605.

### The Courts' Twentieth Finding of Fact Was That:

"The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent."

A detailed application of claim 2 of the Butler patent to the plaintiff's Alemite Hydraulic system is to be found in the testimony of Lynn Williams, Jr., at R. p. 59. His testimony in this connection concluded with the statement that

"This Alemite Hydraulic equipment as shown in the drawing and in the samples that have been offered in evidence, has in it the combination of elements enumerated in claim 2 of the Butler patent."

The colored chart attached to the back of this brief includes a colored reproduction of the drawing Plaintiff's Exhibit 34 herein. This drawing shows the Alemite Hydraulic type of equipment. It comprises a yellow compres-

sor 9 having a discharge tube or conduit to the end of which is attached the coupler C for connecting the compressor 9 to the blue nipple 35. The coupler consists of a green part providing a cylinder 50 in which there is located a purple piston which is moved toward the blue nipple by the pressure of the lubricant behind or to the left of the purple piston. The piston consists of the cup leather 45 confined between metal washers 43 and 44.

When in preparation for the lubrication of a bearing, the nipple and coupler are brought together, the tapered head and the shoulder of the nipple press the jaws 40 backwardly and outwardly. Their movement is transmitted through the piston members 43, 45 and 44 to the head 47 of the sealing member 51, so that the entire reciprocable assembly moves backwardly within the coupler shell. When the tapered head of the nipple has sufficiently pushed the jaws backwardly, and has sufficiently wedged them apart, the head of the nipple can be moved in to a point at which the end of the nipple engages the semi-spherical face of the sealing member 51, in such a way as to effect a light initial seal between the sealing member and the end of the nipple.

Just as in the form of the invention shown in Figure 2 of the Butler patent, it is the head and shoulder of the nipple which cocks and resets the piston mechanism of the coupler in such a way as to permit of its subsequent operation to bring about the automatic gripping and the automatic end sealing of the coupler to the nipple.

After the nipple has effected this cocking or resetting of the piston mechanism, and after an initial light seal has been effected between the end of the nipple and the sealing member 51 of the coupler, the associated compressor 9 is operated in such a way as to force grease into the rear end of the coupler shell behind the piston 44, 45, and the associated sealing member 48. When grease under pressure is thus delivered into the rear end of the coupler shell. the purple piston 45 moves to the right under the pressure of the applied grease. The forward movement of the piston forces the red jaws 40 into the conical constriction provided at the right-hand end of the green coupler shell. As the jaws are forced into the tapered bore at the forward end of the coupler shell, they are compressed inwardly in such a way as to grip the nipple behind its enlarged head. This contraction or compressive actuation of the jaws prevents separation of the coupler from the nipple during the lubrication operation, i. e., the injection of grease into the bearing to which the bore of the nipple is connected. The operation of this gripping mechanism is entirely automatic. It requires no manipulation. It results automatically from the normal actuation of the compressor as in the act of delivering grease into the coupler shell and thence through the nipple into the interstices of the bearing to be lubricated. As described in claim 2 of the Butler patent in suit, the jaws or movable locking elements are

"actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

The orange-colored end-seal 51 is pressed against the head of the nipple by the pressure of the lubricant behind or to the left of this orange-colored end-seal. It will be noted that the end sealing member in this instance extends through the aperture 48 in the purple piston 45 and provides a central passage through which the lubricant can flow from the coupler into the blue nipple 35. The purple piston is located between the nut 47 and an opposing shoulder provided by the orange-colored seal, the nut and shoulder

being so spaced as to provide limited movement between the purple piston and the sealing member. (R. pp. 57-59, 253.)

The purple piston, red jaws, and the conically constricted end of the green coupling shell constitute an automatic gripping means actuated by the lubricant pressure for mechanically gripping the coupler to the blue nipple 35. The orange-colored sealing member 51 constitutes an apertured seat which is automatically pressed against the end of the blue nipple by the lubricant pressure. Because of the relative movement permitted between the sealing member 51 and the purple piston, the sealing member has a limited amount of movement independent of the movement of the gripping mechanism. (R. pp. 57-59, 253.)

When, after the injection of grease has been completed and it is desired to separate the coupler from the one nipple in preparation for its application to another nipple of the same kind, the grease pressure is relieved, whereupon a slight tilt of the coupler to one side or the other will cause the shoulder of the nipple at one side to disengage itself from the adjacent jaw. The grip between the nipple and the jaws of the coupler having in this way been relaxed, a slight tug or pull will effect the complete disengagement of the nipple from the coupler. The various parts of coupler mechanism are thereby restored to their initial positions,—ready for engagement by another nipple in the manner previously described. (R. pp. 57-59, 151.)

When the coupler is to be connected with the next nipple associated with another bearing, a light push on the compressor or coupler will cause the head of the nipple to wedge the jaws outwardly and backwardly in such a way as to cock and reset the piston mechanism for its gripping and sealing functions in the manner previously described.

### The Courts' Fifteenth Finding of Fact Was That:

"Plaintiff commenced selling the Alemite Hydraulic lubricating equipment exemplified in Plaintiff's Exhibit 13 to 20 and 22 to 25, inclusive, in April, 1933." (R. pp. 39-42-64.)

This Alemite Hydraulic lubricating equipment was manufactured and sold under the Butler patent in suit, and is marked with the number of the Butler patent, as appears from an examination of Plaintiff's Exhibit 13. Its construction and mode of operation are fully described by the plaintiff's witness Lynn A. Williams, Jr. at R. pp. 57-60.

The Courts' Sixteenth Finding of Fact Was That:

"Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof." (R. p. 40.)

When the Butler apparatus is being used to inject grease into a bearing, it is a complete combination of elements cooperating and coacting with one another to accomplish a unitary result. During the moment of such use, it has the characteristic of all patentable machines,—that all of the elements of the combination cooperate and coact with one another in the accomplishment of a unitary result. In this instance, the unitary result is the injection of grease under extremely high pressure into the interstices of the bearing.

One of the greatest and most practical advantages of the Butler invention is that each of the bearings of an automobile or other machine can be permanently equipped with one of the nipples. These headed nipples are so small and so simple that they can be manufactured and sold at a price of a cent or two each. The compressor and coupler parts are more expensive. One compressor and coupler can be combined for use with any one of the 30 nipples on a

given automobile,—or indeed with any one of 30,000,000 nipples permanently attached to the bearings of 1,000,000 automobiles.

A farmer can buy an automobile having 30 nipples permanently attached to its 30 chassis bearings. He can take the one compressor and coupler out of the tool kit and combine it in succession with each of these 30 nipples. If he likes the ease and effectiveness with which he can lubricate the bearings of his automobile, he may decide to increase the repertory of his own compressor and coupler by buying 100 more nipples and screwing them into the holes leading to the bearings of his reaper, his tractor, and his windmill. He can then combine his one compressor and coupler with any one of the 130 headed nipples in order to effect the lubrication of any one of 130 bearings.

This interchangeability of the parts which make up the complete combination of the Butler invention is an unusual characteristic,—a characteristic which is not present in most machines. It is because of this characteristic that purchasers invariably wish to buy such parts and such assortments of parts as well best serve their particular needs. It is this unusual characteristic which makes it necessary for the patentee or his assignee to separately price and sell the component parts of the complete combination.

As we have seen, the Butler patent describes and claims a combination of seven elements. Some of these elements inhere in the headed nipple part, some in the coupler part, and some in the compressor part. The nipple parts are adapted and intended to be screwed or otherwise more or less permanently attached to each of the bearings of an automobile or other machine (R. p. 39-40.) The compressor is intended to be filled with grease and then to be coupled in succession to each of the several nipples in or-

der to inject grease into the interstices of the several bearings. In a lubricating system of this kind it is a necessary characteristic that the complete combination of nipple part, compressor parts, and coupler parts be brought together only periodically and temporarily and then, too, only in the hands of the ultimate user. (R. p. 41.)

The manufacturer cannot sell the completed combination as such. No one wants to buy the completed combination, as such. What the ultimate user of the lubricating equipment of the Butler patent desires is to buy from the manufacturer such a number and such an assortment of nipples as may be required for permanent association with the several bearings of his automobile or other machinery. He wishes then to have the use of a single compressor and coupler with which he may connect occasionally each of his many nipples. Some makes of automobile have twenty chassis bearings with which these nipples are more or less permanently associated. Others may have as many as thirty-six. One man may own a single automobile. Some one else may own two or ten. (R. pp. 13, 395-401.)

Some automobile owners wish to grease their own cars. Others wish to have this greasing done at more or less public service stations and garages (R. pp. 47, 145).

Some bearings can be most conveniently greased when equipped with a "straight" nipple, others with a "90 degree elbow" nipple, still others with nipples extending at angles of 45 degrees, 22½ degrees, 67½ degrees, etc. Some of the nipples had best be long, others short. Some must have single check valves. Others must have double check valves. Some must be screwed into holes tapped with one-eighth inch pipe threads, others with holes having one-fourth inch pipe threads, and still others with holes having machine screw threads (R. pp. 40, 132, 395-401).

What the purchaser desires to buy, and what the manu-

facturer necessarily makes, is, therefore, an assortment of nipples of various angles, lengths, and thread sizes. What the purchaser desires to buy, and what the manufacturer sells, is, therefore, a variety of compressors, some large and power driven for use in a public garage, others small and hand operated for use in Johnny Q. Public's back yard. The sale of this kind of lubricating equipment requires, therefore, that the manufacturer separately list and price each of the various kinds of nipples and that he separately list and price each of the various sizes of compressor which may be coupled to and used in conjunction with the nipples. This leaves the purchaser free to buy the particular assortment of nipples best adapted to the lubrication of his own particular automobile or other machine. It leaves him free to buy a compressor of small capacity or a compressor of large capacity,—as may be best adapted to his particular needs. He may buy a power driven compressor, if he has much greasing to do; or he may buy a hand operated compressor, if he has only occasional and limited use for that part of the complete combination (R. pp. 40, 132, 395-401).

An automobile owner who invariably has his car greased at a public service station or garage has no use whatsoever for the compressor and coupler parts of the combination. On the other hand, a garageman who spends his life in greasing other people's automobiles has no need to buy the nipple parts of the combination for his own use (R. pp. 136-137).

Speaking by and large, it is only at the moment of greasing a bearing that the complete combination is ever brought together. This may be at the hands of the ultimate user or it may be at the hands of the garageman (R. pp. 136-137).

The combination of the Butler patent as manufactured

and sold by the plaintiff provides a system whereby every automobile and truck may in the course of its manufacture have every chassis bearing equipped (as prior to the contributorily infringing acts of the defendant it was equipped) at its factory with one of the Alemite Hydraulic . nipples (R. p. 129). The tool kits of the less expensive cars are generally provided at their factories with the Alemite Hydraulic compressor and coupler parts of the combination (R. p. 40). In the case of high priced cars, where presumably the greasing will be done at a public garage, it is the custom not to provide the tookkit with an Alemite Hydraulic compressor and coupler unless the purchaser of the car specially requests it (R. pp. 40, 136-137). The owner of every public greasing station provides himself with an Alemite Hydraulic compressor and coupler, furnished either by the plaintiff or one of its several licensees, so that the garageman will be in a position to grease any car which may drive in to his station (R. pp. 41-42).

If, as is the case, the dimensions of all of the several parts of the complete combination are standardized and maintained, then there will be complete universality of interchange and co-operability as between all of the nipple parts, all of the coupler parts, and all of the compressor parts of the complete combination. This universality of interchange and cooperability is one of the very practical merits of the Alemite Hydraulic System of chassis lubrication (Pl. Ex. 21).

The Courts' Seventeenth Finding of Fact Was That:

"Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April, 1933, to March, 1936, approximately 4,485,000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the cars at the factory." (R. p. 43.)

The Courts' Eighteenth Finding of Fact Was That:

"The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullborg and the Zerk lubri-

cating equipment because

(a) Under this equipment, it was not necessary to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting,—as was necessary in effecting a connection between a Gullborg coupler and fitting, and

(b) It was not necessary for the user to apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lu-

bricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception of the Duesenberg." (R. pp. 45-48, 50-51, 64, 128-129.)

# The Courts' Ninteenth Finding of Fact Was That:

"The mechanism embodied in the means by which the jaws are compressed about the nipple of the Alemite Hydraulic system, is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts." (R. pp. 57-60.)

As shown in Figure 2 of the Butler patent, the segmental jaws are squeezed between a stationary surface perpendicular to the axis, and a moving inclined surface which is associated with the piston. The result is that upon the application of grease pressure the jaws are forced inwardly to grip the nipple. (R. pp. 51-59.)

In the Alemite Hydraulic embodiment of the Butler invention the perpendicular surface is associated with the piston, and the inclined surface is associated with the shell.

Despite this reversal, the pressure of the grease causes the jaws to be squeezed between the perpendicular surface and the inclined surface in such a way as to force them inwardly to grip the nipple. (R. p. 57.)

This distinction-without-a-difference was made the subject-matter of much controversy in the District Court (R. pp. 105-107, 254.) We find no allusion to the matter, however, in the petitioner's brief, and shall not, therefore, elaborate relative to the proofs in support of (or in opposition to) the proposition that the two reverse arrangements are such exact mechanical equivalents of one another that the language of claim 2 does not even distinguish between them.

The petitioner's brief does not refer to any of the evidence in this case upon which it is urged that the plaintiff's Alemite Hydraulic equipment does not embody the invention of claim 2 of the Butler patent. It confines itself to the erroneous assertion that the 8th Circuit Court of Appeals "held" and "adjudicated" that the Alemite Hydraulic equipment does not embody the invention claimed in the Butler patent. The Alemite Hydraulic equipment came into the Jiffy case only for the purpose of showing that the invention of the Butler patent had had great commercial success at the hands of the plaintiff. The matter was not in issue. It was only a matter of evidentiary persuasion.

What the 8th Circuit Court of Appeals said in the Jiffy case was that the plaintiff's Alemite Hydraulic couplers do not correspond "to the drawing and specification of its Butler patent" and that "the plaintiff had not manufactured for sale any couplers according to the drawings or specifications on which the claim in suit reads."

. What these statements mean is that the plaintiff's couplers were not manufactured according to the drawings or "on which the claim in suit reads" is intended to identify the drawings and specifications. Thus the 8th C. C. A. might have said, "The plaintiff has not manufactured for sale any couplers according to the drawings or specifications of Figure 2 and the description concerning it." It is upon this drawing and description which the claim in suit (claim 1) reads. The 8th C. C. A. did not express even a dictum as to whether or not the plaintiff's Alemite Hydraulic equipment comes within the scope of Butler's claims or either of them.

On the other hand, the 8th Circuit Court of Appeals did say that it regarded the reversal of the location of the inclined and perpendicular surfaces as involving merely "a clear mechanical equivalent".

The Jiffy Company's coupler had the inclined surface incorporated in the shell as in the plaintiff's Alemite Hydraulic. It had the perpendicular surface incorporated in the piston member as in the plaintiff's Alemite Hydraulic. The coupler, made up by the plaintiff in the Jiffy case to demonstrate the Butler patent, had the perpendicular surface associated with the shell and the inclined surface associated with the piston member precisely as shown in the drawings of the Butler patent. It was relative to this matter of mere reversal that the 8th Circuit Court of Appeals said in its opinion (citation at page 793):

"We consider the Jiffy coupler a clear mechanical equivalent of the coupler which has been made by the plaintiff to demonstrate the Butler patent."

(To be sure, the 8th C. C. A. went on to say, "We find latter to be a departure and different from the real disclosure of that patent.") The difference was that in our embodiment of the Butler patent the "spring fingers" took the form of a slitted cylinder having a strength sufficient to grip the jaws 40 to the throat of the nipple. The 8th C.

C. A. formulated the view that Butler's "spring fingers" must be so flimsy as not to effect any gripping of the throat of the nipple.

As we have seen, however, both the plaintiff and the defendant in the instant case agree that the disclosure of the Butler patent is of a tubular or cylindrical member 42, which may be slitted as in the sample which the plaintiff made up for submission to the Court in the Jiffy case and as in the samples submitted to the District Court in the present suit. (Pl. Ex. 63, Deft. Ex. A-61.)

The Courts' Thirty-first Finding of Fact Was That:

"There is nothing in the Butler patent which requires the use of spring fingers which can yield a substantial amount." (R. p. 240.)

This was Judge Lindley's answer to the defendant's contentions as advanced upon the basis of the decision of the 8th C. C. A. in the Jiffy case, 81 F. (2d) 786.

It is based upon the disclosure within the four corners of the Butler patent. (R. p. 464.)

The record contains much testimony upon the subject. At the outset of the defendant's case in the District Court, Mr. Fox, the Vice President of the Lincoln Engineering Company, made an elaborate presentation of a certain sample. (Defendant's Exhibit A-61.) Mr. Fox endeavored to show that if the spring fingered cylinder 42 were quite stiff or rigid then it would be impossible to withdraw the coupler from the nipple. (R. pp. 103-104.) He endeavored to show, on the other hand, that if the walls of the small cylinder 42 were made sufficiently thin, and if the slits were carried far enough toward the base of the piston 43, then the flimsy fingers could be sprung outwardly a distance sufficient to permit the withdrawal of the coupler from the nipple. (R. pp. 101-103.) The attempted point of all

coupler must have exceedingly thin, weak and flimsy "spring fingers". He compared this "necessary" flimsiness with the relative strength of the spring finger or jaw mechanism of the plaintiff's Alemite Hydraulic coupler in an effort to show that the relatively strong Alemite Hydraulic coupler did not embody the invention of the relatively weak Butler coupler. (R. pp. 105-107.)

All of Mr. Fox's testimony and all of Mr. Fox's demonstrations were turned into a pitiable fiasco when upon rebuttal Lynn A. Williams, Jr. discovered and demonstrated that Mr. Fox's demonstration apparatus had been falsified by making the cylinder shell so short that the piston mechanism could have no longitudinal movement whatsoever,—regardless whether the flexible "spring fingers" be made relatively stiff or relatively flimsy. (R. pp. 235-238.)

# The Courts' Twenty-second Finding of Fact Was That:

"When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile lubricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or nozzles of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fittings."

# The Courts' Twenty-third Finding of Fact Was That:

"In May, 1933, Mr. A. P. Fox, the vice-president and designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraulic system. Although he had known of the compressor and coupler parts at any earlier date, he became familiar with them at least as early as January, 1935."

The Courts' Twenty-fourth Finding of Fact Was That:

"The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hydraulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part or the plaintiff's nipple part."

The Courts' Twenty-fifth Finding of Fact Was That:

"The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydraulic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of slightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make."

The Courts' Twenty-seventh Finding of Fact Was That:

"Defendants sold Lincoln Kleenseal fittings with the knowledge that they were to be used in combination with the compressor and coupler parts of the Butler combination as sold by the plaintiff for use with plaintiff's Alemite Hydraulic coupler equipped grease guns."

The Courts' Twenty-eighth Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri expected that automobiles equipped with the Lincoln nipple part of the combination and sold in the United States, would be lubricated at garages and service stations. The plaintiff had previously sold millions of the compressors and coupler parts of the combination, and had endeavored to supply every public garage and service station in the United States."

The Courts' Twenty-ninth Finding of Fact Was That:

"The Lincoln Engineering Company of Missouri in its Kleenseal fittings, duplicated, fitting for fitting, all of the arbitrary dimensions of the entire line of Alemite Hydraulic fittings."

The Courts' Thirtieth Finding of Fact Was That:

"The Lincoln Engineering Company did not sell any of its grease guns or nozzles to automobile manufacturers for tool kit equipment of automobiles sold in the United States, even though the automobiles were equipped with Lincoln Kleenseal fittings."

The Courts' Thirty-third Finding of Fact Was That:

"The Alemite Hydraulic coupler will grip and form a sealed connection with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent describes one combination as well as the other."

We have grouped together the foregoing findings because they relate to matters which constituted the principle defense in the District Court, but which are not made the subject of any defense or contention in this Court.

Taken together, these several findings mean simply that the Lincoln Company has endeavored to oust the Stewart-Warner Corporation from the sale of the nipple parts of the plaintiff's Alemite Hydraulic system. Briefly; the Lincoln Company has been selling the nipple parts of the complete combination of the Butler patent, with the knowledge and intent that the purchasers would combine them in use with the other parts of the combination as sold by the plaintiff.

Prior to the commencement of the Lincoln Company's manufacture and sale of its so-called "Kleenseal" nipples for intended and expected use in conjunction with the other parts of the Butler combination, the Lincoln Company had

worked up an elaborate pretense. It sought to put itself in a position where under this pretense it could assert that the Lincoln "Kleenseal" fittings were really designed and sold with the intention and expectation that the purchasers would use them in conjunction with certain compressors and nozzles furnished or to be furnished by the Lincoln Company itself, and in such ways as would not involve either direct or contributory infringement of the Butler patent.

This pretense was made the subject-matter of much testimony on the part of the defendant (R. pp. 87-89, 93-96, 127-128, 223-224). It was made the subject of much rebuttal testimony on the part of the plaintiff in showing that the exact form, size, shape, and configuration of the Lincoln Company's "Kleenseal" nipples was not necessary or appropriate to any of the innocent uses for which the Lincoln Company claimed to have made and sold them, but only for the contributory infringing use which the purchasers were shown to have made of them (R. pp. 60-61, 259-272).

A large part of the record was devoted to a showing that the Lincoln Company had developed straight-sided nipples with no groove or head or shoulder, and that these straight-sided nipples could be used just as effectively with the compressors and nozzles manufactured and sold by the Lincoln Company itself as could the grooved, shouldered, and headed nipples with which they were succeeded. There was much evidence showing the Lincoln Company's efforts to sell these straight-sided and non-infringing nipples to the General Motors Corporation and to others (R. pp. 124-127, 137-139, 143-144).

Much testimony was adduced to show that it was only when the Lincoln Company changed its nipples in such a way as to incorporate the characteristic features of the Butler nipple as found in the plaintiff's Alemite Hydraulic system, that it became possible to make sales to the General Motors Corporation and its subsidiaries, Oldsmobile, Buick, Pontiac, Cadillac, etc. (R. pp. 127, 131-135, 137-139, 143-144, 147).

Much evidence was adduced to show that the inevitable result of these sales would be the use of the Lincoln Company's "Kleenseal" fittings in substitution for the plaintiff's Alemite Hydraulic fittings as parts of the complete combination of the Butler patent (R. pp. 42-44, 131-132, 135).

Much of the evidence had to do with the knowledge of the Lincoln Company's engineering staff relative to the construction and mode of operation of the plaintiff's Alemite Hydraulic equipment into which the Lincoln Company's "Kleenseal" nipples were intended to go. Much of it had to do with the exact date of this knowledge, or with bringing home such knowledge and intent as of a date prior to the filing of the supplemental bill of complaint herein (R. pp. 115, 120, 127-135).

Some of the evidence had to do with sales of the Lincoln "Kleenseal" nipples by the Lincoln Company's Chicago distributing agency, under circumstances which were conclusive as to the purpose and intent for which the Lincoln nipples were sold (R. pp. 43-44).

Your Honors will observe that a very considerable part of Judge Lindley's first opinion of July 15, 1936, is directed to a consideration of this evidence which led inevitably to the conclusion that the Lincoln Company's nipples were sold with the knowledge and intent that purchasers would combine them in use with the other parts of the plaintiff's Alemite Hydraulic equipment, manufactured and sold under claim 2 of the Butler patent in suit.

We do not elaborate our statement of facts in regard to these matters. This is for the reason that the petitioner has completely abandoned this, its major line of defense in the District Court.

We have failed to find throughout the whole of the petitioner's brief, the slightest contention or suggestion that the Lincoln Company's "Kleenseal" nipples were not from the beginning and at all times thereafter, sold with the definite knowledge, intent, and expectation that the purchasers would combine them in use with the compressor and coupler parts of the Butler combination as manufactured and sold by the plaintiff.

The petitioner's present contention is that it had the right to do the very thing which the District Court found that it had been doing, but which in the District Court the petitioner denied that it had ever done at all.

In so far as any question of infringement is now concerned in this Court, the defendant's only contention is that the plaintiff's own Alemite Hydraulic equipment does not embody the invention of the Butler patent, and that therefore anybody and everybody is free to make and sell any and every part of it, including, of course, the nipple parts made and sold by the defendant. This contention is not based upon anything which can be found or which the defendant even alludes to as capable of being found in the record in the present suit. It is based solely upon the dictum-like view of the Eighth Circuit Court of Appeals in the Jiffy case, that the plaintiff's Alemite Hydraulic equipment is not made in the exact form shown and described in the drawings and specifications of the Butler patent.

It is for these reasons and under these circumstances that we do not elaborate our statement relative to the acts and guilty intent of the defendant in and about its sales of the Lincoln "Kleenseal" nipples or fittings.

Just inside the back cover of our brief, we have included

a chart comprising colored drawings of the structure of Figure 2 of the Butler patent, and of the Alemite Hydraulic equipment manufactured and sold by the plaintiff (Plaintiff's Exhibit 34), and of the defendant's "Kleenseal" nipple 35 when combined in use with the compressor and coupler parts sold by the plaintiff. The last of these drawings is a reproduction of Plaintiff's Exhibit 36. (R. p. 313.)

It was repeatedly demonstrated during the course of the trial that the cooperation of all of the parts and the functions of all of the parts of the complete combinations were identically the same, regardless whether the plaintiff's Alemite Hydraulic nipple or the defendant's Lincoln "Kleenseal" nipple be associated with the Alemite Hydraulic compressor and coupler. (R. pp. 61-62.)

It is perfectly evident that if claim 2 of the Butler patent describes the Alemite Hydraulic equipment of Plaintiff's Exhibit 34, it describes also the defendant's nipple when combined in use with the plaintiff's compressor and coupler.

Claim 2 of the Butler patent reads in precisely the same way on the combination of the Lincoln "Kleenseal" fittings (Plaintiff's Exhibit 27-A and 27-B) with the Alemite Hydraulic compressor and coupler (Plaintiff's Exhibit 28) which the witness Cornell had with him at the time he purchased these Lincoln fittings (R. p. 62), as it does on the combination of the Alemite Hydraulic fittings (Plaintiff's Exhibit 14) with the same Alemite Hydraulic compressor and coupler.

The Courts' Thirty-fourth Finding of Fact Was That:

"Defendants' model of Fig. 2 of the Butler patent does not accurately or fairly represent the invention of Butler." The Courts' Thirty-fifth Finding of Fact Was That:

"Defendants' Exhibit A-61 does not correspond to the alleged drawing thereof, Defendants' Exhibit C-21."

These findings have to do with a matter to which we have previously referred, namely, the defendant's falsification in its Exhibit A-61 of the disclosure of the Butler patent. This falsification involved making the cylinder of the defendant's A-61 coupler so short that there was no room for the piston member to have any reciprocating movement whatsoever. The whole matter is covered in the testimony of the plaintiff's witness, Lynn Williams, Jr., at R. pp. 235-245.

In connection with its alleged sample A-61, the defendant presented a drawing, Defendant's Exhibit C-21. The representation was that the sample faithfully followed the details shown in the drawing. (R. pp. 104-105.) The drawing fairly represented two different embodiments of the Butler construction. The plaintiff discovered, however, that the defendant's physical sample did not correspond with the defendant's drawing as had been claimed by it, and it discovered also that it was solely because of this discrepancy that the physical sample did not operate in accordance with Butler's-patent specifications.

### The Courts' Thirty-sixth Finding of Fact Was That:

"Defendants' expert stated that none of the prior art except Winkley Reissue patent No. 14,667 accomplishes the results obtained by the Butler patent."

The part of the record to which this finding refers comprises certain of the testimony of Alexander P. Fox. Mr. Fox's testimony relative to this matter is as follows:

"Generally speaking, of all these prior art patents to which I have referred, the only ones which refer in any way to the art of lubrication are those to Richardson and Dupre and Seng and Wurster. All the patents to Richardson, Dupre, Wurster, and Seng, show headed fittings. The Wurster patent 356, 519 shows a compressor having a coupling member. I can't make

up my mind which is the nearest or closest.

Q. Can you name any one patent or other publication or any patent application filed prior to the filing of the application for the Butler patent in suit on February 19, 1923, which in and of itself discloses lubricant equipment comprising in any form whatsoever, nipples permanently attached to the bearings, and a compressor having a coupler adapted for attachment to any of the nipples, in which the coupler has any kind of means whatsoever for compressively clutching or mechanically gripping the coupler to the nipple and any kind of means whatsoever for sealing the joint between the coupler and the end of the nipple against leaking, both of which means are automatically operated by the pressure of the lubricant in such a way that the intensity of the mechanical grip and the tightness of the end seal are increased as the pressure of the lubricant is increased?

A. I will look through my patent references here. I would say the first one I come on to here, which is F. D. Winkley re-issue 14,667 is for a lubricating system in which there is a compressor, a coupling member, and a headed nipple. I find this Winkley patent shows what is accomplished by the Butler patent."

(R. pp. 220-221.)

# The Courts' Thirty-seventh Finding of Fact Was That:

"The Winkley Reissue patent No. 14,667 does not disclose the radially movable locking elements, the piston, or the means octuated by the piston for compressively clutching the locking elements upon the nipple, as Butler's invention is defined in claim 2 of his patent. The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in Butler's claim 2."

The Winkley patent (owned by the plaintiff throughout its entire life) appears at page 526 of the Record. A brief examination of its drawings and specifications will show

how utterly remote it is from the subject-matter of the Butler patent in suit. In the Winkley patent the end of the compressor conduit is attached to the head of the shackle bolt solely by a manual hooking of the forked claws 36 (Figs. 4 and 5) over the head 29 of the shackle bolt. The only seal between the flexible conduit and the shackle bolt hole leading into the bearing is the cup-shaped member 37. This "oil cup" is pressed in the direction of the joint by a spring 46. As Winkley puts it in his specification,

"The oil cup 37 is yieldingly mounted in the nozzle proper, and is held downwardly therein with its bottom projecting beyond the plane of the nozzle proper by a relatively stiff expansion spring 46 interposed between the cap 43 of the cup and a cap 47 threaded into the top of the nozzle body." (page 2, line 60, R. p. 530.)

In the Winkley device the pressure of the grease has no part whatsoever in attaching or gripping the nozzle to the head of the shackle bolt. Furthermore, the pressure of the grease does not tend in the slightest degree to seal the joint between the nozzle and the head of the shackle bolt. On the contrary, the pressure of the grease tends to disrupt the union between the "oil cup" of the nozzle and the head of the shackle bolt. As soon as this pressure rises to a point sufficient to overcome the pressure of the spring 46, the oil cup 37 will be burst away from the head of the shackle bolt, and grease will be extruded into the atmosphere at the would-be joint between the oil cup and the shackle bolt.

It was for these and similar reasons that Judge Lindley found that the disclosure of the Winkley patent

"is not in any way analogous to the combination of elements defined in Butler's claim 2."

Despite the fact that the defendant's Vice-President and

Chief Engineer and expert witness, Fox, selected the Winkley patent at the closest approach in all of the prior art to the invention of the Butter patent, the petitioner does not in its brief in this Court make the slightest mention of this Winkley patent, except to list it with many other patents as showing a "headed" piece of metal for the reception of lubricant or for some other purpose. (Appellant's brief, pp. 14 and 50.)

# The Courts' Thirty-eighth Finding of Fact Was That:

"The particular shape of the oil cup shown in the Richardson patent No. 8,251 has no significance of functional utility."

The Richardson patent (R. p. 472) was issued in 1851. It shows a tube with a spring-pressed check valve at the outer end, this valve "serving to close the mouth of the cup and exclude dirt, but yielding to the slightest pressure of the spout of an oil can or feeder, and allowing the oil or other lubricating material to be introduced; closing itself when the pressure is removed, and forming, in fact, a self-acting stopple." (p. 1, l. 21,—R. p. 473.)

The outside of this tubular member was given a somewhat ornamental configuration, including a little flange. The defendant seized upon this ornamental flange and then proceeded at great length (R. pp. 89-93, and Defendant's Exhibits A-45, C-18, and A-46) to convert Richardson's mechanically useless ornamentation into the functionally useful head, shoulder, and throat of Butler's nipple. The irrelevancy of the Richardson oil cup sufficiently appears from the fact that the oil was gotten into it from the spout of an old fashioned oil can poked into the hole at the top of the oil cup in such a way as to dislodge the dirt-excluding valve. (Such valve-closed oil holes became a matter of common knowledge in connection with sewing machines and bicycles.)

### The Courts' Thirty-ninth Finding of Fact Was That:

"The patents to Paul No. 621,276, Ulleland No. 1,253,309, and Pinel French No. 327,557, each discloses a construction readily distinguishable from that claimed by Butler in that in each of these prior art patents the locking elements are not actuated by any piston nor automatically by the pressure of the grease."

The Paul patent shows a garden hose coupling (R. p. 480). The Ulleland patent shows another garden hose coupling at R. p. 516. The Pinel patent shows a garden hose coupling at R. p. 597. The petitioner's brief in this Court makes no reference to these patents except to list them, with many others, on a chart following page 16, showing what petitioner's counsel choose to designate as "headed 'nipples'." None of these patents had any relation to lubrication of any kind. None of them suggested a lubricant compressor or any such coupler as that of Butler for participating in the connection of anything whatsoever.

### The Courts' Fortieth Finding of Fact Was That:

"The patent to Newton No. 1,118,876 discloses a train hose testing appliance which was never intended to be used for high pressure lubrication and could not be used for such purpose without making a great many alterations of an inventive character in its construction. It does not embody the combination of claim 2 of the Butler patent."

### The Courts' Forty-first Finding of Fact Was That:

"Defendants' representation, Exhibit A-68, differs in many material respects from the disclosure of the Newton patent No. 1,118,876, but even with all of the changes which have not been incorporated in it, in an endeavor to make it work, it is not a commercially feasible or practically operative device for high pressure lubrication." The "Defendants' representation, Exhibit A-68," embodied the defendants' attempt to reconstruct the railroad brake hose testing device of Newton patent No. 1,118,876 in such a way as to convert it into a high presure automobile chassis lubricator.

Contrary to the main reliance in the District Court of the defendant's vice-president and chief engineer, Mr. Fox, upon the Winkley Reissue patent (R. pp. 221, 226), counsel for the petitioner now in this Court practically confine their attention to this Newton patent as invalidating the Butler patent on the score of anticipation (pages 28 to 30), or at least upon the contention that "no invention was involved." (page 32). Counsel for the petitioner conclude their nine-page discussion of the Newton patent by reference to certain distinctions between the mechanism of Butler's coupler and the mechanism of Newton's air brake hose testing device and say in this connection that

"Such distinction is without patentable significance because it, at best, merely spells the substitution of Gullborg's (R. pp. 534-9) or Seng's (R. pp. 542-4) conventional axially-sealing 'cup washer' in place of Newton's radially sealing tubular washer."

The "no invention" argument of counsel for the petitioner would carry far more weight if the defendant's vice-president and chief engineer had not attempted with brass and iron to show that Newton's air brake hose testing appliance could, by various changes, be converted into a high pressure lubricating system; because, despite all of Mr. Fox's many modifications and changes, the demonstration served only to convince Judge Lindley that the resulting device was "not a commercially feasible or practically operative device for high pressure lubrication."

The defendant's modified revamp of Newton's air brake hose testing appliance was offered in evidence as Defendant's Exhibit A-68. The brief of counsel for the petitioner is careful to conceal the fact that there was any such attempt to construct a lubricating device upon the basis of Newton's disclosure or by the defendant's proposed modifications of it. Counsel are careful to conceal the fact that the attempt was offered in evidence and now constitutes an exhibit in the case. They do not even cite or refer to any of the many words of testimony relative to this matter. As a matter of fact, however, the impossibility of utilizing the Newton construction for high pressure lubrication was fully discussed by the plaintiff's expert at R. pp. 274-293.

The many, many differences between the disclosure of the Newton patent and the defendant's modified revamp, Exhibit A-68, are discussed by Lynn Williams, Jr., at R. pp. 278-279, 283-290. The demonstrations of the impracticability and non-feasibility even of this modified revamp for the purposes of high pressure lubrication, are fully discussed in the Record at pp. 278-279 and 289-290.

The many respects in which the Newton railway brake hose testing appliance fails to incorporate and embody the several elements of claim 2 of the Butler patent, are discussed at R. pp. 292 and 293.

One of the important respects in which the combination of the Butler patent differs from the air brake hose testing device of the Newton patent, is that upon the initial engagement of Butler's headed nipple by his coupling mechanism, the head of the nipple cooperates in such a way as to cock or reset the piston of the gripping mechanism so that it can subsequently be driven forward under the pressure of the grease, to grip the throat of the nipple between the jaws of the coupler.

In the Newton mechanism the metal terminal of the air brake hose (which counsel for the petitioner wish to regard as the "headed nipple" of the Newton device) does not and cannot perform the function of cocking or resetting the piston mechanism. In the Newton device the return of the piston to its left-hand position as shown in Figure 1 of Newton's drawings (R. p. 502), is accomplished by manually turning the valve 3 into the position which it occupies in this Figure 1, thereby admitting compressed air into the space 17 to the right of the piston 16. It is this retraction of the piston and its associated mechanism under the power of the valve-controlled compressed air, which alone does or can return the piston mechanism from the position shown in Figure 2 to the position shown in Figure 1, in order to put the mechanism in condition to apply a fresh charge of compressed air to the piece of air brake hose which is to be tested.

Upon the trial, the plaintiff's expert found it impossible, with a sample of Newton's testing device, to insert the terminal of the air brake hose into the yielding packing tube 5 until he had manipulated the valve 3 in such a way as to retract the piston mechanism under the power of the compressed air supply. The whole matter is discussed at Record pages 274 to 285.

The resetting of the hose gripping mechanism of the Butler patent by a steam engine action of the piston mechanism under the power of the compressed air, is described as follows at page 2, line 47, of the Newton patent, where it is said:

"After the test has been made, and it is desired to disconnect the appliance from the hose so that it may be readily applied to another similar hose to be tested, the controlling cock 3 is again moved to the position shown in Fig. 1, which permits air to exhaust from the chamber 17 at the left of the piston 16 and causes air to enter through the port 20 at the right of the piston 16 which is thus moved from right to left back to the position shown in Fig. 1. This releases the clamping fingers 9, leaving them free to expand, and while the fluid from the clamping tube 5 and the hose may flow back through the passage 18 and thence escape to the

air, the said passage 18 is so small that it does not immediately make a large reduction in the pressure in the hose, the reaction of which thus serves to eject forcibly the coupling member 4 from the packing tube 5 as soon as the pressure of the spring fingers 9 thereon is relieved by the disengagement of the cam surfaces 10 and 11."

In the Butler combination, all of the resetting or cocking of the piston and its associated gripping mechanism is accomplished automatically by the head of the nipple as it wedges its way into the space between the jaws upon the disengagement of the coupler from one nipple preparatory to its connection with another nipple, or, if need be, upon the initial engagement of the coupler with any one of the many headed nipples with which it is to be combined in use.

The manner in which the headed nipple of the Butler combination effects the cocking or presetting of the piston mechanism upon the initial contact between the two parts of the connector mechanism, is extremely valuable in a high pressure lubricating apparatus. It makes possible the "one hand" operation of the lubricating mechanism in relatively concealed and inaccessible parts of an automobile (R. pp. 46 and 50). The steam engine reciprocation of the piston mechanism of the Newton device under the control of a manually operated air valve which must be located at or close to the point of junction, would make the Newton construction and method almost impossible of use in an automobile lubricating apparatus. (R. p. 286.)

One of the Newton brake hose testing appliances was purchased from Newton's assignee, the New York Air Brake Company, and offered in evidence as Plaintiff's Exhibit 79. Samples of air brake hose and their coupling terminals were offered in evidence as Plaintiff's Exhibits 59, 60, and 80. Even a casual examination of these exhibits makes it obvious that the large, complicated, and

extremely heavy apparatus of this Newton patent is utterly unsuited for any lubrication purpose. The air pressure utilized in testing air brake hose have a maximum of 160 pounds per square inch. The entire design and construction of the Newton brake hose testing device is utterly unsuited for handling grease pressures of the order of 10,000 pounds per square inch, as is a common requisite in the art of automobile chassis lubrication.

The full size air brake hose testing appliance of the Newton patent was set up and repeatedly demonstrated in the District Court with a power-driven air compressor, precisely in accordance with its intended use and mode of operation. This demonstration of the reality, as made and constructed by Newton and his assignees, was perhaps the best possible evidence of the manifold differences in construction and mode of operation between the Newton device and the lubricating system of the Butler patent in suit.

Finally, the testimony of the defendant's Chief Engineer and expert, Alexander P. Fox, almost completely removed the Newton air brake hose testing appliance from the need of further consideration. In this connection we very particularly refer the Court to the following cross-question which was put to Mr. Fox at R. p. 221, and to the answers and evasions which it elicited throughout the immediately succeeding pages of the record.

"Q. Can you name any one patent or other publication, or any patent application filed prior to the filing of the application for the Butler patent in suit on February 19, 1923, which discloses any kind of pumping system for any kind of fluid whatsoever, either liquid or gas, in which there is a compressor connected to a nipple by a coupler, which includes a cylinder and piston cooperating so as to tighten any kind of gripping elements inwardly around the nipple upon actuation of the compressor, and which also includes a fluid pressed seal engaging the end of the nipple to effect a fluid tight joint. I have cut that question out

of my notes so that you can read the question as well as having heard it."

It is to be observed that this "formal cross-question No. 2" was exceedingly broad and comprehensive. It was not limited to the art of lubrication. It embraced any and every field "for any kind of fluid whatsoever, either liquid or gas." Nevertheless, Mr. Fox could not answer it, and did not answer it by suggesting Newton (or anything else in the prior art) as meeting its broad and comprehensive terms.

He took refuge rather, in asserting that claim 2 of the Butler patent did not describe the structure shown in the drawings and specifications of the Butler patent itself. We do not stop to discuss the absurdity of such a position and contention.

Mr. Fox's contention that the claim of the Butler patent did not even describe the device shown in its own accompanying drawings and specifications was of course based upon his other contention and attempted demonstration that the Butler apparatus was operative only when the jaw-actuating mechanism of the piston member was so weak and flimsy that it would not apply any pressure upon the jaws or permit the jaws to apply any pressure to the nipple, and upon the allied contention and attempted demonstration that when the jaw-actuating mechanism was made sufficiently stiff to apply pressure, then the device would be completely inoperative because of the alleged impossibility of removing the coupler from the nipple.

These contentions were utterly annihilated upon the subsequent discovery and demonstration that Mr. Fox had falsified his presentation and demonstration by shortening the cylindrical shell of the coupler to an extent such that the piston mechanism could not reciprocate at all, as is of course required by the disclosure of Butler's drawings and specifications. This subsequent demolition of any possible basis upon which Mr. Fox could take refuge in the alleged non-applicability of Butler's claim to Butler's disclosure, left him and the defendant in the position of being unable to advance Newton or anything else in the prior art as even approaching an anticipation of the Butler invention, even when considered in an aspect much broader than the art of lubrication.

The several other prior art patents listed but not otherwise discussed in the appellant's brief are of the kind which show one element or another element but not the complete new combination which Judge Lindley had in mind when, in his first opinion of July 15, 1936, he said:

"Obviously to any trial judge, in their final analyses, almost all patentable combinations are of the second class, namely: those in which all the elements are of themselves old." (R. p. 611.)

The defendant offered in evidence and, in its brief, lists a grist of patents, some showing one element and some showing another. None of them discloses the complete combination of the claim or anything approaching the complete combination of the claim. It would not seem to be profitable to canvass these many prior patents to which the petitioner's counsel themselves give only the scantiest and most passing attention.

### The Courts' Twenty-sixth Finding of Fact Was That:

"The defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, sell any Lincoln Kleenseal fittings."

This is the only one of Judge Lindley's Findings of Fact which we have not heretofore quoted. It means merely that the officers of the Lincoln Company were found not to be liable in their individual capacities.

#### ARGUMENT.

I.

THE SUPREME COURT HAS NOT RECENTLY ABOLISHED THE AGE OLD LAW OF JOINT TORTS AS APPLIED TO THE INFRINGEMENT AND CONTRIBUTORY INFRINGEMENT OF PATENT RIGHTS. THERE HAS BEEN NO SUCH REVOLUTION IN THE LAW OF PATENTS AS IS ADVOCATED BY COUNSEL FOR THE PETITIONER.

The Petitioner's Contentions Raise a Question of Paramount Importance.

Is there any such thing as a contributory infringement?

If so, what is it?

If there is such a thing as contributory infringement, how should it be described,—or defined?

If there is no contributory infringement in the instant case, what possible facts or circumstances could support a charge of contributory infringement?

Such questions as these are the paramount issues before this Court.

For the Purposes of our Discussion of This Question of Contributory Infringement, We Shall Assume That the District Court and the Court of Appeals Were Fully Justified in Their Conclusions (1) That the Butler Patent in Suit Was Not Anticipated by the Prior Art; (2) That It Involved the Exercise of Invention; (3) That the Lubricating Apparatus Manufactured and Sold by the Stewart-Warner Corporation Does Embody the Invention of the Butler Patent; (4) That Claim 2 of the Butler Patent Describes a Patentable Combination,—Not an Unpatentable Aggregation; (5) That There Is No Issue of Alleged Clayton Act Violation; and (6) That There Is No Issue of License to the Defendant-Petitioner.

(1) Counsel for the petitioner urge that the Butler patent in suit is invalid because it is anticipated by the prior art. It is only by a flagrant disregard of the plain language of Butler's specification and claim that this contention can be advanced. We apprehend that the Court will not be able to find in any one disclosure of the prior art an anticipatory response to the plain language of Butler's claim 2, regardless whether it be read literally or whether it be read as it is entitled to be read, in the light of the accompanying specifications and drawings.

We shall recur to this defense of "anticipation." For the time being, we shall assume that the structure described in claim 2 of the Butler patent was not known or disclosed by any one else prior to the date when Butler filed an application for the patent in suit.

(2) Counsel for the petitioner urge that Butler's achievement did not involve the exercise of the inventive faculty,—that any one could and would, as a matter of course, have brought together the mechanism described in Butler's claim. The evidence is overwhelmingly to the contrary.

In less than a year after the Stewart-Warner Corporation bought the Butler patent and put the Butler lubricating equipment on the market, it had become the standard factory equipment of every automobile and every automobile truck made in America (with the single exception of the Duesenberg \$15,000 automobile). The respondent's Alemite Hydraulic lubricating system as manufactured and sold under the Butler patent in suit is universally regarded as far and away the best and at the same time the cheapest lubricating apparatus which has ever been devised. deficiencies and disadvantages of every lubricating system which had been marketed prior to the advent of the Butler invention were generally recognized. There was a general recognition of the need of something better. As soon as the Butler equipment was placed upon the market, it immediately displaced everything which had gone before.

Under such circumstances, it is impossible to advance any substantial reason for a conclusion that the Butler patent is invalid because "no invention was involved."

(3) Counsel for the petitioner urge that the Alemite Hydraulic lubricating equipment manufactured and sold by the Stewart-Warner Corporation does not incorporate the invention which is described and claimed in its own Butler patent. No substantive reason is advanced in support of this contention. The petitioner relies wholly upon an irrelevant dictum of the Eighth Circuit Court of Appeals in which it was said that the respondent's Alemite Hydraulic couplers do not correspond "to the drawings and specification of its Butler patent." Any weight or pertinency which might by any possibility be attributed to the Eighth Circuit idea of the "spring finger" construction and operation of the Butler mechanism, is unavailable to the petitioner in the present case because the petitioner recognized the untenability of the Eighth Circuit idea to the extent of offering evidence to show that the mechanism illustrated and

described in the Butler patent is not such mechanism as must have been assumed by the Eighth Circuit Court of Appeals, but rather just such mechanism as the respondent has invariably offered in evidence as representing the construction illustrated and described in the Butler patent.

We are confident that the Court will, upon the basis of the petitioner's evidence, as also upon the basis of the respondent's evidence, reach the conclusion that the Stewart-Warner Company's "Alemite Hydraulic" lubricating equipment does embody the invention described and claimed in the Butler patent in suit. For the time being, we shall assume that such is the fact and will be the conclusion of the Court.

(4) From first to last, the petitioner's brief insinuates and assumes and contends that the new coaction and cooperation between the "headed nipple" element and the other six elements of the Butler combination, did not entitle Butler to claim the whole of his new combination. Counsel insinuate and assume (they cannot well contend) that the very essential coaction of the headed nipple in resetting and cocking the piston mechanism of the coupler, and in various other ways, had no part in the achievement of Butler's new and unitary result. Counsel for the petitioner insinuate and assume (they cannot well contend) that Butler's grease compressor had no new or different function in bringing about the automatic gripping and the automatic end sealing of the connection between the two halves of the connector mechanism during the injection of grease.

Butler's "machine" is like every other new and patentable machine in that it comprises a new combination of elements,—each of which elements was separately old and well known. In so far as the instant case is concerned, the purposes of counsel for the petitioner are well served by attempting or pretending to concede that the five separately old elements which make up the coupler part of the whole, constitute a good and valid "combination," whereas the seven separately old elements which make up the complete mechanism necessary to achieve the new and unitary result, do not constitute a valid and patentable combination.

The lower courts have found and explicitly described the new and unitary result which Butler achieved. They have found that each of the seven elements of claim 2 co-operates in new ways and performs new functions in the achievement of this new and unitary result. They have explicitly described the various respects in which the headed nipple part of the Butler combination co-operates with the other six elements of the combination in ways in which no other nipple ever co-operated before. They have explicitly described the new interactions between the parts, including, for example, the necessary coactions of the headed nipple in cocking and resetting the piston mechanism of the coupler. They have made it clear that the five elements comprised within the coupler could not automatically effect a mechanical gripping or automatically effect an end seal, except as a result of the action of the headed nipple in first putting the gripping and sealing mechanism in position and condition for the performance of those functions. have pointed out that the action of the grease compressor in automatically effecting the operation of the gripping mechanism and automatically effecting the operation of the sealing mechanism, involves a new function never experienced by any grease compressor prior to the advent of the Butler invention.

We are satisfied that this Court will find it necessary under the authorities to join the lower courts in reaching the conclusion that every one of the seven elements of Butler's claim 2 was necessary to the achievement of the new and unitary result. We are satisfied that this Court will join the lower courts in reaching the conclusion that Butler was entitled under the patent statutes of the United States to claim as his invention the combination of these seven elements,—all of which necessarily participated in the achievement of the one and only new and unitary result which constituted Butler's aim and object.

For the time being, we shall assume that claim 2 of the Butler patent describes a new and patentable combination of seven elements.

(5) Counsel for the petitioner urge that the respondent has violated or attempted to violate the Clayton Act. The authorities agree that violations of the anti-trust laws may not be interposed in defense of patent infringement suits. This defense was never pleaded in answer to the bill of complaint. No one adduced evidence either in support or in denial of the allegation. The allegation was not even urged in the District Court or in the Court of Appeals. It is advanced in this Court for the first time. Even if the Court were to consider the matter upon the basis of all of the evidence which was introduced with respect to all of the questions which really are in issue, we are satisfied that it must reach the conclusion that the petitioner has not violated nor attempted to violate the Clayton Act.

The Clayton Act prohibits certain contracts of lease or sale but in no wise affects the subject-matter of this action in tort. Respondent's case in no sense depends upon any contractual relationship, either expressed or implied. On the contrary, it depends solely on its patent rights and upon which rights the petitioner is alleged to have trespassed. If respondent's position as to this trespass is correct, there is nothing in the Clayton Act to prevent relief and recovery. If the respondent is wrong, that is the end of the matter, and the Clayton Act can add nothing of interest.

For the time being, we shall assume that this case in-

volves the patent laws, and that it does not involve the antitrust laws of the United States.

(6) Counsel for the petitioner urge that the respondent is equitably estopped to assert its patent rights. They urge that the Stewart-Warner Corporation has impliedly licensed the Lincoln Engineering Company to manufacture and sell the headed nipple parts of the combination of Butler's invention. The petitioner's contentions are such, however, as to mean by necessary implication that the Lincoln Engineering Company is impliedly licensed to manufacture and sell every other element and part of Butler's lubricating apparatus.

It is essential to the purchasers of Butler's lubricating apparatus that they be able to buy such assortments of the various parts as will meet their peculiar and variant needs. If, therefore, the Stewart-Warner Corporation is to do any business in manufacturing and selling the Butler invention, it must necessarily sell such assortments of the component parts as will meet the needs of its customers. If by selling such assortments as will enable its customers to grease the bearings of their widely variant machinery, the Stewart-Warner Company has by implication licensed the Lincon Engineering Company to sell the nipple parts. of the machine, then by the same procedure the Stewart-Warner Company has impliedly licensed the Lincoln Engineering Company and every one else to manufacture and sell the compressor, the cylinder, the piston and its aperture, the sealing seat, the locking jaws-all of the partsall of the mechanism which constitutes Mr. Butler's invention. If the manufacture and sale of the Butler invention in the only way in which it can be sold at all, necessarily licenses the Lincoln Engineering Company and all of the world to join competitively in the manufacture and sale of all of the several parts of the Butler lubricating apparatus.

precisely as does the owner of the Butler patent, then indeed the "patent protection" of a meritorious invention has become a poor sham.

The law, as authoritatively stated, is that defenses of estoppel and of implied license cannot be urged unless they have been pleaded. The reason is clear: If a plaintiff is to meet the defense of estoppel or of license, he is entitled to be apprised of that fact, in order that he may adduce the evidence with which to meet and avoid these defenses. In the present case the defendant's answer did not plead any estoppel; the defendant's answer did not plead any license, either express or implied. No one directed any evidence to the facts which would tend, either to establish, or to refute, the charges of estoppel and license. Neither of these defenses was urged in the District Court or in the Court of Appeals. They are here and now advanced to this Court for the first time.

For the time being, we shall assume that these defenses can neither be sustained nor entertained.

Assuming that all of the foregoing defenses should be and will be rejected, we are left with what the inventors of the United States regard as the question of paramount importance in this law suit: Is there now any such thing as contributory infringement?

If so, what constitutes a contributory infringement?

We have assumed that Mr. Butler made an invention. We have assumed that the Stewart-Warner Company purchased Mr. Butler's patent and has engaged simply in putting his invention upon the market,—simply in manufacturing and selling it. We have assumed that Mr. Butler's invention is "useful" in accordance with the statutory requirement. We have assumed that the Stewart-Warner Company's patent rights have not been abrogated by some

newly asserted but never pleaded or proven violation of the anti-trust laws. We have assumed that the Stewart-Warner Company has not impliedly, and for no consideration whatsoever, licensed the Lincoln Engineering Company and all of the world to duplicate its every act in the manufacture and sale of the Butler invention.

Even if all of these assumptions are well-founded,—as we believe them to be,—the petitioner's brief and argument still raise a question which in its essence is simply this: whether there may be any such thing as a contributory infringement of a United States patent. A correct decision of this question is of course of far wider and more general importance than a decision as to the validity or scope of any particular patent.

If, even upon all of our assumptions, there has been, as counsel for the petitioner contend, no contributory infringement of the Butler patent in suit, then the inventors of the United States will be interested to learn what, if anything, would or could constitute a contributory infringement of any patent whatsoever.

The Petitioner's Theory Would Abolish All of the Law of Joint Liability for the Tort of Patent Infringement, and Would Destroy the Practical Value of the Vast Majority of Patents.

The patent statutes promise the protection of the patent laws to any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter.

The vast majority of patents fall under the classification of "machine."

Section 4888 of the statutes (U. S. C. Title 35, Sec. 33) requires that the patentee "shall particularly point out and distinctly claim the part, improvement, or combination

which he claims as his invention or discovery." Almost every new and patentable machine comprises simply a new "combination" of separately old elements,—old levers, old cams, old gears, old cranks, old connecting rods, old spindles, old plates, old what-nots. The vast majority of patents, therefore, necessarily claim simply new "combinations" of old elements. (Can any one think of any new and patentable machine which in its final analysis comprises anything other than a new combination of old elements?)

If the Lincoln Engineering Company is free to sell the headed nipple of the Butler combination, then why should not the Lincoln Sales Company be free to sell the cylinder of the coupler? Why should not the Lincoln Manufacturing Company be free to sell the piston? Why should not the Lincoln Products Company be free to sell the sealing seat? Why should not the Lincoln Lubrication Corporation be free to sell the locking jaws? Why should not the Lincoln Grease Gun Company be free to sell the lubricant compressor? Each of these elements as thus described by appropriate words of the English language, is separately old and well-known!

If seven different concerns may each engage in the sale of one of the seven parts of Butler's machine, why may not a galaxy of other concerns engage in the sale of all of the separately unpatented parts of every other patented machine,—leaving it only to the ultimate purchaser to fasten them together and enjoy the use of the assembled whole,—in complete disregard of the patentee?

The position which counsel for the petitioner take relative to this paramount question of contributory infringement, raises still further questions.

Why divide the sale of any patented machine into the sale of seven parts? Why not divide the machine into two halves? Neither half is or can be separately patentable?

Is John Doe free to sell the one unpatented and unpatentable half of the machine? Is Bichard Roe free to sell the other unpatented and unpatentable half of this machine? Is John Doe free to sell his half of the complete machine with the knowledge and intent that the purchaser will combine it in use with the other half which he acquires from Richard Roe? Is Richard Roe free to sell his half with like knowledge and intent? Is the purchaser of the two halves free to fasten them together and then to use the complete machine of the patent?

Is there any remedy available to the patentee? May he proceed against John Doe? Against Richard Roe?

Or must he proceed only against the ultimate user, who for the first time joins together the two halves to make the complete whole which is necessarily described in the patent claim?

The petitioner's contentions necessarily mean that quite regardless of the patentee's conduct in the use which he attempts to make of his patent, John Doe and Richard Roe are free to do these things and the patentee may never, under any circumstances, have any relief against them.

Let us assume that the ultimate user can purchase all of the several parts of the complete machine for \$1.38. Let us assume that the ultimate purchasers have brought together 6,306,000 of the complete machines. (The record shows that in three years the Stewart-Warner Company sold 6,306,000 complete installations of the Butler lubricating equipment. R. p. 40.) Is it the sole remedy of the patentee, quite regardless of his own conduct in and about his business under his patent, to proceed against the ultimate user who buys and assembles the requisite parts of a complete machine at a total cost of \$1.38? Is the patentee relegated to recovery of profits or damages in separate proceedings against 6,306,000 ultimate users of his invention?

These are some of the questions which plague the minds of the patentees who await the decision of this Court in answer to the main contention of the petitioner herein.

The reason is that counsel for the Lincoln Engineering Company are asking this Court to tell the petitioner and all of the world that the Lincoln Engineering Company is not guilty of contributory infringement.

The Stewart-Warner Corporation first put the invention of the Butler patent upon the market in April, 1933. From that time to this, its sole business has been to manufacture and sell the whole of the invention of the Butler patent in suit. There have been no attempted license restrictions, no tying clauses, no understandings, no limiting contracts, no license notices no sales of materials or supplies or parts involving either express or implied licenses. There has been nothing other than the plain, old-fashioned, and straightforward making and selling of the whole of the very thing described and claimed in the patent in suit.

Shortly prior to the advent of the Butler invention upon the market in April, 1933, the Lincoln Engineering Company had embarked upon an effort to devise a complete lubricating apparatus of its own.

There is no contention that this apparatus, first devised and sought to be sold by the Lincoln Company involved any infringement of the Butler patent. For eighteen months after the commercial advent of the plaintiff's Alemite Hydraulic equipment of the Butler patent, the Lincoln Company struggled to sell its wholly different and non-infringing lubricating apparatus,—but without success. Finally, in November, 1934, eighteen months after the advent of the Butler invention upon the market, the Lincoln Company made such changes as to incorporate a nipple having a head and a shoulder appropriate to coact and to cooperate perfectly and particularly with the other parts

of the Butler apparatus as manufactured and sold by the Stewart-Warner Company. These changes were made for the very purpose of adapting the Lincoln nipple for use in the Butler combination.

This new "headed nipple" of the Lincoln Company never existed in all of the history of the world until eighteen months after the apparatus of the Butler patent had first been put on the market in April, 1933. It was not an old thing. It was a new thing. It was a new thing designed, manufactured, and sold especially for the very purpose of becoming a part of the Butler combination as described in claim 2 of the Butler patent, and as manufactured and sold by the Stewart-Warner Corporation.

It had all of the details of precise shape, form, and dimensions requisite to bring about the necessary coactions with the other parts of the complete combination as manufactured and sold by Stewart-Warner.

Neither the precise shape nor form nor dimensions which the Lincoln Company gave to these headed nipples did have or could have any utility in connection with any of the other possible uses which the Lincoln Company began industriously to pretend to concoct for it. The Lincoln Company's headed nipples never had any existence whatsoever,—never had any utility whatsoever—until eighteen months after the advent of the Butler invention upon the market. It was a wholly new thing especially devised for the sole purpose of becoming a part of the Butler invention as theretofore manufactured and sold by the Stewart-Warner Company.

It is all well and good for the petitioner to assert that "headed nipples" were old and well-known. The fact remains that never in the history of the world prior to the commercial advent of the lubricating appartus of the Butler patent in April, 1933, was there a headed nipple or a nipple

of any kind whatsoever which ever has been used or which ever can be used as one of the seven component elements of the Stewart-Warner Company's version of the Butler invention.

Other patentees have put and will put their inventions on the market. What will happen to them after they have enjoyed eighteen months of successful manufacture and sale of these other inventions? Will the Lincoln Engineering Company step in and begin the manufacture and sale of any or all of the special component parts of these other inventions? Is the Lincoln Engineering Company free to ruin the business of every patentee simply because the several special parts of the complete inventions of these other patentees, when described by appropriate words, may be asserted by the Lincoln Engineering Company to be, in some remote and generic sense, "separately old and unpatentable"?

Such questions as these are raised by the interpretation which counsel for the petitioner put upon the decisions of this Court in the more or less recent Dry Ice case, the Barber Asphalt case, and the case of Rogers v. Alemite.

The inventors of the United States are interested to learn whether the petitioner correctly interprets and applies these decisions.

In Each of the Following Cases, the Defendant's Sale of an Unpatented Article, With the Knowledge and Intention That It Be Employed in the Construction of a Patented Combination or in the Use of a Patented Process, Was Held to Constitute a Contributory Infringement.

Obviously, if the articles sold by these defendants had been separately patented, then the defendants would have been liable as direct infringers. There would have been no opportunity or occasion for the charge of contributory infringement.

Wallace et al. v. Holmes et al., 9 Blatchf., 65; 29 Fed. Cas. No. 17,100. (C. C. D. Conn., Sept. 19, 1871, Woodruff, D. J.)

Richardson v Noyes, 20 Fed. Cas., No. 11, 792. (C. C. D. Mass., Sept. 1, 1876, Lowell, D. J.)

Bowker v. Dows, 3 Fed. Cas., No. 1,734. (C. C. D. Mass., Oct. 9, 1878, Lowell, D. J.)

Holly v. Vergennes Machine Co., 4 Fed. 74, 77, 82. (C. C. D. Vet., Oct. 5, 1880, Wheeler, D. J.)

American Cotton Tie Co. v. Simmons, 106 U. S. 89, 93-95; 27 L. Ed. 79, 80, 81. (Appeal from C. C. D. R. I. reversing 1 Fed. Cas. No. 293—Nov. 6, 1882, Blatchford, Justice.)

Schneider v. Pountney, 21 Fed. 399, 402, 403. (C. C. D. N. J., Aug. 30, 1884, Nixon, D. J.)

Travers v. Beyer, et al., 26 Fed. 450. (C. C. N. D. N. Y., Jan. 28, 1886, Wallace, D. J.)

Schneider v. Missouri Glass Co., 36 Fed. 582, 583, 584. (C. C. E. D. Mo., Oct. 31, 1888, Thayer, D. J.)

Stearns et al. v. Phillips et al., 43 Fed. 792, 795. (C. C. E. D. Mich., July 7, 1890, Brown, D. J.)

Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co., 75 Fed. 1005, 1007, 1008, 1010. (C. C. A. 2, July 29, 1896, Shipman, C. J.)

Thomson-Houston Electric Co. v. Ohio Brass Co., et al., 80 Fed. 712, 713, 720-722, 730. (C. C. A. 6— May 17, 1897—Taft, C. J.)

New York Filter Mfg. Co. v. Jackson, 91 Fed. 422, 425, 426. (C. C. E. D. Mo., E. D., Dec. 27, 1898, Adams, D. J.)

German-American Filter Co. of New York v. Loew Filter Co., et al., 103 Fed. 303. (C. C. N. D. Ohio, E. D., June 30, 1900, Day, C. J.)

- John R. Williams Co. v. Miller, DuBrul & Peters Co., 107 Fed. 290, 293. (C. C. S. D. N. Y., Feb. 4, 1901, Wheeler, D. J.)
- Rumford Chemical Works v. New York Baking Powder Co. et al., 136 Fed. 873. (C. C. S. D. N. Y., Jan. 3, 1905, Lacombe, C. J.)
- Johnson, et al. v. Foos Mfg. Co., 141 Fed. 73-75, 85, 87, 88. (C. C. A. 6, Nov. 29, 1905, Lurton, C. J.)
- Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 Fed. 266, 274-275. (C. C. E. D. Wis., June 2, 1906, Quarles, D. J.)
- Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 325, 332, 333, 337; 53 L. Ed. 816, 819, 820, April 19, 1909, McKenna, Justice. (On certiorari to C. C. A. 2, affirming 154 Fed. 58.)
- Victor Talking Mach. Co. v. Duplex Phonograph Co., 177 Fed. 248. (C. C. W. D. Mich., S. D., May 27, 1909, Knappen, D. J.)
- Parsons Non-Skid Co. v. Seneca Chain Co., 192 Fed. 46. (C. C. S. D. N. Y., Nov. 18, 1911, Lacombe, C. J.)
- Acme Acetylene Appliance Co. v. Commercial Acetylene Co., 192 Fed. 321-323, 329. (C. C. A. 6, Dec. 5, 1911, Warrington, C. J.)
- Woodward Co. v. Hurd, et al., 232 U. S. 428; 58 L. Ed. 671, 672. (Feb. 24, 1914, Hughes, Justice.)
- Consolidated Rubber Tire Co. v. Diamond Rubber Co., 226 Fed. 455, 461, 462. (D. C. S. D. N. Y., July 22, 1915, L. Hand, D. J.) Affirmed, 232 Fed. 475.
- Solva Waterproof Glue Co. et al. v. Perkins Glue Co., 251 Fed. 64, 73. (C. C. A. 7, Jan. 2, 1918, Kohlsaat, C. J.)
- Barrett, et al. v. Sheaffer, 251 Fed. 74, 79. (C. C. A. 7, Jan. 2, 1918, Kohlsaat, C. J.)

- Dental Co. of America v. S. S. White Dental Mfg.
   Co., 266 Fed. 524. (C. C. A. 3, July 10, 1920, .
   Woolley, C. J.) Affirming 263 Fed. 719.
- Jockmus v. Gale & Co., 295 Fed. 208, 212. (D. C. D. Conn., Dec. 14, 1923, Thomas, D. J.)
- Belknap et al. v. Wallace Addressing Mach. Co., Inc., 12 Fed. (2d) 597. (C. C. A. 2, Apr. 5, 1926, Per curiam.)
- American Stainless Steel Co. v. Ludlum Steel Co., 16 Fed. (2d) 823, 824. (D. C. S. D. N. Y., Feb. 4, 1926, Thacher, D. J.)
- Westinghouse Electric & Mfg. Co. v. Precise Mfg. Corp., 11 Fed. (2d) 209, 212. (C. C. A. 2, March 8, 1926, Manton, C. J.)
- Electro Bleaching Gas Co. et al. v. Paradon Engineering Co., Inc., 12 Fed. (2d) 511, 512, 513. (C. C. A. 2, May 17, 1926, Hough, C. J.)
- General Electric Co. v. De Forest Radio Co., 28 Fed. (2d) 641, 648. (C. C. A. 3, Sept. 18, 1928, Woolley, C. J.)
- Trico Products Corporation v. Apco-Mossberg Corporation, 45 Fed. (2d) 594, 599. (C. C. A. 1, Nov. 26, 1930, Wilson, C. J.)
- Graham Paper Co. v. International Paper Co., 46 Fed. (2d) 881, 882, 885, 886, 887. (C. C. A. 8, Feb. 17, 1931, Kenyon, C. J.)
- Naivette, Inc. v. Bishinger, et al., 61 Fed. (2d) 433. (C. C. A. 6, Oct. 12, 1932, Simons, C. J.)
- Activated Sludge v. Filtros, Inc., 10 Fed. Supp. 241. (D. C. W. D. N. Y., Mar. 23, 1935, Rippey, D. J.)
- Philad Company v. Modernistic Permanent Wave Mach. Co., 31 U. S. P. Q., 13. (Apr. 9, 1936, Molyneaux, D. J.)

Fehr, et al. v. Activated Sludge, Inc., 84 Fed. (2d) 948, 949, 957. (C. C. A. 7, June 24, 1936, Sparks, C. J.)

Bundy Incubator Co. v. George Cugley, et al., 30 U. S. P. Q., 340. (Aug. 12, 1936, Raymond, D. J.)

Aero Neck-Band & Collar Co., Inc., et al. v. Fenway Fabrics, Inc., 19 Fed. Supp. 846, 849, 850, 851. (D. C. S. D. N. Y., June 22, 1937, Woolsey, D. J.)

If the petitioner's interpretation of the recent decisions of the Supreme Court are correct, then all of the Courts in all of the foregoing cases were wrong in holding the defendants liable as contributory infringers.

The Four Supreme Court Cases Out of Which the Petitioner Endeavors to Spell a Practical Abolishment of the Law of Joint Torts as Applied to the Tort of Patent Infringement.

On page 58 of their brief, counsel for the petitioner list the decisions of this Court in the *Leeds & Catlin* case, the *Dry Ice* case, the *Barber* case, and the *Rogers* case, and then formulate the conclusion based upon their understanding of these cases that,

"While the theory of contributory infringement may be applicable to prevent a defendant from appropriating the patentee's actual contribution to the art, as in the Leeds & Catlin case, it is entirely inapplicable to prevent a defendant from using things long old in the art as in the Carbice, Leitch and Rogers cases."

<sup>\*</sup> Even if this sentence correctly summarized these recent decisions of the Supreme Court, it would not serve to overrule the concurring decisions of the lower courts in the instant case, (1) partly because the defendant, Lincoln Engineering Company, does not "use" the things complained of,—it sells for use by others in the combination which constitutes Mr. Butler's invention; and (2) partly because the particular headed nipples sold by the defendant were not "long old in the art",—they never existed until more than a year after the Butler invention was put on the market, whereupon they were then first especially designed and made with the definite knowledge and intention that they were to be used in the Butler combination, and with the knowledge that their special details had no other utility, no other reason for being.

Quite aside from the fact that counsel's stated summary of the law to be derived from these recent decisions of the Supreme Court would not relieve the defendant from the charge of contributory infringement in the instant case, still it will be well worth while, we think, to determine whether or not counsel for the petitioner have correctly understood and interpreted these recent decisions.

The Petitioner's Theory Means Necessarily That Every Infringement Must Be a Complete and Direct Infringement,—That There Can Be No Such Thing as a Contributory Infringement.

If counsel for the petitioner do correctly interpret the recent decisions of this Court, there cannot be such a thing as contributory infringement,—in any practical or realistic sense. This is for the reason that if "the patentee's actual contribution to the art" is to be determined in the manner in which counsel for the petitioner would determine it, there would not ordinarily be any particular piece or part of the whole invention which could be designated as that in which the crux or essence of the invention specially inhered. Almost all inventions, more particularly all machine or apparatus inventions, necessarily involve merely new combinations of old elements. The classic definitions of a patentable combination are those of Leeds & Catlin v. Victor. In 213 U. S. 301, 318, this Court said, by Mr. Justice McKenna:

"A combination is a union of elements, which may be partly old and partly new or wholly old or wholly new. But, whether new or old, the combination is a means—an invention—distinct from them. They, if

<sup>\*</sup>The Court is doubtless aware of the many different and conflicting views which lawyers and courts have expressed relative to the real ground and meaning of your Honors' decision in the Carbice case. The more recent decision in the case of Leitch v. Barber has engendered further controversy and discussion.

new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same

patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To become that they must be united under some corporative law. Certainly, one element is not the combination, nor, in any proper sense, can it be regarded as a substantive part" (i. e., the essential part, or, as it is sometimes called, the "gist") "of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination, an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of the patent laws. It is in accordance with the policy of Section 4887 of the Revised Statutes, which is urged against it."

Perhaps even more pointed in respect of the present discussion is the definition of a patentable combination as stated in the opinion of the Court in the second Leeds & Catlin case, 213 U. S. 325, 332, where Mr. Justice McKenna said:

"A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or non-infringement of a combination that one of its elements or all of its elements are unpatented. In other words, the fact that the disc sold by petitioner . is unpatented does not affect the questions involved except to give an appearance of a limitation of the rights of an owner of a Victor machine other than those which attach to him as a purchaser."

Section 4888 of the Revised Statutes (U. S. C. Title 35, Sec. 33) expressly provides that the patentee shall claim the "combination which he claims as his invention."

If now an inventor may patent and thus claim his new combination, and if his new combination is a union of elements each of which is separately old, then the only thing which the patentee can contribute to the art is the whole of that combination of old elements. To use the language of petitioner's counsel, "the patentee's actual contribution to the art," in any such case as this, is necessarily a combination of old elements. The invention cannot inhere in some one of the old parts. It cannot inhere in some two or three of the old elements. It must necessarily inhere in the whole of the new combination.

When, therefore, the patentee has invented a new combination of old elements, he cannot procure any patent except by claiming just what the statute requires him to claim as his invention, namely, the "combination." The Patent Office will not permit him to claim less. If he attempts to do so, he will be met with a rejection upon the ground that his claim is incomplete. As was said by Patent Commissioner Thatcher in *In re Farrow*, 2 O. G. 57, 1872 C. D. 148:

"If there are parts which may be optionally omitted in the construction of the device, they may also be omitted in the claim. It is only necessary that such elements be named as will constitute an operative whole, unless the novelty of the device depends upon the presence of the additional elements."

In Ex parté Jones, 343 O. G. 4, 1926 C. D. 100, the Commissioner of Patents said:

"The proposed claim 3 as rewritten is incomplete by reason of the inclusion of the expression—'means comprising contacts mounted on the walls of the cylindrical casing, whereby said lamp is connected to a source of energy when said platform is pushed into position.' Obviously, the means for connecting the lamp with the source of energy comprises something more than the contacts mounted on the walls of the cylindrical casing. It is uncertain whether the whereby clause refers to the means or to the contact. The claim is not for means for doing something, but for means for permitting something to be done. The claim is therefore indefinite or incomplete."

In Loggie v. Puget Sound, 194 Fed. 158, 164, the Court held

"that the first five claims of the complainant's patent are void for lack of utility, because, without the first section of the guide including the down presser, which is omitted from said claims, the apparatus is inefficient and impractical."

In Rapp v. Central, 158 Fed. 440, 442, the Court said:

"The elements of claim 1, without the lips or other means for engaging the parts and connecting them together, would be an incomplete and inoperate (ive) and useless structure. In fact, no structure at all, but simply pieces of metal. We must read into it some means for connecting the various parts. Should they be nailed to the core or filler in the usual manner of nailing, we would not have a fireproof door."

In Bliss v. Brooklyn, 3 Fed. Cas. 707 (Federal Case No. 1546), the Court said:

"In the one combination, no lug appears, and no · practical result is attained. The introduction of the lug, for the first time, produced a combination which accomplished any useful result. An added element, which increases the efficiency of a combination, of itself effective, is of the nature of improvement; but, when the added element essential to the production of any result, such an addition is not an improvement, but its use gives birth to the only patentable, because the first useful, combination. Notwithstanding, then, the conceded fact, that the combination which includes the lug with other elements which are described in the reissue of 1869, is useful, it is, nevertheless, necessary, in order to sustain the reissue, that it should appear that the device there described, which does not contain the lug, is of some utility. As before stated, the contrary here appears, and, for this reason, the patent must be declared invalid."

There is no logical sense in which it can be said that something less than the whole of a new and patentable combination constitutes the "gist" of the invention. As was said in the opinion of the Sixth Circuit Court of Appeals in

the case of Automotive Parts Co. v. Wisconsin Axle Co., 81 Fed. (2d) 125, 126:

"The invention is for a composite thing, embracing several elements or parts, all of which are necessary to and co-operate in the operation of the patented unit. We cannot subscribe to the view that the test of contributory infringement in the furnishing of parts for a combination invention is whether the parts furnished constitute the gist or essence of the invention; indeed, we cannot see how it may be said that any one element or another marks the advance step or is the essence of such an invention. There are cases, it is true, in which the phrase 'essence of the invention' is used; but in our view, when the facts in those cases are considered, it cannot be said that the conclusions reached were the result of a logical selection of one or more elements of the combination as the gist or essence of the invention."

In the case, therefore, of any patentable invention comprising a new combination of old elements, "the patentee's actual contribution to the art" is that very combination, the whole of it,—nothing less.

According to the petitioner's interpretation of the recent decisions of this Court, there could therefore never be any such thing as a contributory infringement of such a patent. The making or using or selling of "the patentee's actual contribution to the art" would necessarily involve the making or the using or the selling of the complete union or composition or combination of old elements. The making or the using or the selling of any one of the old elements would not involve the making or the using or the selling of "the patentee's actual contribution to the art." The same would be true of the making or using or selling of any two or three of the elements of the complete combination. The making or selling of any number of old elements less than the total number of the elements of the composite whole, would not involve the sale of "the patentee's actual contribution to the art."

If any defendant were to make or to use or to sell the entire combination, i. e., "the patentee's actual contribution to the art," then he would be guilty of complete and direct infringement. He could be prosecuted as "an infringer." There would be no occasion to proceed against him as "a contributory infringer." He would not indeed be a contributory infringer. He would be simply an infringer.

Whenever a person sells one (or some only) of the several elements of a combination claim with the knowledge and intention that the purchaser will combine them for use with the other elements of the combination, he is engaged in what may be stated to be merely the sale of unpatented parts or elements. When these parts or elements are described as they necessarily must be described in a patent claim by the use of mere words, then it can generally be said that each of the parts of elements is in and of itself not only unpatentable but "old". The connecting rod of a new combination must have certain length and breadth and various details of conformation,-otherwise it will not cooperate with the cross head and the crank,-it will not fit into the combination of which it is a part. Nevertheless, the mere words of a patent claim may appropriately describe it as a connecting rod. Counsel for the petitioner would say in such a case that the connecting rod is merely a "thing long old in the art."

It is their contention that when each and every element of a combination patent claim is capable in the above sense of being described as something separately unpatentable,—something "long old in the art," then anybody and everybody is free to make and to sell it. They say that anybody and everybody is free to make and sell it with the knowledge and intent that the purchaser will combine it with the other "old" elements of the new and patented combination, thereby leaving it for the purchaser merely to bolt or otherwise

fasten the parts together. Counsel for the petitioner say that this is the position of this Court, as arounced in its recent decisions. The criterion, according to counsel for the petitioner, is whether or not the party who manufactures and sells one or more of the several parts of the whole has furnished what may be termed "the patentee's actual contribution to the art."

This cannot be the test.

This cannot be the criterion.

We do not believe that this Court is attempting to say in any one decision or in all of its decisions, that such is the criterion. Certainly this Court has not as yet said that the test of contributory infringement is to be found simply in an answer to the question whether those words of a patent claim which describe the defendant's contribution to the whole, can be said to describe also some other thing which in and of itself is unpatented or which can be found in the prior art.

We cannot believe that it is the purpose or desire of this Court to accept and apply the petitioner's formula for determining a defendant's liability or non-liability as a contributory infringer. It was with respect to this formula as urged by counsel for the petitioner that the Seventh Circuit Court of Appeals said in its opinion in the instant suit:

"While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that Bassick Mfg. Co. v. R. M. Hollingshead, supra, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. announced a court rule in sick case, as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the

validity of patents, then Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 301, is overruled. However, instead of stating that the Leeds & Catlin opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

"Until and unless there is an express repudiation of the Leeds & Catlin Co. v. Victor Talking Machine Co. case, we cannot accept the Bassick Mfg. Co. v. R. M. Hollingshead opinion as being inconsistent with the views stated in the former opinion." (91 Fed. (2d) 757, 760, 761; R. p. 633, 634, 635.)

There are two reasons why the test of contributory infringement as formulated by counsel for the petitioner, allegedly upon the basis of the recent decisions of this Court, would revolutionize and practically destroy the law of patents:

(1) If anybody and everybody is free to make and sell one element or two elements or anything less than all of the elements of a patented combination, without regard to the intention or purpose with which these separately old and unpatented elements are thus sold, then anybody and everybody else will be equally free to sell each and all of the other parts of that combination. If no such contributor can be held liable as a contributory infringer, then the patentee's remedy will necessarily be limited to suits or actions against the ultimate users who bring the several parts together to form the unitary whole of "the patentee's actual contribution to the art."

As was said by Odin B. Roberts in his article on "Contributory Infringement of Patent Rights," in Vol. XII, No. 1, of the April, 1898 issue of the Harvard Law Review, page 35,

"There is always, nominally at least, a clear remedy for the patentee by suit against the immediate infringers whose acts are punishable by injunction, whether or not any actual intent to infringe existed. In many cases, however, such a remedy is wholly inadequate. A manufacturer who distributes thousands
of infringing machines is the only defendant against
whom the patentee can obtain real relief; for, as against
the purchaser and user, a suit in equity could not reimburse the patentee for the unavoidable expenses of his
suit; the courts recognize the existence of this state
of things, and in cases of contributory infringement
assist the patentee, so far as possible and proper, in
his attempt to stop the trespass at its origin rather
than compel him to take a course which practically opposes an impossibility to his effort toward establishing
or enforcing his right."

If a valid and enforceable patent cannot be had upon a new combination of old elements, all of which cooperate and coact in new ways to effect the accomplishment of a new and unitary result, then there are few valid patents in existence, there can be but few valid patents in the future. The reason is that almost every new invention involves simply a new combination of old elements. the case of such a new combination of old elements, it is logically and practically impossible to select any one element or any smaller group of elements and to say that "the patentee's actual contribution to the art" inhered in this one element or in this lesser group of elements. If a patentee attempted to select and claim any one element of his combination, he would be met by the fatal objection that in and of itself the one element was old and well-known, and by the objection that he had failed to claim anything which would meet the test of usefulness. If it were possible to select and to claim in a patent, the one element or the lesser group of elements representing, as petitioner's counsel would have it, "the patentee's actual contribution to the art." then there would indeed be no need of any doctrine of contributory infringement, because, forsooth, the making or selling of the one supposedly gist-like element would constitute a complete and direct infringement.

We respectfully submit that if there is any such thing as contributory infringement, then the criterion of such contributory infringement is not to be found in the formula which counsel for the petitioner say that they have derived from the recent decisions of this Court.

Counsel for the petitioner do not, of course, say in so many words that there is no such thing as contributory infringement. Nevertheless, as we have seen, their proposed test of contributory infringement is such that there cannot be any such thing as contributory infringement, either logically or practically.

It Is Impossible to Derive the Petitioner's Formula of So-Called Contributory Infringement From Anything and Everything Which the Supreme Court Has Said.

We are not, however, satisfied to rest the matter upon the demonstrated impossibility of applying any such formula as that advanced by counsel for the petitioner. We should like in the first place to show that the decisions of this Court do not state or rely upon any such formula as that advanced by the petitioner. We should like to show that it is impossible to derive the petitioner's formula from anything and everything which the Supreme Court has said.

We hope that we may without presumption indicate what we believe to be the law under the very decisions to which counsel for the petitioner refer, and upon which the defendant claims freedom from liability.

The Very Decisions of This Court Upon Which the Petitioner Relies, Expressly Recognize That There Still Is Such a Thing as Contributory Patent Infringement.

In the Carbice Case, 283 U.S. 27, 34, this Court said:

"The case at bar is wholly unlike Leeds & C. Co. v. Victor Talking Mach. Co., 213 U.S. 325, 333, 53 L. ed.

816, 819, 29 S. Ct. 503, on which plaintiffs rely. That was an ordinary case of contributory infringement. The Victor Company sold machines embodying a patent for a combination. Leeds & Catlin were held to be infringers because the intended incorporation in the Victor machines of the article which they sold, did not constitute a repair of the machine and hence was not within the license implied on sale. Heyer v. Duplicator Mfg. Co., 263 U.S. 100, 68 L. ed. 189, 44 S. Ct. 31. There was no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.' In the case at bar the plaintiffs neither sell nor license others to sell complete transportation packages. They supply merely one of the several materials entering into the combination; and on that commodity they have not been granted a monopoly. Their attempt to secure one cannot be sanctioned."

Again, in the case of Bassick v. Hollingshead, 298 U. S. 415, 425, this Court again recognized and distinguished the contributory infringement of the Leeds & Catlin case, saying:

"Leeds & C. Co. v. Victor Talking Mach. Co. 213 U. S. 301, 325, 53 L. ed. 805, 815, 29 S. Ct. 495, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination."

In Leitch v. Barber, 82 L. Ed. 276, 278, the Court said again that

"Nothing in Leeds & C. Co. v. Victor Talking Mach. Co. 213 U. S. 325, 53 L. ed. 816, 29 S. Ct. 503, limits it," i. e., the rule declared in the Carbice case.

The Dick Case, 224 U.S. 1, 56 L. Ed. 645, 32 Sup. Ct. Rep. 364, was expressly overruled in the Motion Picture Patents Case, 243 U.S. 502, 61 L. Ed. 871,

If it has been the intention of the Court to overrule the Leeds & Catlin Case, we believe that the Court would have said so. No one contends that the Leeds & Catlin case has been expressly overruled. Nevertheless, counsel for the petitioner take the position that the principles of the Leeds & Catlin case have in effect been overruled.

We do not think so.

## The Infringement of a Patent Is a Tort; a Contributory Infringer Is a Joint Tort Feasor.

Section 4884 of the Revised Statutes, U. S. C. Title 35, Patents, Sec. 40, provides that

"Every patent \* \* shall contain \* \* a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention \* \* throughout the United States and the territories thereof \* ."

Any violation of this exclusive right is a tort. It will probably be conceded that patent infringement is a tort. It was so regarded in the opinion in the Carbice Case, 283 U. S. 27, 33. There Mr. Justice Brandeis said:

"Infringement, whether direct or contributory, is essentially a tort, and implies invasion of some right of the patentee."

The same view was applied by the Seventh Circuit Court of Appeals in the instant case. In his opinion, Judge Evans said:

"In dealing with this subject of contributory infringement, it might be observed that we are dealing with a phase of the general subject of torts. An infringer is a tort feasor. A contributory infringer is one whose action contributes to the infringement." (91 Fed. (2d) 757, 763.) (R. p. 638.)

Contributory infringers have always been regarded as joint tort feasors. In discussing the matter of joint tort

feasors, Professor Cooley, in his work on torts, says, in Vol. I, sec. 75, page 238 (4th Ed.):

"What Constitutes Participation. Most wrongs may be committed either by one person or by several. When several participate, they may do so in different ways, at different times, and in very unequal proportions. One may plan, another may procure the men to execute, others may be the actual instruments in accomplishing the mischief, but the legal blame will rest upon all as joint actors."

"What Constitutes a Joint Wrong or Joint Liability. All who actively participate in any manner in the commission of a tort, or who command, direct, advise, encourage, aid or abet its commission, are jointly and severally liable therefor. 'All who aid, advise, command or countenance the commission of a tort by another, or who approve of it after it is done, are liable, if done for their benefit, in the same manner as if they had done the act with their own hands; ""."

There is no good reason why joint tort feasors should not be held liable in connection with the tort of patent infringement, just as in the case of all other torts, such, for example, as trade-mark infringement, unfair competition, copyright infringement, misappropriation of secret profits in fraud cases, assault and battery, alienation of affections, trespass for the injury of property, etc.

We respectfully submit that in the cases of Leeds & Catlin, Carbice, Leitch, and Rogers (petitioner's brief, page 58) the rule as to the liability of joint tort-feasors was accepted as a matter of course. The question was, whether the plaintiffs, by their conduct in respect of their use of the patents in suit, had disentitled themselves to relief. Relief was denied in two of the cases solely upon the ground that the plaintiffs had forfeited any right to relief because of their misuse or abuse of what otherwise might have been their patent rights.

The Cases of Rogers vs. Alemite and Bassick vs. Hollingshead Turned Upon Questions of Validity and Proof of Direct Infringement, and Did Not, Therefore, Involve the Determination of Any Question of Contributory Infringement.

Let us turn now to the four Supreme Court cases out of which petitioner's counsel endeavor to spell an immunity for the Lincoln Engineering Company.

Rogers v. Alemite and Bassick v. Hollingshead, 298 U. S. 415.

In these cases the plaintiff sought to establish the liability of the defendants as contributory infringers.

In the Hollingshead Case, the Court Found That the Parts Furnished by the Hollingshead Company Did Not Embody the Suction Effect Coupler Claimed in the Gullborg Patent in Suit.

In the Hollingshead case the court found claims 1 to 6 and 8 and 10 of Gullborg patent No. 1,307,734 to be valid because the patent disclosed novelty and invention in the combination which included a movable perforated cupshaped disk or washer in the barrel of the coupler held by a spring against the orifice of the coupler, which disk on being forced forward by its spring as the coupler was removed, caused a vacuum which drew in any lubricant that would otherwise adhere about the orifices of the fitting and the coupling.

The plaintiff's charge of contributory infringement was based on the contention that the compressor and coupler parts which had been sold by the defendant had this construction and mode of operation. The opinion of the Supreme Court refers to the decision of the Sixth Circuit Court of Appeals, saying that

"It therefore held that the accused grease gun lacked the only novel feature of the patented combination." (page 422.)

The Supreme Court reached the same conclusion, saying:

"We are satisfied that the Circuit Court of Appeals was correct in its decision that the accused device did not embody the novel feature claimed in the patent." (page 422.)

The decision of the court in respect of these claims 1 to 10 of the Gullborg patent obviated any possible question of contributory infringement. If the defendant, Hollingshead Company, had manufactured and sold the complete combination embracing its own grease gun and coupler and also pin fittings of the kind manufactured and sold by the plaintiff, the decision of the court would have been that there was no infringement of any kind because the defendant's device did not embody the construction and mode of operation which constituted Gullborg's invention as set forth in claims 1 to 6 and 8 and 10 in suit.

The Hollingshead part of this decision by the Supreme Court does not, therefore, throw any light upon any question of contributory infringement.

In the Rogers Case, Claims 14 and 15 of the Gullborg Patent Were Held to Be an Attempted Double Patenting of Gullborg's Earlier Patent No. 1,307,733.

Let us turn now to the part of the decision which dealt with the case of Rogers v. Alemite Corporation. Here again we shall find that the decision was upon grounds which did not involve any question of contributory infringement.

The plaintiff's suit against the Rogers Company in-

volved two rather separate and distinct sets of facts and questions. Claims 14 and 15 only were involved in the one situation. Claims 1 to 6 and 8 and 10 alone were involved in the other situation.

The situation involving claims 14 and 15 only was as follows: Mr. Gullborg, the patentee of the patent in suit, had taken out a prior patent, No. 1,307,733, which described and claimed a certain novel pin fitting. This earlier patent contained claims describing this pin fitting in and of itself. In its opinion the court said that "claim 15 may be taken as typical" of claims 14 and 15; and it said that

"It will be noted that this claim describes a combination consisting of the pin fitting of Gullborg's Patent No. 1,307,733, with any grease pump having a bayonet type coupler." (page 420).

In so far as these claims 14 and 15 were concerned, it was said that the Rogers Company had sold "grease guns having a bayonet slotted coupler, which could be used with the pin fittings of Gullborg's patent No. 1,307,733." (page 423).

Of these grease guns the court said:

"The petitioner's grease guns are of an old unpatented type, having couplers of a different construction from that disclosed in the patent. There is no assertion that they produce the suction effect of Gullborg's invention." (pages 423-424).

As bearing upon the patentability of claims 14 and 15 over the earlier patent No. 1,307,733, which described and claimed the novel pin fitting only, the court found that

"The proofs establish that the prior art embraced the use in combination of a grease gun composed of a chamber or pump, a hose, a hose-coupler, and a springclosed fitting, the coupling being of the pin and slot or bayonet type."

The question in issue was stated by saying that

"The respondent's position is, nevertheless, that if the petitioners furnish a gun, a part of this old unpatented and unpatentable combination, for use with the patented pin fitting of Gullborg's No. 1,307,733, they contributorily infringe claims 14 and 15 of the patent in suit because those claims describe the combination of any grease gun with the patented pin fittings."

The court then disposed of the one situation which involved these claims 14 and 15 by holding these claims to be invalid because they attempted to secure a second patent upon the one invention which had already been described and claimed in the earlier patent No. 1,307,733.

In doing so the court said:

"It is plain that Gullborg invented improvements in two of the mechanical elements of an old combination consisting of grease gun, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such. (No. 1,307,733.) Secondly, he invented an improved form of coupler, ""' etc.

After referring to the subject matter of the other group of claims, the court then said that in claims 14 and 15 "he further claimed the combination between his patented pin fitting and any form of grease gun, whether that claimed in his patent or unpatented and old in the art." As stated by the court, the question was whether Gullborg might "in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element."

In so far as these claims 14 and 15 were concerned, the court answered the question by saying:

"We are of the opinion that the owner of the patents cannot extend the monopoly of its patent for a pin fitting" (i. e. patent No. 1,307,733) "to preclude the use therewith of any grease gun not embodying the improvement in the coupling device evidenced by the patent in suit."

It would seem quite clear, therefore, that the basis of this decision relative to these claims 14 and 15 was that

Gullborg's right to patent protection upon the pin fitting invention had been perfected in and by the earlier patent No. 1,307,733, and that the attempt to repatent this one invention in a second patent resulted merely in invalid and therefore unenforceable claims. The logic of this part of the decision would mean, therefore, that even if the Rogers Company had sold lubricating apparatus comprising Gullborg's particular form of pin fitting in combination with a prior art type of grease gun and bayonet type coupler, still the plaintiff could not have held Rogers as a direct and complete infringer under claims 14 and 15. (Presumably the plaintiff could, in these circumstances, have held Rogers as a direct infringer of the earlier patent No. 1,307,733.) The reason would be that claims 14 and 15 involved a nonpermissible attempt to repatent the one invention which had already been patented in the earlier patent No. 1,307,-733; in other words, that claims 14 and 15 were void for double patenting.

Miller v. Eagle, 151 U. S. 186; 38 L. Ed. 121. Elishewitz & Sons Co. v. Bronston, 40 F. (2d) 434 (C. C. A. 2—1930).

Lion Fastener, Inc. v. Hookless Fastener Co., 72 F. (2d) 985 (C. C. A. 3-1934).

It was necessarily, of course, part of the court's factual finding in this connection that the construction and operation of the old style grease gun and bayonet coupler of claims 14 and 15 would be unchanged, regardless whether the compressor and coupler parts be used in conjunction with the old style fitting of the pin and slot type, or whether they be used in conjunction with the new pin fitting of Gullborg's invention. The matter was described by the court as "improving one element of an old combination whose construction and operation are otherwise unchanged". (page 425).

Since the Rogers case under Claims 14 and 15 was decided upon the ground that these claims were invalid, it does not throw any light upon any question of contributory infringement.

In the Rogers Case, Claims 1-6 and 8 and 10 of the Gullborg Patent Did Not Involve a True and Enforceable Combination Because "the Construction and Operation" of the Compressor and Suction Effect Coupler Parts Were Unchanged By the Pin Fitting or the Form of Pin Fitting Associated Therewith.

It was the plaintiff's contention in the Rogers case that the defendant had infringed also claims 1 to 6 and 8 and 10 by selling certain fittings with the knowledge and expectation that the purchasers would use them in conjunction with grease guns and bayonet couplers sold by the plaintiff. As the court put it in its opinion:

"The petitioners did sell pin fittings of a type with which a grease gun of the description of Gullborg's could be used." (page 423)

In this connection it was said that "the petitioners' pin fittings are not of the type described in Gullborg's patent No. 1,307,733." (page 424) The court regarded the defendant's fitting as a "spring-closed fitting \* \* \* for use in a pin and slot or bayonet type" combination embraced in the prior art. (page 424) Relative to the plaintiff's position in respect of these fittings sold by the defendant, the court said:

"The respondent says that as pin fittings made in accordance with the prior art but susceptible of use with a gun covered by the patent in suit were sold by petitioners, these sales constituted contributory infringements of all of the claims of the patent." (i. e. Nos. 1-6, and 8 and 10.)

These claims described by the inclusion of appropriate elements, the details of the so-called "suction effect" coupler.

After saying

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and grease cup or pin fitting"

the court went on to describe the second of Gullborg's 4m-

provements, saying:

"Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting."

But the court criticized the form of Gullborg's attempted patent protection by saying that

"Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.)"

With respect to these claims also the court said:

"The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element."

The court's answer to this question was in the negative. It is important to note, however, that the question which the court answered was whether it was possible to "repatent the old combination by reclaiming it with the improved element substituted for the old element" in a case where the "construction and operation of the old combination are otherwise unchanged." "Otherwise" takes account obviously of any changes which inhere in the new element itself.

We regard the part of the paragraph appearing at the top of page 425 of the official report as relating to the "repatentability" of the old combination with respect particularly to the old style fitting whose "construction and

operation" were said to be "unchanged" by their association with the concededly new and separably patentable suction effect coupler.

The court's conclusion in this regard was that the owner of the Gullborg patents "cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting which does not infringe the fitting patent, 1,307,733, with a gun having a coupler such as that claimed in the patent in suit." (Claims 1-6 and 8 and 10 of 1,307,734.)

The reasoning of the court was plainly enough stated to be that all of the actions and coactions, i. e., the "construction and operation" of the pin fitting part of the complete combination of the prior art would be "unchanged" by the association of the old pin fitting with the new coupler instead of the old coupler of the art. As we regard it, this was simply a way of saying that because there was no new operation, no new coaction, no new function for the pin fitting part, there was no true combination in which the old style pin fitting could be properly and enforceably included. The decision passed, therefore, upon the form and enforceability of a certain type of claim in a situation where the "construction and operation" of one element was "unchanged" by its inclusion in the stated combination.

The language of the decision is that under the factual circumstances in this regard the old combination cannot be "repatented" by "reclaiming it with the improved element substituted for the old element."

The Law of Contributory Infringement Is Not Clarified by the Twelve Cases Cited in a Footnote to the Opinion in Rogers vs. Alemite.

The opinion goes on to say this, however:

"That this cannot be done is shown by numerous cases in this and other federal courts."

The index number 4 refers to a footnote listing the following twelve cases. These cases involve such widely disparate circumstances and were decided upon such widely variant grounds that it is difficult to apply them in support of the one rather clearly stated ground of the decision of the court in respect of claims 1-6 and 8 and 10 of the Gullborg patent involved in this case of Rogers vs. Alemite.

If these twelve cases were supposed to have been cited in support of any proposition stated in the opinion, it was in support of the proposition that one cannot "in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element" where the "construction and operation is otherwise unchanged." It will be found, however, that these cited cases were decided against the plaintiffs upon nine separate and distinct grounds, namely:

- (1) Double patenting: Underwood v. Gerber, 1497U. S. 224, 227, 229;
- (2) Lack of Invention: Wall Pump & Compressor Co. v. Gardner Governor Co., 28 Fed. (2d) 334, 338, 339; General Electric Co. v. Ohio Brass Co., 277 Fed. 917.; Proy Wagon Works Co. v. Ohio Trailer Co., 274 Fed. 612;
- (3) Anticipation by prior art: Heald v. Rice, 104 U. S. 737, 753; Troy Wagon Works Co. v. Ohio Trailer Co., 274 Fed. 612;
- (4) That a reissue patent was for a different invention from that of the original patent; Langan v. Warren Axe & Tool Co., 184 Fed. 720; Heald v. Rice, 104 U. S. 737, 753;
- (5) Non-infringement because defendant did not sell any part of the thing claimed in the patent in suit: Harvey Hubbell, Inc. v. General Electric Co., 267 Fed. 564;
- (6) That the patentee and purchaser and user of the patentee's machine contemplated that the purchaser might

replace quickly perishable and periodically renewed parts or supplies: Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co., 152 U. S. 425, 431, 432; Wagner Typewriter Co. v. Webster Co., 144 Fed. 405, 409;

- (7) That the defendant had been impliedly licensed by the patentee: Edison Electric Light Co. v. Peninsular Light, P. & H. Co., 101 Fed. 831;
- (8) That a patentee may not exact as the condition of a license, that unpatented materials used in connection with the invention shall be purchased only from the licensor: Carbice Corporation v. American Patents Development Corporation, 283 U.S. 27, 31, 32. (Upon a rehearing the patent in suit was held to be invalid because anticipated, 283 U.S. 420.)
- (9) That it was a violation of the Clayton Act for the Radio Corporation to require its licensees to purchase radio tubes from it alone for inclusion in sets licensed under Radio Corporation circuit patents as initial equipment: Radio Corporation v. Lord, 28 Fed. (2d) 257.

It would seem clear from everything that is said in the opinion of the court in the Rogers case that the case was decided upon grounds other than that of contributory infringement,—the liability of a joint tort-feasor.

Everyone must concede that one thing at least is clear from the decision of the court in the Rogers case, namely, that it did not attempt to make any exception relative to the tort of patent infringement from the more general and widely recognized law applicable to joint tort-feasors. The tort of patent infringement was not exempted from the more general and widely applied principles.

It is clear that it was not intended to abolish the law relative to contributory infringement, because in referring to the cases of Leeds & Catlin v. Victor, 213 U.S. 301 and 325, the court did not say that the decision in Leeds & Catlin

Case was overruled. On the contrary, the court distinguished this case and by inference approved and affirmed it, saying:

"Leeds & C. Co. v. Victor Talking Mach. Co., 213 U. S. 301, 325, 53 L. Ed. 805, 815, 29 S. Ct. 495, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination." (Emphasis ours.)

We shall come later to a consideration of claim 2 of the Butler patent in respect of its describing a patentable combination as distinguished from an unpatentable aggregation. The District Court and the Court of Appeals have referred to the many reasons why claim 2 of the Butler patent is for a true and patentable combination in which all of the elements, including the headed nipple element, have quite markedly changed operations,—new actions, new coactions, new functions, because of their incorporation in the new combination.

For the purposes of our present discussion of the law of contributory infringement, we have asked the court to assume with us that the Butler patent is not of the Gullborg type in which the patentee "by improving one element of an old combination whose construction and operation are otherwise unchanged" sought to repatent the old combination by reclaiming it with the improved element substituted for the old element. Let us continue our assumption that the new cooperation, the new coactions, the new functions, of all of the elements of the Butler combination, are such as to have given Butler a validly patentable and enforceable claim.

Upon the basis of this assumption, let us examine into the other cases which counsel for the petitioner rely upon at page 58 of their brief. A Brief History of the Restrictions and Attempted Monopolies in Well-Known and Staple Articles of Commerce Leading Up to the Decisions in the Carbice Case and in the Barber Asphalt Case.

The author of one of the notes at page 298 of the Harvard Law Review, Volume XXXI, No. 2, for December 1917, discusses particularly the then recent decision in the *Motion-Picture Patents Case*, 243 U. S. 502, 61 L. Ed. 871, and in leading up to his consideration of that case says:

"RIGHT OF A PATENTEE TO RESTRICT THE PRICE AND THE USE OF A PATENTED ARTICLE.—At common law any attempt to restrict the use or price of a chattel by notice to the purchaser or sub-purchaser was held void as contravening the public policy in favor of the free

alienation of chattels.

"The Patent Act grants to the patentee the exclusive right to 'make, use, and vend' the article patented. It has been contended that this monopoly granted to the patentee takes the patented article out of the general common law rule, and that the exclusive right to use and to vend enables the patentee, indirectly, by a license arrangement to restrict the use and the price of his patented article by a mere notice attached thereto, and that any use or sale of the article in violation of the license constitutes an infringement of the patent. Since a suit for infringement of a patent right is a suit arising under the patent laws of the United States the federal courts have exclusive jurisdiction in these cases.

"Several decisions in the lower federal courts upheld this position as to price restrictions, and the United States Supreme Court in Bement v. National Harrow Co. (180 U. S. 70, 22 Sup. Ct. Rep. 747) seemed also to commit itself to this view. But that court definitely decided in Bauer v. O'Donnel (229 U. S. 1, 33 Sup. Ct. Rep. 616; affirmed, Straus v. Victor Talking Machine Co., 37 Sup. Ct. Rep. 412) that the mere fact that an article is patented does not give to the patentee

the right to restrict its price on resale.

"As to use two general types of restrictions have been submitted to the courts for consideration. The first is a restriction which regards the use of the patented article only. Such restrictions have been upheld

in the lower federal courts, and at least in one case by the Supreme Court. The second type is a restriction on the article primarily with reference to its use with non-patented accessories and seeks to confine its use to accessories specified by the patentee. This sort of restriction was first upheld in the lower federal courts in Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., (77 Fed. 288) which was followed by a long line of decisions in accord. (Tubular Rivet and Stud Co. v. O'Brien, 93 Fed. 200; Cortelyou et al. v. Lowe, 111 Fed. 1005; Rupp and Wittgenfeld Co. v. Elliott, 131 Fed. 730; A. B. Dick Co. v. Milwaukee Specialty Co., 168 Fed. 930; Crown Cork and Seal Co. v. Brooklyn Bottle Stopper Co., 172 Fed. 225). The rule of the Button-Fastener Case was affirmed by the Supreme Court in Henry v. A. B. Dick & Co. (224 U. S. 1, 32 Sup. Ct. Rep. 364. The same result has been reached by the English court under a similar statute. Incondescent Gas Light Co. v. Cantelo, 12 Pat. L. R. 262; Incandescent Gas Light Co. v. Brogden, 16 Pat. L. R. 179); but this decision has recently been overruled in Motion-Picture Patents Co. v. Universal Film Manufacturing Co., (Advance Sheets, 37 Sap. Ct. 416), where the court refused to enforce a restriction imposed by the patentee on his patented motion-picture projecting machine to the effect that it should be used only with films of the patentee's manufacture."

In reaching certain conclusions relative to the policy of the law, the author refers first to the decision by the House of Lords in the case of Nordenfelt. v. Maxim-Nordenfelt Guns and Ammunition Co., [1894] A. C. 535, and says that

"The House of Lords, " Realizing that a rule of law that depends on the balancing of two contrary policies cannot be settled adequately by a fixed and inelastic standard, formulated the principle that the test of the validity of a contract not to engage in a trade is whether or not it is necessary reasonably to protect the property rights of the promisee; and there are decisions in this country which in effect adopt this principle. 1 P. Wms. 181."

The author of the note then goes on to say:

"It is urged that the validity of restrictions on the use and price of chattels should be determined by the

principle of the Nordenfelt Case. Wherever such restrictions are necessary reasonably to protect the property rights of the vendor they should be allowed. But even under this test the Motion-Picture Case can be supported. There the vendor sought in his restriction not to protect his property rights in the patent under which he manufactured and sold the machine, but rather to stimulate his business in an independent and separate commodity."\*

A Classification of the Contributory Infringement Cases and the Assertedly Contributory Infringement Cases Which Preceded the Decision in the Carbice Case.

Shortly after the decision of this court in the Carbice Case, Mr. Willis B. Rice, a lecturer on Patent Law at New York University School of Law, contributed an article entitled "The Tangle of Contributory Infringement in the Supreme Court" to the New York University Law Quarterly Review (Vol. 11, page 48, September, 1933).

We do not at all share Mr. Rice's views as to the real meaning or effect of the decision of this court in the Carbice Case It bears internal evidence that it was decided upon a principle quite different from anything which Mr. Rice. discovers or discusses, t

† His reasoning is in part based upon a definite misunderstanding of one of the facts of the Leeds & Catlin Case. Mr. Rice said:

feeding the needle laterally.

"The Victor Company, who owned that patent, made and sold machines embodying the freely movable stylus or needle and also made and sold records having the sound grooves with which the needle of such a machine could operate."

He then says of "this machine", as distinguished from the record, that it had been patented separately but that the patent had expired. This statement as to the expiration of a separate patent on the machine,—at least if Mr. Rice means a machine having "a reproducing stylus \* \* free to be vibrated and propelled by the" "record", is, we believe, an error,

<sup>\*</sup> Note the identity between this outstanding characteristic of the Motion-Picture Patents Case as stated by this author in the Harvard Law Review, with the principle which animated the Supreme Court in its subsequent decisions in the Carbice Case and in the case of Leitch v. Barber.

<sup>&</sup>quot;In the Leeds & Catlin Case the patent in suit was for the combination of a phonograph stylus and a disk record, the needle being free to be propelled over the record by the spiral character of sound groove of the record, in which it rested. This is the now common construc-tion which makes it unnecessary to provide any other mechanism for feeding the needle laterally.

His article does, however, present the historical background for the decision in the Carbice Case. In so doing it classifies the preceding cases in which contributory infringement was found and in which the plaintiffs asserted that contributory infringement was involved. We shall, therefore, quote briefly from Mr. Rice's article,—interpolating however only a few of the many citations contained in his footnotes.

## "THE TANGLE OF CONTRIBUTORY IN-FRINGEMENT IN THE SUPREME COURT

## Willis B. Rice

"A patent is intended to give an inventor a reward for his invention commensurate with its value to society by giving him a monopoly of it for seventeen years. It is assumed that the value of this monopoly will be measured by the public demand for the invention. There is, however, a very great difference between the theoretical monopoly intended to be given and the practical power of restraint which can be enforced, for no matter how great the inventor's contribution, the patent is of no value if the public may appropriate the invention and get its full benefits without payment to the patent-owner.

"If society is to maintain this system in good faith, it should provide not only a theoretical right of control but a practical means for enforcing that control, otherwise a patent is nothing more than a "will-o-the-wisp." Many inventions, as for example, those which are primarily made or used in large factories or units can be controlled by bringing a few suits against those large organizations which may start to infringe, but there are many inventions with which the task is not so easy.

"For example, the Boyce Motor meter comprised a small thermometer or heat indicator on the radiator cap of an automobile. It was protected by a patent drawn to the combination of the thermometer arranged in the radiator cap on the car. The thermometer itself, apart from the car, was not and could not have been patented. In the strict sense, therefore, such a patent is not infringed until some individual bores a hole through the cap of his raditor and inserts, the instrument. If the patent owner relied on the charge of direct infringement, he could bring suit only against the individual mechanic who installed such a thermometer or the individual car owner, on whose car it was installed.

"Such a doctrine would make it possible for a large company to manufacture devices made and intended especially to be inserted in radiator caps, and to instruct individual mechanics or individual automobile owners how to install them in violation of the patent. Such a company could compete on equal terms with the patent-owner who himself can do little more than that. It is practically impossible to bring a sufficient number of suits against individual owners to produce any appreciable effect. In a practical sense, the intended monopoly would not exist.

"It was in part to remedy such a situation that the courts created the doctrine of contributory infringement as an outgrowth of the common-law doctrine of joint tort-feasors, and it was well expressed in such a case as follows:

'Contributory infringement is "the intentional aiding of one person by another in the unlawful making or selling or using of the patented invention;" and this is usually done by making or selling a part of the patented invention with the intent and purpose of so aiding. The essence of contributory infringement lies in concerting or planning with others in an unlawful invasion of a patentee's rights."

<sup>&</sup>lt;sup>2</sup> Goodyear v. Jackson, 112 Fed. 146, 148 (C. C. A. 1st, 1901); see also General Electric v. Sutter, 186 Fed. 637, 638 (C. C. W. D. Pa. 1911): "The legal principles governing contributory infringement are clear. Contributory infringement exists where one knowingly concerts or acts with another in an unlawful invasion of a patentee's rights. If such assistance is given by furnishing an essential part of an infringing combination and the part furnished is adapted to no other than an infringing use, such contribution makes him a contributory infringer. On the other hand, if the part furnished is adapted to other and lawful uses, in addition to infringing uses, then an intent to furnish for infringing use must be established before the furnisher can be held a contributory infringer."

"Under such a rule the patent owner is permitted to prevent the deliberate manufacture of devices intended solely for infringement or to shut off the source of special materials or the special apparatus which the ultimate infringer requires in making the infringement. He may thus indirectly stop the infringement which he cannot directly prevent, and yet in general, he will be able to control only that business which the patented invention has created.

"This doctrine has been so thoroughly accepted by the bar and by the courts that cases which depended upon it have been decided without serious challenge upon this issue, and many important patents have been enforced through it, which otherwise would have been without practical remedy.

"The Supreme Court's opinion in the first Carbice case now leaves this matter in grave uncertainty. It denies relief in what is apparently so typical a case of contributory infringement that it leads Mr. Alfred McCormack to say " " if the Dryice Corporation had no right to be free from competition in the sale of carbon dioxide, then the law of contributory infringement is abolished," and yet the Court evidently, as Mr. McCormack recognizes, did not intend to abolish it. If it is an abolishment or even a modification of the doctrine of contributory infringement, it is apparently so serious an alteration as to involve readjustment of the patent law.

"Apparently, also, grave modifications of the responsibility of tort-feasors in other fields may be necessary for the Court's statement, that 'relief is denied because the plaintiff is seeking a monopoly not in the patented article, but in an unpatented material' gives a reason for denying relief which transcends the patent law altogether.

"This same patent was declared void on rehearing but

<sup>\*</sup>McCormack, Restrictive Patent Licenses and Restraint of Trade (1981) 31 Col. L. Rev. 773.

the second opinion does not correct or alter any of the statements of the first.

"The cases prior to the Carbice case may be classified under the following headings which are intended to express the doctrines which each has been considered to represent:

"I. The general selling of ordinary materials and supplies to a party does not make the seller liable for any patent infringement of which that party may be guilty, even if the seller knows of it, unless there is a very intimate relation between the material or article furnished and the actual infringement.

"II. The sale by a patent-owner of a device having as a part of the patented combination a transient element or one requiring frequent replacement or repair to keep the device in condition for use, implies the right to make that necessary replacement or repair, even though this involves the combining of the elements which constitute the patented combination. It is probably assumed that the purchase of the device carried with it the right to keep it in condition for use for its intended purpose, in order that the purchaser may get that for which he paid. This license to repair is a license from the patent-owner implied from the very nature of the original sale. (Citing and discussing Heyer v. Duplicator Co., 263 U. S. 100, 44 Sup. Ct. 31 (1923); Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 14 S. Ct. 627 (1894).)

"III. A person who furnishes a critical part or a critical material or a critical apparatus for the unlawful making or remaking of the invention with knowledge and intention that it is to be used by another in making an infringing device is guilty of contributory infringement if it is in fact so used. Thus, in the case of Symington v. The National Castings Company, the Castings Company was making certain special castings which were used by a third party to make car couplings which infringed the plaintiff's patent. These castings were made for the express purpose of being used in the patented coupling and the court sustained the charge of infringement. The decision of this case in the Supreme Court does not discuss the question of contributory infringement but this issue was faised in the lower court. 17

"IV. The validity of license restrictions was sustained generally in the Bement case, 18 provided in any particular case that the restrictions are not contrary to law, and a breach of such contract by violating the conditions will support an action in a state court for breach of contract. As decided in Henry v. Dick, 18 however, the licensor may elect to treat any act of the licensee in excess of his license, and this includes any act in violation of a valid restriction, as an unlicensed act and hence as an infringement. The reasoning of the Bement case was criticized and the Henry v. Dick case was overruled in the Motion Picture Patents case, 20 but only as to the validity of certain types of restrictions and not on the particular doctrines here stated. 21

"Ordinarily in a contract, if an important condition is void, the entire contract may be declared void, but a dif-

<sup>\*</sup>Symington v. National Castings, supra note 3; Leeds and Catlin v. Victor, 213 U. S. 325, 29 Sup. Ct. 503 (1909); Union Tool Co. v. Wilson; Field v. De Gomeau; Geneva Furn. v. Karpen, all supra note 11; Cotton Tie v. Simmons, 108 U. S. 89, 1 Sup. Ct. 52 (1882).

<sup>&</sup>quot; National Castings v. Symington, 234 Fed. 348 (C. C. A. 1st, 1916).

<sup>\*\*</sup> Bement v. National Harrow, 186 U. S. 70, 22 Sup. Ct. 747 (1902).

<sup>&</sup>lt;sup>3</sup> 224 U. S. 1, 32 Sup. Ct. 364 (1912).

<sup>\*</sup> Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 37 Sup. Ct. 416 (1917).

<sup>\*</sup>See Healy v. Sea Gull Specialty Co., 237 U. S. 479, 35 Sup. Ct. 658 (1915); Luckett v. Delpark, 270 U. S. 496, 46 Sup. Ct. 397 (1926); DeForest v. United States, 273 U. S. 236, 47 Sup. Ct. 388 (1927).

ferent situation arises as to license restrictions. If a licensor violates a license condition which the court believes void, a holding that the license is thereby cancelled, would in effect enforce the very restriction of which the Court disapproved. In such case, therefore, the license must be sustained as though the restriction had not been imposed, if the disapproval of the restriction is to be effective.

"Cases of this kind have formed an important part of the doctrine of contributory infringement because of the extent to which patent-owners endeavored to employ the license restrictions to exploit their inventions and because of the open and extensive manner in which third parties endeavored to profit from the violation of these restrictions. In such cases, the actions of the third party have been fremently intentional and flagrant, so that the third party who was the defendant could not with good grace plead that he was not responsible for the acts committed, but rather tacitly admitting his responsibility, claim justification on the ground that the acts complained of were lawful. Such cases, therefore, have turned upon the validity of the license restrictions.

"This subject of what license restrictions may be imposed is in itself a large one and it is not within the scope of this study. But the *Carbice* case does not turn upon the validity of license restrictions, and we need not go into it here except as to those particular license restrictions referred to by the Court.

"V. When a patented article is sold with a license to resell it, containing a license restriction to limit the price at which the purchaser may resell, the restriction is void and the purchaser is free to resell it for his own price, notwithstanding the restriction. The rule holds regardless of the form which the agreement takes. "VI. Where a device is sold which itself constitutes the patented article and the sale is accompanied by a license containing restrictions purporting to limit the use of the patented device to a use with supplies or materials purchased from the licensor, the object being to use the patented device to create a partial monopoly in unpatented materials which do not form part of the combination but which are used with it, the restrictions are held to be void and the sale a complete sale free from those restrictions.

"A typical case of this kind is the Motion Picture Patents case.<sup>23</sup> In that case the patent concerned a step by step film feeding mechanism for feeding motion picture films through the projecting machine. This feeding mechanism was claimed in the patent as such, and not as a combination between the mechanism and the film. The machines involved in the suit had been made under a license containing restrictions, and were sold bearing the 'restriction and limitation' among others that the machine could be used only with films leased from a 'licensee of the licensor.'

"There was apparently no patent on the combination of the feeding mechanism and the film, and, the patent on the film had expired.

"From the foregoing, it will be clear that the invention was completely embodied in the machine already-made and sold by authority of the patent-owners and the patent-owners had at least a chance to obtain their profit upon it. The right asserted by the plaintiff was based upon the validity of this license restriction imposed upon the machine to limit its use in the hands of the purchaser."

Now with this sketch of the historical background as

<sup>\*\*</sup>Supra note 20, overruling on this point, Henry v. Dick, supra note 19. See also Cortelyou, v. Johnson, 207 U. S 196, 28 Sup. Ct. 105 (1907) (decided for insufficient notice to defendant of the intended license restriction).

written by Mr. Rice in his Law Review article, we shall turn to the decision of the Court in the Carbice case (Carbice Corporation of America v. American Patents Development Corporation and Dry Ice Corporation of America, 283 U.S. 420, 51 Sup. Ct. 496).

## What Were the Grounds of the Decision in the Carbice Case.

In denying relief to the plaintiff, His Honor Judge Campbell in the District Court put his decision, 25, F. (2d) 730, upon two grounds which could be aligned with authoritative decisions in earlier cases. His first ground is to be gathered from the language in which he said:

"Plaintiff contends that the thing claimed is a package, goods baled, boxed, or otherwise enclosed for transportation, " Defendant contends that the

patent is for a container.

"In my opinion the defendant is correct, and no infringement was shown, because at most defendant could only be a contributory infringer, and to sustain such a charge, it would have been necessary to show that defendant contributed materials going into the construction of the container, and such charge would not be sustained by showing that commodities were used in the container." (emphasis ours.)

There is considerable support for this view, since in none of the claims in suit (2, 3, 4, 6, 7 and 9) was the frozen carbon dioxid included positively as an element of the combination.

The second ground upon which Judge Campbell placed his decision was that

"Even if it be held that the patent in suit is for a combination, one element of which is solid carbon diaxid, the defendant did not infringe the patent in suit by furnishing the solid carbon dioxid, as that was a perishable product, consumed in the operation, and the patentee has not patented and could not patent solid carbon dioxid. Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 14 S. Ct. 627, 38 L. Ed. 500."

In view of the grounds of the subsequent decision by the Supreme Court, the most striking feature of Judge Campbell's opinion is the fact that he went out of the way of the grounds upon which he formally based his decision to stress this:

"Plaintiff does not make nor sell, nor has it licensed anyone to make, the refrigerating apparatus claimed in the patent in suit. All that plaintiff or defendant does is to manufacture and sell solid or frozen carbon dioxid, the chemical symbol of which is CO<sub>2</sub>."

We should like now to quote from the opinion of Mr. Justice Brandeis to show what were the stated grounds of the decision by the Supreme Court. In so doing, we shall take advantage of the opportunity to contrast the facts of the instant suit. Each of the following numbered paragraphs is quoted from the opinion of the Supreme Court beginning on page 29 of 283 U.S.

1. "The sole business of the Dry Ice Corporation" (one of the plaintiffs) "is the manufacture of solid carbon dioxid which it sells under the name of 'Dry Ice'."

In so far as the Butler patent in suit is concerned, the sole business of the Stewart-Warner Corporation is the manufacture and sale of the lubricating apparatus described and claimed in the Butler patent in suit. (The Stewart-Warner Corporation does sell lubricating oil and grease but it has never attempted or even suggested that purchasers of its oil or grease should thereby acquire any license under the patent in suit.) It has never attempted to require that the purchasers of any lubricating apparatus under the Butler patent in suit or under any other patent should purchase the plaintiff's lubricants for use therein.

2. "It (the plaintiff, Dry Ice Corporation) does not make or sell transportation packages in which solid carbon dioxid is used as a refrigerant."

The plaintiff, Stewart-Warner Corporation, does make

and sell all of the parts of the complete lubricating apparatus described and claimed in the Butler patent in suit.

3. "It" (the plaintiff, Dry Ice Corporation) "does not issue to other concerns licenses to make such packages upon payment of a stipulated royalty."

The record herein shows that the Stewart-Warner Corporation has granted just such a license to the Cincinnati Ball Crank Co. (R. p. 37).

4. "Each invoice" (of the plaintiff, Dry Ice Corporation) "for solid dioxid sold by it bears this notice: 'The merchandise herein described is shipped upon the following condition: That DryIce shall not be used except in DryIce Cabinets or other containers or apparatus provided or approved by the Dry Ice Corporation of America;" etc.

The Stewart-Warner Corporation has never sold or shipped any of its lubricants or any of its lubricating apparatus upon any such condition or upon any condition whatsoever,—except, of course, conditions as to time and terms of payment, etc.

5. The opinion of the Supreme Court points to and quotes the following condition, namely:

"that DryIce Cabinets or other containers or apparatus provided or approved by the Dry Ice Corporation of America shall be refrigerated or used only with DryIce. These uses of DryIce are fully covered by our Basic Method and Apparatus Patent No. 1,511,306, granted October 14, 1924, and other Patents Pending."

The plaintiff, Stewart-Warner Corporation, never sold any of its lubricating apparatus upon the condition that it should be supplied with or used only in conjunction with oil and grease furnished by Stewart-Warner Corporation nor under any other limitation or restriction as to supplies or repairs of any kind whatsoever. 6. "The Dry Ice Corporation extends to each of its customers, buyers of solid carbon dioxid, a license to use the invention without the payment of royalty."

Neither in the sales of its oil or grease nor otherwise has the Stewart-Warner Corporation ever extended to any of its customers a license to use the invention of the Butler patent or of any of its patents without the payment of royalty.

7. "The Carbice Corporation challenges the validity of the patent and denies infringement. Whether the transportation package described is a patentable invention we need not determine. For, even if it is, no relief can be granted."

If the claims of the Slate patent in suit were valid combination claims and included solid carbon dioxid as an element, and if the defendant sold that element with the requisite knowledge and intent, there would be what ordinarily was called an infringement. It is to be noted that the court did not say: "Even if the transportation package described is a patentable invention, there has been no infringement."

What the court did say was that "no relief can be granted." We regard this expression as significant of the fact that the decision of the court was put upon grounds other than those of patent validity or patent infringement. There is much more in support of the same understanding.

As we have seen, and as we shall see, none of the grounds upon which the court said that "no relief can be granted" in the Carbice Case can be found in the facts of the instant case.

8. After enumerating many of the patentee's rights, the court said:

"But it" (the plaintiff, Dry Ice Corporation) "may not exact as the condition of a license that unpatented materials used in connection with the invention shall be purchased only from the licensor." The Stewart-Warner Corporation has never exacted as a condition of any license that grease or other unpatented materials used in connection with its Butler invention or any other invention shall be purchased only from the licensor.

9. The opinion of the court went on to say:

"If it does so, relief against one who supplies such unpatented materials will be denied."

Now let us see what was said in the footnote indexed at this point.

(a) It was pointed out that

"In England the insertion of such a requirement in any license agreement is a complete defense to any defendant charged with infringement." (Citing statutes and cases.

(b) It was pointed out that

"The need for such legislative measures to prevent the abuse of the patent monopoly has now been recognized by the International Convention for the Protection of Industrial Property." Citing authorities.

(c) It was pointed out that

"In this country the patent statutes similarly provide that an unreasonable delay in formally disavowing patent claims held invalid, and the consequent maintenance of a broader monopoly than warranted, is a complete defense to all infringers, even as to remaining valid claims." Citing statute and cases.

This meant that even in the case of infringement of valid claims, relief was to be denied because of the inequity of the patentee in attempting to assert a broader monopoly than was warranted.

Here again the statement that "relief will be denied" was not based upon any contention that the patent in and of itself was invalid or that the defendant had not infringed, but rather upon grounds of broad public policy in view of the inequitable conduct of the patentee. 10. In its opinion the court said:

"The relief here sought is indistinguishable from that denied in the Motion Picture Patents Co. Case. There, it was held that to permit the patent owner to 'derive its profit, not from the invention on which the law gives it a monopoly but from the unpatented supplies with which it is used,' is 'wholly without the scope of the patent monopoly'."

The claims of the patent involved in the Motion Picture Patents Case did not even pretend to include the film as an element of any combination or other claim. In the Motion Picture Patents Case, therefore, relief was denied,—not because of the invalidity of the patent, not because of any direct determination of any question of infringement or non-infringement, but solely upon the ground that the owner of the patent in and by its "license notice" had attempted to make such an inequitable use of its patent as to have forfeited any right to such equitable relief as had theretofore been granted, as, for example, in the case of *Henry* v. *Dick*, 224 U. S. 1, 56 L. ed. 645, 32 Sup. Ct. Rep. 364.

Some fragments of the opinion in the Motion Picture Patents Case are illuminative of its raison d'etre.

Thus, for example:

"Plainly this language of the statute and the established rules to which we have referred restrict the patent granted on a machine, such as we have in this case, to the mechanism described in the patent as necessary to produce the described results. It is not concerned with and has nothing to do with the materials with which or on which the machine operates.

"The restrictions of the law relate to the useful and novel features of the machine which are described in the claims of the patent; they have nothing to do with the materials used in the operation of the machine.

"Whatever right the owner may have to control by restriction the materials to be used in operating the machine, must be derived through the general law from the ownership of the property in the machine, and it cannot be derived from or protected by the patent law.

"A most persuasive expression of the public policy of our country with respect to the question before us.

"Such a restriction is invalid because such a film is obviously not any part of the invention of the patent in suit; because it is an attempt, without statutory warrant, to continue the patent monopoly in this particular character of film after it has expired, and because to enforce it would be to create a monopoly in the manufacture and use of moving picture films, wholly outside of the patent in suit and of the patent law as we have interpreted it."

It is evident that in the Motion Picture Patents Case, relief was denied upon rather broad principles of equity and public policy. It was these grounds which were, therefore, invoked in support of the decision in the Carbice Case.

The respondent, Stewart-Warner Corporation, has not attempted to perpetrate any restraints or restrictions of the kind which were condemned in the Carbice Case or in its so designated prototype, the Motion Picture Patents Case.

11. Referring further to the Motion Picture Patents Case, the court said in its opinion in the Carbice Case that

"If a monopoly could be so expanded, the owner of a patent for a product might conceivably monopolize the commerce in a large part of unpatented materials used in its manufacture."

Unpatented materials as here used refers directly to the fifty-year old commodity, solid carbon dioxid, and indirectly, the old and well-known commodity, motion picture film, upon which the patent had long since expired.

If the Stewart-Warner Corporation were to attempt to use its patent in such a way as measurably to monopolize the commerce in grease, it would run counter to such considerations of public policy and of equitable principles as were here under discussion.

12. "The owner of a patent for a machine might thereby secure a partial monopoly on the unpatented supplies consumed in its operation."

The Stewart-Warner Corporation has never attempted to use any patent in such a way as to secure a partial monopoly on the grease consumed in the operation of its lubricating apparatus.

13. "The owner of a patent for a process might secure a partial monopoly on the unpatented material employed in it."

That is precisely what was subsequently attempted by the Barber Company. The attempt was frustrated by the decision of this court in *Leitch* v. *Barber*, 82 L. Ed. 276.

The Stewart-Warner Corporation has never made any such attempt.

14. In its opinion in the Carbice Case the court said that

"The owner of the patent in suit might conceivably secure a limited monopoly for the supplying not only of solid carbin dioxid, but also of the ice cream and other foods, as well as of the cartons in which they are shipped."

This suggests a comparable situation in which the respondent in the instant case might attempt to secure a limited monopoly upon the machines whose bearings were greased by the use of the apparatus of the patent in suit. Nothing of the kind has ever been attempted or suggested.

15. The court said in the Carbice Case that

"The attempt to limit the licensee to the use of unpatented materials purchased from the licensor is comparable to the attempt of a patentee to fix the price at which the patented article may be resold."

Obviously, the question of public policy and equity in-

volved in the matter of price fixing was far remote from anything contained in or reasonably deducible from the patent laws.

The Stewart-Warner Corporation has never attempted to fix the price at which its lubricating apparatus may be resold nor to do anything comparable therewith.

16. In its opinion in the Carbice Case the court said:

"In both classes of cases, (i. e., those in which the patentees had attempted to place restrictions upon the use of the patented machines sold by them and those in which the patentees had attempted to fix the resale price of their patented articles) courts deny relief against those who disregard the limitations sought to be imposed by the patentee beyond the legitimate scope of its monopoly."

The most illuminating phase of the statement is perhaps the footnote comments in which it is pointed out that

"The patent grant is inherently limited in other respects."

Thus, for expamle,

"A patent covering an essential instrumentality does not enable a patentee or its licensee thereby to abridge its obligations as a public utility. "Nor does the grant of a United States patent exempt the patented product from limitations imposed by state police statutes. "Nor can a patent be made the basis of an unconscionable contract."

These illustrations all relate to matters of common equity or public policy quite outside the range of any patent questions of validity, infringement, etc. They aid in making it clear that the basis of the decision in the Carbice Case was the use or perhaps rather the misuse which the patent owner had attempted to make of its alleged patent rights. Its business was simply the sale of an old and staple commodity. It attempted to enhance the profits of its purely merchandising business by wielding the club of a patent which in reality related to quite another thing.

The respondent, Stewart-Warner Corporation, has attempted to use its patent simply in protecting itself against competition in the manufacture and sale of the very thing which is described and claimed in its patent.

The inapplicability of the real grounds of the decision in the Carbice Case to the facts of the instant case is further emphasized by the distinctions which the opinion in the Carbice Case makes with respect to the Leeds & Catlin Case.

17. The court says of the latter:

"That was an ordinary case of contributory infringement."

So is this.

18. In its opinion in the Carbice Case the court said:

"The Victor Company sold machines embodying a patent for a combination."

So does the Stewart-Warner Corporation.

19. In the Carbice Case the court said:

"Leeds & Catlin were held to be infringers because the intended incorporation in the Victor machines of the article which they sold, did not constitute a repair of the machine and hence was not within the license implied on sale."

There is no contention and could be no successful contention that the headed nipples sold by the Lincoln Engineering Company constitute any "repair of the machine" sold by the Stewart-Warner Corporation.

20. In the Carbice Case the court said:

"There was no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used."

Similarly, there can be and is no suggestion that the Stewart-Warner Corporation, which itself manufactures and sells the patented product, seeks to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies as, for example, the grease with which it is used.

21. In the Carbice Case the court said:

"In the case at bar the plaintiffs neither sell nor license others to sell complete transportation packages."

In the instant case the respondent, Stewart-Warner Corporation, both sells and licenses others to sell complete lubricating apparatus embodying the invention of the Butler patent in suit.

22. In its opinion in the Carbice Case the court said that "They" (the plaintiffs, American Co. and Dry Ice Corp.) "supply merely one of the several materials entering into the combination."

They merely merchandised an old and well-known commodity, carbon dioxid. In the present case the business of the plaintiff-respondent is to manufacture and sell the whole of the apparatus described and claimed in the patent in suit.

23. In the Carbice Case the court went on to say that "On that commodity they" (the plaintiffs) "have not been granted a monopoly. Their attempt to secure one cannot be sanctioned."

These phrases would be applicable to the Stewart-Warner Corporation, if it had attempted to secure a monopoly or a partial monopoly on the commodity known as grease. Nothing of the kind has ever been attempted or thought of. The Stewart-Warner Corporation's concern is solely with the protection of the patent laws in the manufacture and sale of the highly specialized combination of elements constituting the subject matter of the patent in suit.

Here again, in this last sentence of the court's opinion in

the Carbice Case, there is a footnote which high-lights the real basis of the decision. It is said that

"Restrictions on the manner of use, essential to prevent unwarranted extension, are inherent in other limited monopolies."

The manner of use!

"The manner of use" in the Carbice Case refers, of course, to the use which was attempted to be made of the patent. The patent was attempted to be used through license restrictions and through the business policy of granting immunity from liabilities for patent infringement to all who would buy the old and well-known carbon dioxid from the Dry Ice merchandising company. The trouble with the Dry Ice Company was that it was not attempting to enjoy and to enforce its patent rights; it was attempting to merchandise an old and staple commodity by wielding a patent club in such a way as to enhance its profits as a commodity merchant.

When, therefore, the court pointed to restrictions on the manner of use of other limited monopolies, it was saying, in effect, that rules of public policy and of equity would be made to supercede the laws of patents whenever the patentee foreswore his more strictly patent rights and sought to make them an ostensible cover for socially indefensible depredations.

The cited instances in which public policy and equitable principles stepped in to estop a plaintiff from the enjoyment of his monopolistic rights because of his misconduct in connection with those rights, were as follows:

"a. A trade mark may not be used as a means of misrepresentation."

"b. Nor a trade name as a means of deception."

We have in the foregoing discussion quoted very considerable parts of the opinion of the court in the Carbice

Case. We have been careful not to omit reference to any point or consideration upon which the conclusion of the court was based.

The striking fact is that from beginning to end the court laid completely aside all considerations of patent validity. It laid completely aside all questions of patent infringement, either direct or contributory.

From beginning to end the opinion deals with the use, or rather the misuse, which the plaintiffs attempted to make of what under other circumstances would have been their patent rights. The opinion makes it clear beyond peradventure that "relief was denied" because the conduct of the plaintiffs was not compatible with broad principles of equity,—because the misuse which the plaintiffs sought to make of their patent rights was contrary to public policy.

Not one of the stated considerations for denying relief in the Carbice Case finds any applicability to any of the facts in the instant case.

Although many courts and many lawyers have expressed widely different views as to the real philosophy of the decision of this Court in the Carbice case, we have been glad to find that we are not alone in our understanding of it. The brief filed on behalf of the petitioner in the more recent case of Leitch v. Barber, 82 L. Ed. 276, shows that counsel for the petitioner in that case have the same understanding as do we of the real grounds of the decision in the Carbice Case. It seems to us that those grounds are made quite plainly clear in and by the opinion of the Court by Mr. Justice Brandeis. We put the matter in this way nevertheless, because we are aware, as doubtless the Court is aware, that there are many courts and many counselors who apparently have not understood the grounds of the decision in the Carbice Case, at least as we understand them and as counsel for the petitioner in the Leitch Case understand them.

Under the circumstances, we are taking the liberty of quoting in extenso from the brief of counsel for the petitioner in the Leitch vs. Barber case. This brief fairly bristles with expressions in confirmation of our understanding of the Carbice Case. We are quoting from the brief of counsel for the petitioner in the Leitch Case without adding to or changing any of their typographical emphasis. Let us therefore stress in advance such phrases as these, which appear in the argument of counsel for Leitch:

"The clearly expressed principle of law" (in the Dry Ice Case) "namely, that contributory infringement does not lie where the primary intent or purpose of the plaintiff in bringing the infringement action, as deduced from his acts, is to secure to himself a limited monopoly in an unpatentable material."

"Such an intent may be inferred when," etc.

"Its repeated emphasis on these factors in the Dry Ice Case."

"Accordingly, the doctrine of contributory infringement, which is an equitable doctrine originated by the courts to do equity in the appropriate cases, readily lends itself to abuses."

"This Court will not permit the distortion of an equitable principle into an instrument of inequity."

"Nothing in the *Dry Ice* Case can properly be construed to mean that the sale of unpatentable material will not be enjoined where the *sole purpose* is to stop an infringement of a patent which the plaintiff is practicing and from which he derives his profit. And it is respectfully urged that this distinction be repeated in the present case," i. e., in the Leitch Case.

"This Court was clearly saying that the issue is not in the patentability or unpatentability of the material."

"The issue of contributory infringement depends on whether, from the actual business of the plaintiff and the source from which it derives its profit, it is reasonable to infer that the primary object of the plaintiff is to set up an unlawful monopoly on the unpatented material."

"Under such circumstances, no tort has been committed which justifies granting equitable relief."

"When, however, the charge is contributory infringe-

ment, it becomes important to examine whether the Plaintiff is really seeking to prevent such a tort or is instead using the patent as a color of legality for securing a monopoly in unpatentable materials."

"In determining whether contributory infringement lies, the purpose and intent of the plaintiff asking for injunctive relief deducible from the facts may be in-

vestigated by the Court."

"There is nothing in such a holding which in any way limits the well-established doctrine of contributory infringement in cases where the Plaintiff's primary and only purpose, deducible from the facts concerning the nature of his business, is to stop actual interference with his granted patent monopoly, even where he seeks to stop the sale of unpatentable materials. In such cases, no doubt, an equity court would be justified in granting injunctive relief."

The Correct Interpretation and Application of the Decision of This Court in the Dry Ice Case as Expressed by Counsel for the Petitioner in Their Brief in the Case of Leitch vs. Barber.

The following paragraphs are quoted (without change in or addition of emphasis) from the brief of counsel for the petitioner in the case of *Leitch* v. *Barber*, 82 L. Ed. 276:

## "The Issue:

"These facts raise the following issue:

"May a patent be employed for the primary, obvious and frank purpose of securing a limited monopoly in

an unpatentable material?

"The answer to this was clearly given by this Court in the Dry Ice case (283 U. S. 27) but has been misconstrued by many of the patent profession and by the Courts.

"The present case affords an opportunity to stop further misconstruction by reaffirming the clearly expressed principle of law, namely, that contributory infringement does not lie where the primary intent or purpose of the Plaintiff in bringing the infringement action, as deduced from his acts, is to secure to himself a limited monopoly in an unpatentable material.

"Such an intent may be inferred when:

(1) the Plaintiff's business is primarily in the sale of the unpatentable material, and

(2) the Plaintiff derives all or substantially all

its profit from such sale.

"It would seem that this was made unquestionably clear by this Court in its repeated emphasis on these factors in the *Dry Ice* case where it called attention to the fact that:

1) "The sole business of the Dry Ice Corporation is the manufacture of solid carbon dioxide

• • "" (p. 29);

2) "It (the Dry Ice Corporation) does not make or sell transportation packages (p. 30);

3) "The Carbice Corporation also manufac-

tures solid carbon dioxide" (p. 30);

4) "In the case at bar the plaintiffs neither sell nor license others to sell complete transportation packages. They supply merely one of the several materials entering into the combination; and on that commodity they have not been granted a monopoly. Their attempt to secure one cannot be sanctioned" (p. 34);

5) "The Dry Ice Corporation has no right to be free from competition in the sale of solid car-

bon dioxide" (p. 33);

6) "Relief is denied because the Dry Ice Corporation is attempting, without sanction of law, to employ the patent to secure a limited monopoly of unpatented material used in applying the invention" (pp. 33, 34).

"To Petitioner, these statements culled from that decision clearly indicate that in a suit for contributory infringement as distinguished from an ordinary infringement suit, the Court may properly inquire into the business of the Plaintiff to determine the actual relief he is seeking.

"Is it really to secure to the patentee the undisturbed enjoyment of his actually granted patent monopoly or is it primarily to secure some other monopoly not

granted him by the patent?

"Such an inquiry is proper because in contributory infringement relief is usually sought, not for the thing patented, but for an unpatentable part thereof which a third party will use in accordance with the patent. Accordingly, the doctrine of contributory infringement which is an equitable doctrine originated by the Courts to do equity in the proper cases, readily lends itself to abuses.

"The Dry Ice case merely reaffirmed an obviously sound principle of law, namely, that where the Plaintiff's intent in bringing the action, clearly deducible from the Plaintiff's and Defendant's business is to extend his monopoly to unpatentable supplies, no such grant will be given. In other words, this Court will not permit the distortion of an equitable principle into

an instrument of inequity.

"Nothing in the Dry Ice case can properly be construed to mean that the sale of unpatentable material will not be enjoined where the sole purpose is to stop an infringement of a patent which the Plaintiff is practicing and from which he derives his profit. And it is respectfully urged that this distinction be repeated in the present case as was done in the Dry Ice case when this Court said in distinguishing from the Leeds & Catlin v. Victor Talking Machine Co. case, 213 U. S. 325:

"That was an ordinary case of contributory infringement. The Victor Company sold machines

embodying a patent for a combination.

There was no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.'" (p. 34).

"It would seem to the present Defendant that this Court was clearly saying the issue is not in the patentability or unpatentability of the material. In fact, this Court in the Dry Ice case rejected such specious distinctions in comparing the Dry Ice case with the Victor case, supra. Rather, as appears from the Dry Ice case, the issue of contributory infringement depends on whether, from the actual business of the Plaintiff and the source from which it derives its profit, it is reasonable to infer that the primary object of the Plaintiff is to set up an unlawful monopoly on the unpatented material, thereby obtaining larger financial returns than is obtainable from a mere enforcement of the actual patent grant. Obviously, under such circumstances, no tort has been committed which justifies

granting equitable relief.

"This Court in refusing to be diverted from the true issue in the Dry Ice case by subtle differences over cases such as the Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425, where no contributory infringement was found because of the "passivity" of the paper with respect to the combination of paper and a dispensing mechanism said:

"These distinctions are without legal significance. Infringement, whether direct or contributory, is essentially a tort and implies invasion of

some right of the patentee" (p. 33).

"Now, that invasion is clear and unequivocal when a charge of direct infringement is involved. When, however, the charge is contributory infringement, it becomes important to examine whether the Plaintiff is really seeking to prevent such a tort or is instead using the patent as a color of legality for securing a monopoly in unpatentable materials. And that is determined by the Plaintiff's own business.

"The sociological dangers involved in any different application of the doctrine of contributory infringement are manifest in the particularly flagrant charac-

ter of the present case.

"Thus we have a process patent in which the invention, according to the Circuit Court of Appeals, resides not in the process per se but in using the process for roadways and we have a Plaintiff who would use such a patent to hamper its competitor and thereby prevent him from selling any asphalt emulsion to road contractors, although both Plaintiff and Defendant had been carrying on such sale for years before the present patent was filed.

"That the proposed injunction will have this effect

will be evident from the following:

"The Leitch Company has been selling asphalt emulsion in large drums to road contractors for many years before the present patent was filed. Even now only about 5% of the sold product is used by the road contractors in carrying out the patented process, the remainder being used for road repair, construction, etc. Inasmuch as the Leitch Company or any manufacturer of asphalt knows of the likelihood that a road contractor may use some asphalt emulsion in accordance with the patented process, he would always have the heavy responsibility that some subordinate might sell emulsion with knowledge of infringement. Accordingly, to avoid the risk of being brought up for contempt of court, the Leitch Company would necessarily have to stop selling any asphalt to road contractors, although this has been its business for many years.

"Thus a patent probably invalid for new matter, and in view of prior art, becomes a means for creating a substantial monopoly in the sale of an old asphalt emulsion. It is much more flagrant than the Henry v. A. B. Dick Co., case, 224 U.S. 1, or the Motion Picture Patents Co. v. Universal Film Mfg. Co. case, 243 U. S. 502, 515, where conditional sales requiring purchase of unpatentable supplies with the purchased machine were held by the Court to be contrary to public policy and the Clayton Act. In those cases the limited monopoly sought, while in principle as bad as in the present case, was at least restricted to a sale of unpatentable supplies to purchasers of machines. In the Dry Ice case, this attempt at an illegal monopoly was "inched" a little further to cover Dry Ice sold to anyone but still limited to those who used it in a patented container. In the present case all restraint is thrown aside and the Plaintiff for all practical purposes is asking for a monopoly in the sale of asphalt emulsion to road contractors and that Defendant's business which has been conducted for years prior to the alleged Hayden invention be so hampered with restrictions and danger of contempt actions, as to prevent Defendant from proceeding in his regular lawful business.

#### "Conclusions.

"It is respectfully submitted that the equitable Doctrine of Contributory Infringement does not warrant its extension to secure by direct or indirect means a limited monopoly in the sale of unpatentable materials, and, therefore, in determining whether contributory infringement lies, the purpose and intent of the Plaintiff asking for injunctive relief deducible from the facts may be investigated by the Court. If the Plaintiff's business from which he derives his profit is in the sale of the unpatentable materials the Court may properly infer that its primary intent is to obtain a limited monopoly in these old and unpatentable supplies, and the

case should be dismissed.

"There is nothing in such a holding which in any way limits the well-established doctrine of contributory infringement in cases where the Plaintiff's primary and only purpose, deducible from the facts concerning the nature of his business, is to stop actual interference with his granted patent monopoly, even where he seeks to stop the sale of unpatentable materials. In such cases, no doubt, an equity court would be justified in granting injunctive relief.

"In the present case, The Barber Company, manufacturers of asphalt emulsion, from which product (rather than from the practice of the patented process) they derive their profits, should not be permitted to secure a monopoly in this sale through an improper use of their patent, and the Circuit Court of Appeals for the Third Circuit should be reversed and this case

returned with an order of dismissal."

The Opinion of the Supreme Court in the Case of Leitch v. Barber, 82 L. Ed. 276, Further Emphasizes the Broad Equitable Principle Upon Which the Dry Ice Case Was Decided.

In our discussion of the Carbice Case, we endeavored, point by point, to contrast the facts of the instant case. We shall in our discussion of the opinion of the Court in the case of Leitch vs. Barber, refrain from thus contrastingly interlarding the facts of the present case. They are precisely of the character to which counsel for the petitioner in the Leitch case referred when they said:

"Nothing in the **Dry Ice** case can properly be construed to mean that the sale of unpatentable material will not be enjoined where the **sole purpose** is to stop

an infringement of a patent which the plaintiff is practicing and from which he derives his profit. And it is respectfully urged that this distinction be repeated in the present case as was done in the Dry Ice Case ... (The emphasis is that of counsel for Leitch.)

In considering the grounds upon which the decision was based in the case of Leitch vs. Barber, it is to be borne in mind throughout that the Stewart-Warner Corporation purchased the Butler patent and then began in April, 1933, to manufacture and sell the lubricating apparatus described and claimed in the Butler patent. Stewart-Warner has sold all of the parts, i. e., the complete combination claimed in the patent in suit. It has done so in precisely the same way that any other manufacturer would normally and rightly engage in the manufacture and sale of any patented machine or apparatus. (If there is any difference, it is a purely superficial difference arising from the fact that the real value of the Butler invention resides in the intermittent severability of the two halves of the connector mechanism, thereby making it necessary for Stewart-Warner to sell the invention in its component parts and assortments rather than as a permanently integrated whole.) Stewart-Warner Corporation has never engaged in any attempt to fix resale prices. It has never proposed or used any tying clauses. It never has imposed any restrictions or conditions. It never has incorporated any license or other notices in invoices or on labels or otherwise. Neither the headed nipple parts nor the compressor and coupler parts of the lubricating apparatus sold by Stewart-Warner, had any existence or market or use prior to the time when the invention of the Butler patent was first put on the market in April, 1933. No nipple which had ever been manufactured or sold or illustrated or described prior to the commercial advent of the Butler lubricating apparatus, can be used as a part of or in lieu of any part of the Butler invention as manufactured and sold by the plaintiff-respondent. At the time when Stewart-Warner first put the Butler invention on the market in 1933, no one else had ever manufactured or sold or used any part of any connector mechanism which could be used as any part of the Butler mechanism as then first manufactured and sold by Stewart-Warner.

It was not until a year and a half later that the defendant-petitioner first began the manufacture and sale of headed nipples specially contrived and adapted for the sole purpose of being incorporated as parts of the Butler invention as manufactured and sold by his assignee.

As contrasted with such a simple and straightforward effort to profit from the manufacture and sale of the whole of the invention of the patent in suit, and in no other way whatsoever, let us observe what considerations were expressed in Mr. Justice Brandeis' opinion as the basis for the conclusion reached in the case of Leitch vs. Barber.

(1) At the outset, the Court points out in its opinion that Barber and Leitch "are competing manufacturers of bituminous emulsion."

Road contractors had been purchasing such bituminous emulsion from these concerns and from other concerns for a period of thirty or forty years.

- (2) The Court points out that this bituminous emulsion is "an unpatented staple article of commerce produced in the United States."
- (3) It points out that it was produced "by many concerns."
- (4) The Court points out that this bituminous emulsion was "in common use by their customers for many purposes."
- (5) It is said that "By builders of macadam roads, the emulsion has long been used as a coating for crushed stone and otherwise."

- (6) The Hayden patent in suit was for a process of concrete road building in which the concrete was to be sprayed on the surface of the roadway to retard evaporation of moisture from the concrete during its curing. But the Barber Company, having acquired the Hayden patent, never once used the patented process in its own business. Never once did it sell any product produced in and by the use of the process. As the Court points out in its opinion, "The company does not itself engage in road building."
- (7) "The company does not • compete with road contractors."
- (8) "It does not seek to make road builders pay a royalty for employing the patented method."
- (9) "It does not grant to road builders a written licenseto use the process." (A footnote says that the Barber
  Asphalt Company, the predecessor of the plaintiff, Barber
  Company, Inc., had granted a written license to JohnsonMarsh Corporation. The consideration was not, however,
  the payment of any royalties but rather an obligation or
  expectation that the Johnson-Marsh Corporation would
  buy "from the Barber Asphalt Company Cutback material" for use in the east, and "Trinidad or Bermudez
  asphalt" for use in the west.")
- (10) "But it adopts a method of doing the business which is the practical equivalent of granting a written license with a condition that the patented method may be practiced only with emulsion purchased from it."
- (11) "Thus, the sole purpose to which the patent is put is thereby to suppress competition in the production and sale of staple unpatented material for this use in road building."

We believe that this sentence was intended to contrast and highlight the use and purpose to which the Barber Company put its patent as compared with such a statutorily intended use and purpose as that to which the Stewart-Warner Corporation has put its patent, i. e., to practice the invention of the patent by the manufacture, use or sale of it.

(12) There is significance, we think, in the manner in which Mr. Justice Brandeis' opinion describes the action of the Third Circuit Court of Appeals. He says that the Court of Appeals "sustained the validity of the patent." This question of validity was not even brought up by the writ of certiorari. He says that the Court of Appeals "concluded that there was contributory infringement." Neither of these conclusions was disturbed in any customary sense by the Supreme Court. The significant phrase in Mr. Justice Brandeis' description of the action of the Court of Appeals is that in which he said that the Court

"held that maintenance of the suit was not forbidden by the rule declared in Carbice Corp. v. American Patents Development Corp., 283 U. S. 27, 75 L. Ed. 819, 51 S. Ct. 334."

The conclusion of the Supreme Court was, of course, that "maintenance of the suit was forbidden" by the rule declared in the Carbice case. A consideration, therefore, of the controlling factors in the Carbice decision as they are enumerated in the decision in the Leitch case, will be further illuminative of the real grounds of the decisions in both cases, and of the fundamental principle upon which both were based.

The following are, then, the facts and the only facts of the Dry Ice case which are set forth in Mr. Justice Brandies' opinion in the Leitch case, as determinative of the conclusion in the Dry Ice case.

(1) "The sole business of the Dry Ice Corporation was to make and sell Dry Ice—which is an unpatented material."

- (2) "It did not make or sell transportation packages in which Dry Ice was used as a refrigerant." The Slate patent in suit claimed such a transportation package as the invention which was sought to be covered.
- (3) "It did not issue to other concerns licenses to make such packages upon payment of a stipulated royalty."
- (4) "It did not formally license buyers of its Dry Ice to use the invention in suit."
- (5) "But each invoice for Dry Ice bore a notice in effect that the patented container could be used only with Dry Ice purchased from the corporation."

In its opinion in the Leitch case the Court pointed out that in declaring that relief must be denied in the Dry Ice case, it said certain things;—more particularly that: "Control over the supply of such unpatented material is beyond the scope of the patentee's monopoly." It said that "this limitation" was "inherent in the patent grant." It said that "this limitation" "is not dependent upon the peculiar function or character of the unpatented material or on the way in which it is used." This means, we think, that it was unimportant whether the material had or did not have peculiar functions or characteristics dependent upon the way in which it cooperated in the combination, or the alleged combination, of the patent.

We think that our understanding in this regard is confirmed by the immediately succeeding sentence in which it was said that

"Relief is denied because the Dry Ice Corporation is attempting, without sanction of law, to employ the patent to secure a limited monopoly of unpatented material used in applying the invention."

In its opinion in the Leitch case, the Court went on to quote further from its opinion in the Dry Ice case. The quotation comprises a reiteration of the salient facts that, "The plaintiffs neither sell nor license others to sell complete transportation packages. They supply merely one of several materials entering into the combination." The passage quoted from the opinion in the Carbice case then goes on to say that the plaintiff's "attempt to secure" "a monopoly" "on that commodity" "cannot be sanctioned." The reason lay in the conduct of the plaintiffs in their misuse or abuse of their rights of inherently limited monopoly as conferred upon them by the patent statutes. Having misused and abused what might have been their right to a limited monopoly under the patent statutes, they could not, as the Court elsewhere phrased it, "maintain a suit" in equity for an alleged contributory infringement.

The opinion in the Leitch case next refers to the Barber Company's contentions that the rule of the Carbice case was not applicable to the situation in the Leitch case.

In view of the controlling facts which had been previously enumerated and as we have just quoted them in full, the Court swept aside these contentions and attempted distinctions, with the statement that they were "without legal significance."

In Its Opinion in the Case of Leitch vs. Barber the Supreme Court Explained Why the Barber Company's Attempted Distinctions Were of No Legal Significance.

We stress now the Court's explanation of the reasons why the Barber Company's attempted distinctions were of no legal significance.

#### The First Reason.

(1) It was said "that the Court held in the Carbice Corp. case that the limitation upon the scope or use of the patent which it applied was 'inherent in the patent grant.' "Obviously, the "use of the patent" and the "scope" of the

patent were limited by the patent grant, and were, as the Court said, "inherent in the patent grant." According to the patent grant, the limited and permissible "use of the patent" was to exclude others from making or using or selling the invention of the patent. It was because of the plaintiff's attempt to use the patent in furthering their purpose to suppress competition in the merchandising of a staple and unpatented commodity or material, that they were held to have lost any right to ask a court of equity to enforce what might otherwise have been their limited patent monopoly. The fundamental principle of the decision is, as we see it, such that the plaintiffs had forfeited their right to relief either against an alleged complete and direct infringer or against an alleged contributory infringer.

# Judge Wilkerson's Understanding of the Decision in Leitch vs. Barber as Expressed in His Opinion of February 16, 1938 in the Case of Lecithin vs. Warfield.

Such was the understanding and conclusion of his Honor Judge Wilkerson, sitting in the District Court for the Northern District of Illinois, in the very recent case of American Lecithin vs. Warfield Company (February 16, 1938,—not yet reported). Judge Wilkerson refused to grant relief to the plaintiff under a bill alleging direct and complete infringement as distinguished from so-called contributory infringement. In so doing, Justice Wilkerson said in his opinion:

"Plaintiff's method of doing business is as follows: It does not issue any formal license to anyone to use its patent. It does not itself make chocolate and does not collect royalties from others for the use of its process. Upon the purchase from it of lecithin, the plaintiff acquiesces in the use of its patent. When the lecithin thus sold by plaintiff has been used up by the customer, this acquiescence, as well as the permissive use of the patent, allegedly ceases. See American Lecithin Co. v. Ferguson, 19 F. Supp. 294, 300.

"I am of the opinion that this method of doing business falls within the condemnation of the recent case of Leitch Mfg. Co., Inc., v. Barber Co. (82 L. Ed. 276-1938) as the 'practical equivalent of granting a written license with a condition that the natented method may be practiced only with' lecithin purchased from it. To use the language of the Leitch case, 'the sole purpose of which the patent is put is thereby to suppress competition in the production and sale of staple unpatented material for' use in chocolate mak-

"In the Leitch case, the plaintiff and the defendant were competing manufacturers of bituminous emulsion, an unpatented article of commerce. Builders of cement concrete roads had come to use emulsion as a film on the surface of the roadway to retard evaporation during curing. The plaintiff acquired the process patent sued upon, which covered a method of retarding this evaporation. The company did not itself build roads, it did not require royalties, and it did not issue licenses. Any road builder who bought emulsion from it received, by implication of law, authority to practice the invention. The defendant was a competing manufacturer of the unpatented material, who sold it to a road builder for use with the patented process. The Supreme Court held that the patent did not confer upon the plaintiff the right to be free from competition in supplying unpatented material to be used in practicing the invention.

"While the Leitch case involved a contributory infringer. I believe that its doctrine is applicable in the present suit against the alleged direct infringer. doctrine so clearly formulated in the Leitch case grows out of the case of Carbice Corp v. American Patents Development Corp., 283 U. S. 27, 75 L. Ed. 819. While that case also involved a suit against a contributory infringer, it was thought that its doctrine would be extended to direct infringers and that the opinion might be taken to mean that an otherwise valid patent right would not be enforced to prevent even direct infringement when the patent was being utilized to gain a monopoly beyond its legitimate scope. 45 Harvard Law Review 1119 (1932). The Supreme Court itself in the Carbice case (p. 31) took cognizance of the fact that in some jurisdictions it had been held (Huntoon Co.

v. Lolynos (1930) 1 Chancery 528) that the insertion of a condition in a license agreement that unpatented materials used in connection with the invention should be purchased only from the licensor, established a com-

plete defense to a charge of infringement.

"The language in the Leitch case indicates that the reasons for denying relief in this type of case rest upon broad policy grounds and not upon narrow legal distinctions. The court in the Carbice as well as in the Leitch case denied relief because the owner of the patent monopoly sought by its method of doing business to extend its monopoly to unpatented material. in contravention of the limitations inherent in its patent grant. By the rule declared in those cases, 'every use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process. It applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly.' Leitch Mfg. Corp., Inc., v. Barber Co., 82 L. Ed. 276, 278 (1938). In my opinion, the doctrines also apply whether the person sued be a direct or a contributory infringer. The operation of the principle of public policy does not distinguish between the two.

"I accordingly find that the plaintiff is not in a position to maintain this suit. In view of the foregoing conclusion, it is not necessary to pass upon the validity of the patent or defendant's claim to a shop license for the life of plaintiff's patent. The bill should,

therefore, be dismissed."

## The Second Reason.

(2) The reason as secondly given why this Court in the Leitch case swept aside the insignificant distinctions attempted to be advanced by the Barber Company, was that the Dry Ice Company was

"denied relief, not because there was a contract or notice held to be inoperative, but on the broad ground that the owner of the patent monopoly, ignoring the limitation 'inherent in the patent grant,' sought by this method of doing business to extend the monopoly to unpatented material used in practicing the invention."

## The Third Reason.

(3) Referring further to its decision in the Carbice case, Mr. Justice Brandeis said in his opinion in the Leitch case: "By the rule there declared, every use of a patent as a means of obtaining a limited monopoly of unpatented material, is prohibited."

It would seem to be clear beyond question that this prohibition would apply to every patentee who attempted any such misuse or abuse of his limited patent monopoly, and regardless whether he attempted to proceed against an alleged complete and direct infringer or against an alleged contributory infringer. If, in other words, the patentee violates or disregards the prohibition, he cannot secure any kind of relief in equity based upon what otherwise might have been his inherent right to a limited monopoly.

# The Fourth Reason.

(4) The Court went on to make it clear that this rule of prohibition (and obviously it necessary corollaries) "applies whether the patent be for a machines, a product, or a process." The patentee's every attempt to extend his monopoly beyond the purview of the monopoly inherent in the patent grant, is to be met by a denial of relief in equity, regardless whether the patent be for a machine, a product, or a process.

## The Fifth Reason.

(5) Finally, it was said that the rule "applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly."

Thus, even to the Court's final statement in explanation of the rule and the reason for the rule of the Carbice case,

it is the inequitable and contra-public-policy conduct of the plaintiff in and about his patent, which constitutes the test of the applicability of the rule. The conduct of the defendant in a patent suit brought by such a disqualified plaintiff, can be of no consequence. It can have no bearing whatsoever upon the outcome.

With respect to such a rule as this, it is obvious that nothing in Leeds & Catlin vs. Victor could modify or affect it. "That was an ordinary case of contributory infringement" (Carbice opinion). The Victor Company had not attempted by any device whatsoever to use its patent or to adopt a method of doing business such as would unwarrantably extend its monopoly, and as corollary forfeit its right to the relief which it might otherwise have had in a court of equity. In the concluding sentence of his opinion, Mr. Justice Brandeis said as much:

"Nothing in Leeds & C. Co. v. Victor Talking Mach. Co., 213 U. S. 325, 53 L. ed. 816, 29 S. Ct. 503, limits it."

Summarizing Then, Relative to the Decisions in the Carbice Case and in the Case of Leitch vs. Barber: Nothing in These Decisions Can Properly Be Interpreted as Granting Immunity to a Joint Participant in the Tort of Patent Infringement,—Provided, of Course, That the Conduct of the Patentee Has Not Been Such as to Deprive Him of the Right to Any Relief in a Court of Chancery.

We have canvassed almost word by word every paragraph of the opinions in the Carbice and Leitch vs. Barber cases. If we understand what they say and what they mean, they can have no applicability whatsoever to the present case. They can have no applicability to any case in which the patentee simply goes about the business of making or using or selling the whole of the invention described and claimed in his patent.

Not one of the considerations described by the Court as constituting the reasons why relief was denied in the Carbice and Barber cases, is applicable to any feature of the Stewart-Warner Company's conduct in respect of the Butler patent in suit.

Now, in concluding our long discussion of the case of Leitch vs. Barber, it may be well to recall the fact that we have been examining the case to see whether it supports the contention that it abolished all of the accumulated and long-enforced law of contributory patent infringement.

This much is certain: The Carbice case did not in words overrule the law of contributory infringement as set forth in Leeds & Catlin vs. Victor (and in scores of other cases in all of the federal courts for a period of more than sixty years); in the subsequent case of Rogers vs. Alemite, the Court still recognized "an ordinary case of contributory infringement" as represented by Leeds & Catlin vs. Victor; in the still later case of Leitch vs. Barber, the Court did not expressly overrule the Leeds & Catlin case; it did not expressly abolish the doctrine of contributory infringement.

Despite the opinions which various lawyers have written and expressed, any reasonably careful study and analysis of these recent decisions by the Supreme Court will make it clear beyond peradventure that the Court has not by implication or inference, attempted to abolish the doctrine or the law of contributory infringement. There is nothing in any of these cases which, in a case having the requisite background of equity, precludes the application of the long-established law of contributory infringement. Nothing in these decisions can properly be interpreted as granting immunity to a joint participant in the tort of patent infringement,—provided, of course, that the conduct of the patentee has not been such as to deprive him of the right to any relief in a court of chancery.

The Facts of the Instant Case Exactly Parallel the Facts of Leeds & Catlin v. Victor, 213 U. S. 301 and 325,—from Which the Supreme Court Distinguished the Carbice Case and the Leitch Case.

We turn now to the fourth case upon which the petitioner seeks to place its reliance, namely, the case of Leeds & Catlin v. Victor, 213 U.S. 301 and 325.

In this instance, of course, the petitioner's reliance must necessarily take the form of an effort to distinguish the present case from the case of *Leeds & Catlin* v. *Victor*.

If our understanding of the Carbice and Leitch decisions is substantially correct, they do not afford any avenue of escape to the defendant petitioner,—because the Stewart-Warner Corporation's methods and policies of doing business,—its use of the patent in suit, have been such as to entitle it to such protection as a court of equity can and will afford. None of the reasons for "denying relief" in the Carbice and Leitch cases can be found in the instant case.

On the other hand, the facts of the present case parallel so exactly the facts of *Leeds & Catlin* v. *Victor*, that unless that case has been overruled, it would seem to control the present case in so far as the law and the application of the law of contributory infringement are concerned.

Under the circumstances, counsel for the petitioner have evolved and urged upon the court a novel doctrine which they would like to have regarded as the authoritative present and future doctrine of contributory infringement. They propose that every patented combination shall be dissected into its several elements and that each of the several elements be rated as separately new or separately old. Their proposal is that anyone and everyone shall have the right to furnish any or all of the old elements with knowledge and intent that the purchaser will in-

corporate them into the combination of the patent in suit. Their proposal is that in the case of any element which is separately new and patentable, then third parties shall not have the right to supply that particular element with corresponding knowledge and intent.

It is obvious, as was pointed out in the opinion of the Seventh Circuit Court of Appeals in this case, that any such rule would revolutionize the law of patents. The reason is that almost every invention, great or small, involves simply a new combination of elements, each of which is separately old. If, with appropriate knowledge and intent, anyone and everyone is free to contribute all of the separately old elements of a new combination, then a patentee would be left with no practically useful remedy against the most wholesale invasion of his patent rights. It would be possible for every contributor to the ultimate making or using or selling of the invention of the patent in suit to show that his elements, broadly and generally considered, was an old element. Every contributor would point to someone else as the contributor of the new and patentable element,-if any.

The petitioner's theory would, of course, destroy, in effect, approximately eighty-one per cent of all patent claims. The reason is that the very assumption that the real invention of a new combination must inhere in some one element or in some minor group of elements means that the patent should be taken out upon the one new and patentable element or minor group of elements. The very suggestion that the invention could always or often be found to inhere in some one element presupposes that there is always some one element of a new combination which in and by itself can withstand the necessary tests of novelty, utility, invention, etc.

The theory proposed by counsel for the petitioner is rendered completely untenable by a hundred years of experience in the analysis and definition of patentable inventions. It is rendered untenable by the classic definitions of patentable combinations as set forth in the *Leeds & Catlin* cases (and in other earlier but less successful statements of the matter).

Nevertheless, counsel for the petitioner feel the need of adapting their proposed new theory to the decisions of the Supreme Court in the cases of Carbice, Leitch, Rogers, and Leeds & Catlin. So they proceed to find that in the cases of Carbice, Rogers, and Leitch the defendants were engaged in the sale of old and separately unpatented elements or. commodities. If true, this may or may not have been a coincidence. The fact, if true, would lack significance unless counsel can find that in the Leeds & Catlin case the defendant was engaged in furnishing an element which in and of itself was separately new and patentable. (The acceptance of their new theory would require also a demonstration that the liability of the defendant in the one case and the immunity of the defendants in the other three cases was, in fact, based upon an examination and determination of the novelty and patentability or the antiquity and unpatentability of the element supplied by each defendant. have seen that no such examination or determination was a factor in the reasoning of the opinions either in the Carbice case, or the Rogers case, or the Leitch case.) We shall see also, that it was not a factor in the Leeds and Catlin case,

Nevertheless, counsel for the petitioner direct their attention to the *Leeds & Catlin* case in the hope of finding that the disk record with its spiral groove of even depth and with laterally undulating side walls was a separately new and patentable element at the date of the application for the Berliner patent in suit No. 534,543.

In so doing, they quote certain phrases from the opinion of the court in 213 U.S. 325 and then jump to the utterly

erroneous conclusion that the court was describing these particular forms of record as new and patentable in and of themselves and as indeed constituting something which might appropriately be regarded as the real heart and soul, the so-called gist or essence of the invention of the claim in suit.

A simple test will show the unwarrantability of counsel's conclusions: We say that disk records with spiral sound grooves of even depth and laterally undulatory side walls were old and well known long prior to the application for Berliner patent No. 534,543. We say that Berliner did not and could not at that date have secured a valid patent upon this element for the reason that it was separately old and well known at that time. We say that the only structural novelty in the Berliner combination inhered in the phonograph machine, i. e., in such pivotal mounting of the reproducing stylus as would make it free to be propelled across the face of the record by the spiral groove of the record (the fact being that in all of the prior art the phonograph machine had always been provided with a feed device,-usually in the form of a lead screw, for conveying the stylus across the face of the record or for laterally conveying the record relative to the stylus).

For the moment we pause simply to inquire whether the two fragments of the opinion as quoted by counsel for the petitioner on pages 58 and 59 of their brief would not be entirely consistent with such a factual situation as we have stated it to have been.

In the first place, the claim in suit of the Berliner patent read as follows:

"35. In a sound reproducing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described."

It is obvious that the language in which the record part of the combination was here described is broad enough to cover any and every form of phonograph record, i. e., cylindrical tablets as well as disk tablets,—and tablets having hill and dale grooves of varying depth as well as records having sound grooves of more or less even depth and with laterally undulatory side walls.

The fact of the matter is further that

"a reproducing stylus shaped for engagement with its associated record and free to be vibrated and propelled by the same"

would be caused to travel across the face of the record or tablet, regardless of the particular style of tablet or sound greove.

Any of the old and well-known records or tablets would cause the stylus and its associated diaphragm to vibrate and any of the old and well-known records would cause the stylus and its associated sound box and pivoted tone arm to be propelled by the groove of the record,—provided, of course, that the stylus be pivotably mounted so as to be free for such propulsion.

When under these circumstances the court said, as quoted and stressed by counsel for the petitioner, that

"It will be observed how important the record is to the invention embodied in the claims",

the court was stressing the importance of the new cooperative relationship between the record and the stylus. As a result of Berliner's new combination, the record groove acquired the new function of "propelling" the stylus across the face of the record.

It was true of the phonographs of the art prior to the Berliner patent in suit that, as stated by the court in its opinion,

"the undulations in the side walls of the spiral groove

vibrate the stylus back and forth, transmitting the recorded sound waves to the diaphragm."

All of that was old and well-known. The court went on, however, to point out the new function which was acquired by the sound groove of the tablet because of its new association with a stylus which was freed from any feed device and which was pivotally mounted in such a way as to swing across the record in response to the new propelling action of the sound grooves. It was with this new function in mind that the court went on to say that in the new combination the spiral groove of the record had the function at the same time of "propelling the stylus as it engages with the record." Having in mind this new function of the sound groove of the tablet, the court said that as high a degree (if not a higher degree) of importance (not, of novelty!) "must be awarded to the disk" as to the stylus. The incidental reference to the "lateral undulations" of the groove was simply descriptive of one form of sound groove coming within the broad language of the claim in suit. The court said:

"It is the disk that serves to distinguish the invention,—to mark the advance upon the prior art."

The advance upon the prior art was the automatic propulsion of the stylus and its tone arm by the sound groove of the record itself, as distinguished from the prior propulsion by the mechanically driven feed device. The distinction of the invention of the Berliner patent in suit No. 534,543 was, therefore, the propulsion of the stylus by the disk or tablet,—as contrasted with the propulsion of the stylus by a feed screw.

Certainly, therefore, when the court said that

"It is the disk that serves to distinguish the invention,—to mark the advance upon the prior art"

it was not saying, as counsel for the petitioner would have it say, that the disk record with a spiral groove of even depth and lateral undulations in the side walls, was in and of itself a new thing or something which was separately patentable.

Furthermore, the court was certainly not attempting to say that the broadly stated "traveling tablet having a sound record formed thereon", as it appeared in Berliner's claim, was for any purpose whatsoever to be construed as limited to a disk form record or to a record having a spiral sound groove of even depth or to a sound groove with laterally undulating side walls. The whole of the broad, and all-inclusive descriptive language of the claim was, "a traveling tablet having a sound record formed thereon."

Counsel for the petitioner refer to another phrase picked from the opinion of the court in the second Leeds & Catlin case.

"Indeed, as we have seen, it is the distinction of the invention, constituting by its laterally undulating line of even depth and the effect thereof, the advance upon the prior art."

"And the effect thereof!"

The distinction of the invention was, indeed, the effect of the sound groove in automatically propelling the stylus and its associated sound box and tone arm across the face of the record. That was the one new and unitary result of the invention! In referring to the new function or effect of the sound groove in propelling the stylus across the face of the record, the court did speak of the sound groove as having a "laterally undulating line of even depth". This specificity relative to a particular form of groove was, however, quite irrelevant to the real point of the court's statement. As we have seen, the claim of the patent was not limited to this or any other particular type of sound groove. Furthermore, a tablet or record having this particular type of sound groove had become a part of the

prior art many years before Berliner's invention of his patent in suit No. 534,543.

The opinions of the lower courts in the instant case particularly state the facts of the Leeds & Catlin case to be as we have here stated them to be. At a later point we shall refer Your Honors to the parts of the record which confirm the accuracy of our factual statements and those of the District Court and of the Court of Appeals herein.

For the moment we say simply that the new theory,—the new test of contributory infringement, as now proposed by counsel for the petitioner, cannot be reconciled with the facts of the Leeds & Catlin case. Regardless whether it be called "a travelling tablet having a sound record formed thereon", as stated in Berliner's claim, or a disk record having a spiral groove of even depth and laterally undulating side walls, as counsel for the petitioner would have it,—the fact of the matter is that that record was both broadly and specifically as old as "old" need be, in so far as the invention of Berliner's patent No. 534,543 is concerned. Such phonograph records with such specific grooves, as well as other records with other kinds of grooves, antedated Berliner's invention by several years.

Upon the basis of the real facts it is entirely impossible, therefore, to find any distinction whatsoever between the Leeds & Catlin case on the one hand, and the Carbice, Rogers, and Leitch cases on the other hand, in so far as the novelty or antiquity of the element supplied by the defendant is concerned. There is no such distinction as that which counsel for the petitioner formulate and rely upon.

In attempting to determine the real meaning of the three cases (Carbice, Leitch, and Leeds & Catlin)\* which we have been discussing as a result of the petitioner's cita-

<sup>\*</sup>As we have seen, the Rogers v. Alemite case went off on grounds other than those now under consideration.

tions, it is essential to know that in each and every one of these cases, the thing furnished by the defendant was separately old and unpatentable.

The real distinction of the Leeds & Catlin case was and is that the Victor Talking Machine Company simply went about the business of making and selling the whole of the invention of the Berliner patent. It did not do any of the things which caused the court to refuse to grant relief to the plaintiffs in the Carbice, and Leitch vs. Barber cases.

Furthermore, the manner in which the Victor Talking Machine Company went about its business of making and selfing the whole of the invention of the Berliner patent is paralleled in a remarkable degree by the manner in which the Stewart-Warner Corporation went about its business of making and selling the whole of the invention of the Butler patent in suit.

It is evident, of course, that in a lubricating system of the kind described in the Butler patent, the complete combination of all of the seven elements of claim 2 is brought together only periodically and temporarily,—and then too, only in the hands of the ultimate user.

The manufacturer cannot sell the completed combination intact. No one wants to buy the completed combination intact. What the ultimate user of the lubricating equipment of the Butler patent desires is to buy from the manufacturer such a number and such an assortment of nipples as may be required for permanent association with each of the bearings of his automobile or other machinery. He wishes then to have the use of a single compressor and coupler which he may connect periodically with each of his many nipples.

Some automobile owners wish to grease their own cars; others wish to have this greasing done at more or less public service stations and garages.

What the purchaser desires to buy and what the manufacturer necessarily makes, is therefore an assortment of nipples having interconnecting parts of identically the same form and dimensions but whose shanks are provided with various different lengths, angles, and thread sizes. The sale of this kind of lubricating equipment requires, therefore, that the manufacturer separately list and price each of the various kinds of nipples and that he separately list and price each of the various sizes of compressor which may be interconnected and thus temporarily combined with any one of the assorted nipples. This leaves the purchaser free to purchase the particular assortment of nipples best adapted to the lubrication of his own particular automobile or machine.

An automobile owner who invariably has his car greased at a public service station or garage, has no use whatsoever for the compressor and coupler parts of the complete combination. On the other hand, a garage man who greases nothing but other people's automobiles, has no need to buy the nipple parts of the combination for his own use.

Speaking by and large, it is only at the moment of greasing a bearing that the complete combination is ever brought together. This may be at the hands of the ultimate user or it may be at the hands of the garage man.

All of these characteristics parallel in a remarkable degree those involved in the phonograph litigation.

Speaking generally, the Berliner patent No. 534,543 covered the combination of a phonograph machine and a phonograph record. The Victor Company, the owner of the phonograph patent, necessarily met the desires and needs of its customers by separately listing and pricing the phonograph machines and by separately listing and pricing the phonograph records.

Each of the component parts of the complete combina-

tion was made in the variety of styles and sizes adapted to the needs and tastes of the ultimate users. Each purchaser could select the particular assortment which would strike his needs or his fancy.

The close parallelism between the methods employed by the Stewart-Warner Corporation in conducting its business of manufacturing and selling the complete combination of the Butler patent in suit, and the methods by which the Victor Company engaged in the manufacture and sale of the complete combination of the Berliner patent, is natched by a similarly close parallelism between the activities of the Lincoln Engineering Company in the one case and the Leeds & Catlin Company in the other case.

The Leeds & Catlin Company engaged in the manufacture and sale of disc records having spiral sound grooves essentially like those of the Victor records. The purchaser of a Leeds & Catlin record could combine it with the phonograph machine which he had purchased from the Victor Company, thereby organizing and enjoying the complete combination of the Victor Company's Berliner patent. The suit against Leeds & Catlin alleged contributory infringement of the Berliner patent in and by the sale of records which their purchasers would thus combine with the Victor Company's talking machines. In addition to various defenses going to the validity of the patent in suit, the Leeds & Catlin Company defended upon two grounds,

(1) that when the Victor Company sold the phonograph machine parts of the combination, the purchaser was impliedly licensed to make for himself or to buy from Leeds & Catlin the record parts necessary to the

enjoyment of the phonograph machine; and

(2) that Leeds & Catlin had made and sold a phonograph machine with which the Leeds & Catlin Company's records might be combined and used, and in which a feed screw was provided for moving the needle across the face of the revolving disc record,-thereby avoiding that feature of the Berliner combination which called for a reproducing stylus so mounted as to be free to be propelled by the sound groove of the record, not by any extraneous feed screw but by the coaction of the spiral sound groove of the disc itself with the stylus needle and its associated diaphragm and tone arm.

Despite the pretense of innocence provided by the Leeds & Catlin Company's feed screw machine, and despite the fact that the use of the Leeds & Catlin Company's records in combination with the Leeds & Catlin Company's phonograph machine of the feed screw type, would not, as was conceded by the courts, embody or contribute to the infringement of the Berliner patent, the Supreme Court sustained the Second Circuit Court of Appeals in enjoining the Leeds & Catlin Company against the further sale of its disc records for use in the combination of the Berliner patent. The ground of the decision was of course that the sale of these records, which were so completely and perfectly adapted for use with the hundreds of thousands of Victor phonographs already in the field, and which were manufactured and sold with the knowledge and intention that the purchasers would so combine and use them, was a contributory infringement,-and this despite the fact that there was a possible way in which the Leeds & Catlin records could have been used-in conjunction with the feed screw machine-without involving any infringement of the Berliner patent.

In the instant case the petitioner, Lincoln Engineering Company, like the Leeds & Catlin Company, endeavored to develop some similar pretense of innocence as to the knowledge, purpose, and intent with which it sold the headed nipple parts of the Butler combination. Upon the trial in the District Court, the Lincoln Company devoted much effort to an attempt to show that its headed nipples were made and sold for innocent use in connection with "needle nozzles,"—or at

any rate, that the plaintiff had not been able to prove that the Lincoln nipples were sold with knowledge and intent. that the purchasers would and should combine them in use with the other parts of the Butler combination as manufactured and sold by the Stewart-Warner Corporation. This pretense was completely swept aside by evidence showing that the Lincoln Company had first made up some samples of nipples which did not have the groove and head of the Butler patent, and which could not, therefore, be combined in use with the compressor and coupler parts manufactured and sold by the plaintiff under the Butler patent in suit. These round-headed and straight-sided fittings were, however, perfectly adapted to all of the innocent uses proclaimed by the Lincoln Company. The Lincoln Company endeavored to sell these round-headed and straight-sided nipples to the General Motors Corporation, but without success. Finally, in the fall of 1934, a groove and a head were added to the Lincoln nipples in such perfect form, location, and dimensions that they could be incorporated as perfectly coacting parts of the Butler combination as sold by the Stewart-Warner Corporation. Then, and then only, did the General Motors Corporation and others begin to buy and to use the apple parts as sold by the petitioner.

All of the facts in this regard were presented to the District Court. Both the District Court and the Court of Appeals are agreed upon the basis of rather overwhelming evidence, that the Lincoln Company did, some eighteen months after the advent of the Butler invention upon the market, design, manufacture, and sell its headed nipples with the knowledge and intent that the purchasers would incorporate them as parts of the invention of the Butler patent in suit.

Now, in this Court, the petitioner does not even advance

the contention that its headed nipples were designed or manufactured or sold with any such innocent purpose or intent as was claimed in the District Court.

The only essential difference, then, between the Leeds & Catlin Company and the Lincoln Engineering Compay in this Court, is that the Lincoln Company has now dropped its camouflage, whereas the Leeds & Catlin Company relied to the end upon its camouflage.

In Our Previous Discussion of the Leeds & Catlin Case, We Have Asserted the Fact to Be That In and Of Itself the Record Disc Was Not a Novel Element of the Combination of the Berliner Patent in Suit No. 534,543. We Propose Now to Show in Some Detail That It Was In and Of Itself An Old and Well-Known Element.

In our previous discussion, we have stated the fact to be that in and of itself the record disc of the Leeds & Catlip case was not a novel element of the combination of Berliner patent No. 534,543. In and of itself it was an old and well-known element.

The petitioner's contentions in this Court hinge largely upon the assertion that the disc record of the Berliner patent No. 534,543, was in and of itself a novel and separately patentable element. They make this contention the basis of their attempted distinction between the Leeds & Catlin case on the one hand and the Carbice and Barber Asphalt cases on the other hand.

Despite the conclusions of the lower courts that counsel for the petitioner were all wrong in the factual basis for their argument, it may be worth while to outline briefly the reasons which the lower courts had for deciding the instant case upon the understanding that the disc record of the Leeds & Catlin case was in and of itself an old and well-known element.

It is first to be observed that at the very outset of his patent 534,543, Berliner says that

"My invention has reference to improvements in the method of and apparatus for recording and reproducing sounds, the improvements being more particularly directed to the construction of that kind of sound recording and reproducing apparatus which I have called 'gramophone,' and for which Letters Patent of the United States. No. 382,790, dated May 15, 1888, have been granted to me." (Page 1, lines 8 to 16.)

(This and the other early Berliner patents were issued more than two years prior to Berliner's application for patent 534,543 and are therefore of the "prior art" as against Berliner, in so far as patent 534,543 is concerned.)

One of the features of Berliner patent 534,543 was the use of a constantly flowing bath of alcohol over the face of the disc record or its proto-type during the operation of recording. With this matter, we are not here particularly concerned, but the language used by Berliner in describing this alcoholic detail in connection with the engraving of the initial or master record, makes it clear in several ways that disc records with laterally undulatory sound grooves were acknowledged by Berliner to be old and well-known in and by patents long antedating the application for patent No. 534,543.

If now we turn to page 2, line 77 of the Berliner patent No. 534,543, we find that

"When a sound record is to be made, a record tablet of the kind described in my aforesaid Letters Patent, is placed upon the rotary table 4, and this record tablet is represented in the drawings as a circular disk 44 which has a central perforation passing over the upper end of the shaft 2."

The "aforesaid Letters Patent" are this same number 382,790, as previously mentioned on line 16 of page 1. It is to be noted that the record tablet of the early patent is described as having the form of a "circular disk."

In further describing the formation of the record, Berliner says at page 4, line 39 of his patent 534,543:

"The vibrations of the diaphragm thus produced will cause the stylus to make a tracing of an undulatory line, corresponding to the sound waves directed against the diaphragm; all as described in my aforesaid Letters Patent."

This refers again to the same early Patent 382,790.

Berliner then points out that

"In accordance with the said (early) patent, alcohol is poured once for all over the tablet, and is allowed to evaporate during the process of recording." (page 4, line 53.)

This is contrasted with the new detail of the new patent, relative to which Berliner says:

"During this whole time a thin stream of alcohol is delivered upon the plate 46 and the alcohol spreading out in all directions is maintained as a uniform and constantly renewed film upon the tablet. In this manner every part of the record is made under alcohol, and in this respect my present invention differs from the process set forth in my aforesaid Letters Patent." (page 4, line 44)

It was this constantly flowing bath as contrasted with the once and for all dose of alcohol which distinguished the process of patent 534,543, from Berliner's earlier and previously patented method. Obviously the resulting disc records would not differ from one another in the slightest degree except as the flowing bath might aid in producing a less scratchy and therefore more perfect record of the same identical character as that of the earlier patent.

In other words, Berliner's patent 534,543 presented the record disc or tablet itself as being just what it was—a disc or tablet identical with that disclosed in his earlier pat> ent. This early disc-record was described by Berliner himself as having all of the characteristics which counsel for

the petitioner ascribe to the allegedly new disc-record of patent 534,543.

Berliner himself says in effect, in the 1892 application for his 1895 patent No. 534,543, that the record of his earlier patent, issued in 1888, was a disc record with a spiral sound groove of uniform depth having lateral undulations therein. In 1888 the sound groove of this disc record had the sole function of vibrating the stylus of the reproducing phonograph, in which of course the stylus was fed across the face of the record by an appropriate lead screw geared to the turntable of the machine. This old and well-known disc record never, of course, had the experience of meeting a phonegraph machine with a free swinging stylus, until there was a phonograph machine with a free swinging stylus. (We use the picturesque language employed by counsel for the petitioner on page 24 of their brief in discussing the Butler combination.) The meeting (and mating) occurred in 1892. Then it was that Berliner combined the old disc record with a phonograph machinehaving a stylus so pivotally mounted that it could swing freely across the face of the disc record. Thereupon, the spiral sound groove of the record acquired a new function and participated in a new coaction whereby the sound groove now, not only vibrated the stylus to produce sound. waves, but also propelled the stylus and its associated reproducing diaphragm and tone arm across the face of the record. In this way the old disc record participated in accomplishing the real aim and result of the invention, i.e., the elimination of the lead screw mechanism which there tofore had always been required.

The Berliner patent 534,543 contains much more than we have quoted in confirmation of Judge Lindley's understanding of the Berliner patent.

One of the confirmatory facts is the claims of patent 534,543. Some of them are for methods involving the continuous flow of the alcohol bath. Others are, however, for various parts of the gramophone apparatus. There is no reason in the world why Berliner should not and would not in his patent 534,543 have claimed the disc record or tablet in and of itself, if indeed this disc record or tablet were new, as asserted by counsel for the appellant, rather than old, as stated in the Berliner patent itself.

Furthermore, however, an examination of Berliner patent No. 372,786 of November 8, 1887, shows that

This invention has reference to a novel method of and apparatus for recording and reproducing all kinds of sounds, including spoken words, and is designed to overcome the defects inherent in that art as now practiced and in the apparatus used therefor." (page 1, line 8.)

The very thing which Berliner claimed in this early patent of 1887, was:

"The method or process of recording and reproducing spoken words and other sounds, which consists in first drawing an undulatory line of even depth in a traveling layer of non-recisting material by and in accordance with sound vibrations, then producing the record thus obtained in solid resisting material, and finally imparting vibrations to a sonorous body by and in accordance with the resisting record, substantially as described."

This obviously was the method of producing records or tablets having precisely the characteristics of the disc records or tablets employed in the eight-year later patent No. 534,543. In other words, this patent No. 372,786 of 1887 was claiming the method of producing a disc record with a spiral groove of uniform depth and lateral undulations therein. It was capable, when the time came, of performing the two functions of vibrating and propelling the reproducing stylus of the 1895 patent No. 534,543,—which later patent was alone involved in the Leeds & Catlin v. Victor cases.

The disc or tablet was not in and of itself, therefore, a novel element.

In the Court of Appeals the petitioner advanced certain reasons for disputing the correctness of Judge Lindley's conclusions. In their brief in this Court, counsel for the petitioner have not directly disputed the conclusions of the District Court and of the Court of Appeals. They have simply assumed the fact to be quite contrary to that which was determined in the lower courts. Thus far, counsel have let the matter rest upon their wholly unwarranted assumption.

We fear that if we do not pursue the matter further, we may be met at the argument by some such contention as that which the petitioner advanced in the Court of Appeals. We desire, therefore, to answer a little more fully the erroneous assumption of counsel for the petitioner that the disc record of Berliner's patent No. 534,543 was in and of itself a novel and patentable element at the date, 1892, when Berliner applied for his patent No. 534,543.

In the Court of Appeals, counsel for the petitioner sought to upset Judge Lindley's conclusions by advancing the contention that the drawings and specifications of Berliner's early patent No. 372,786 showed a cylindrical record having but a single sound groove which was closed upon itself, and which therefore was claimed to be incapable of feeding or propelling the reproducing stylus across the face of the record. The contention was that the undulating sound groove of even depth, as shown in this early patent of 1887, had the capability of vibrating the stylus but not of advancing or propelling it.

Berliner's early 1887 patent, No. 372,786, involved the disclosure and the claiming of a very broad fundamental method,—a method of undulatory sound groove formation (as distinguished from a sound groove of hill

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and dale formation) which could be applied equally as well in the case of cylindrical records as in the case of disc records. It so happened (and it was only a happening) that in the simple diagrams with which Berliner sought to explain his broadly new method of sound groove formation, he illustrated a cylindrical carrier and a correspondingly cylindrical record. Reference to the drawings of this Berliner patent will show that the apparatus was simplified to the nth degree,—quite consistently with the principle that a truly patentable method is a concept quite independent of any particular form of apparatus.

Consistently with Berliner's very commendable presentation of his method or process, he cut the apparatus down to a point at which the cylinder was to be rotated by a little hand crank L at the end of the cylinder shaft. The cylinder shaft was not even screw-threaded so as to provide a longitudinal travel of the cylinder with respect to the graving stylus. So also, the stylus and its diaphragm were shown in fixed position, and incapable, therefore, of any longitudinal travel with respect to the cylinder,—and indeed without even a mouthpiece or speaking tube.

All that Berliner endeavored to show was that his method would produce a sound groove of uniform depth but with lateral undulations corresponding with the music or with the spoken sounds which were to be recorded and reproduced. In this early method patent, he did not even show a helical groove which would make more than one circuit around the periphery of the cylinder. He showed merely a single circuit of the cylinder. The result is that, as illustrated in this early patent, No. 372,786, the groove makes but one turn around the circumference of the cylinder, and then returns upon itself (rather than moving along with each revolution to a new position, as in the case of a screw thread).

This disclosure was, however, of course made to "those skilled in the art," i. e., to those who had for ten years been familiar with Edison's phonographs as shown in his still earlier patents No. 200,521 and 227,679. These still earlier Edison patents of 1878 and 1880, disclose sound grooves running helically like a screw thread around the periphery of cylindrical records. Correspondingly, of course, there were feed screws for feeding the stylus along the cylinder, or conversely, for feeding the cylinder longitudinally with respect to the stylus.

It is inconceivable that any one skilled in the art as of the date of Berliner's 1887 patent, No. 372,786, could have thought that Berliner was limiting himself to a cylindrical record having only a single circumferential groove returning upon itself.

"Good morning—Good morning—Good morning—Good morning—Good morning \* \* ." This would be the sum total of the capabilities of Berliner's record as counsel for the petitioner claimed before the Court of Appeals to understand it.

Counsel attempted to excuse such an understanding and presentation of the matter by pointing to a sentence appearing at page 3, line 4, of Berliner's specification of patent 372,786, in which he says:

"Care must be taken that the two ends of the undulatory groove y meet exactly, as will be readily understood."

The reason for this caution was quite different, however, from that ascribed to it by petitioner's counsel. Reference to this Berliner patent 372,786 will show that the record was in the form of a flexible ribbon, which was to be wound upon and later unwound from the metal cylinder upon which it was to be carried when in use. The caution meant merely, therefore, that when this flexible ribbon-like record was re-

wound upon the cylinder, it must be wound "straight,"—so that the groove (or grooves, in the case of a helical sound record) would align itself in accordance with the alignment employed at the time of making the original record; otherwise the stylus would be led into non-consecutive parts of the sound groove in such a way as to produce a disjointed and non-consecutive rendition.

In the foregoing discussion of the disclosure of Berliner's patent 372,786, we have given ourselves a little latitude,—by attempting to apply a little common sense involving the teachings of the phonograph art, which at the date of Berliner's earliest patent was already ten years old. It is not necessary, however, to rely upon even a grain of common sense in order to arrive at the same conclusion. This is for the reason that there was still another Berliner patent, No. 382,790, which also is referred to in Judge Lindley's opinion in this case. This patent 382,790 was granted to Berliner in 1888. In his specification, he says,

"In a patent granted to me November 8, 1887, No. 372,786, I have described a method of recording and reproducing spoken words and other sounds; and in connection therewith and as a part thereof, I have described a process of producing a record of sound waves in solid resisting material by photo-engraving, the phonautographic record of such sound waves having first been produced as an undulatory line of even depth in a traveling layer of non-resisting material." (Page 1, line 8.)

In this second patent, Berliner then goes on to say:

"My present invention is an improvement upon that described in my aforesaid patent; and it has for its object the production of a record of sound waves in solid resisting material, principally, metal, by the process of direct etching," etc.

He then points out that this improved process may be applied "either upon a flat or upon a curved surface" (page 1, lines 19 to 27), i. e., upon either a disc tablet or upon a

cylindrical tablet. Indeed, he goes on to refer expressly and repeatedly to these two forms of tablets, saying, for example:

"The surface which is intended to receive this ground, which may be a flat disc or a cylinder of metal or glass, should be smoothly polished, and must be cleansed and dried," etc. (Page 1, lines 70 to 73.)

He refers repeatedly also to the "grooves" (plural) of the record, and to "the lines" upon the record, and to "the progress of the record,"—all making it perfectly clear that he was concerned with a continuing helical or screw-threadlike groove in the case of a cylindrical record, and with a continuous spiral groove in the case of a disc record. (Page 2, column 2, of patent No. 382,790.)

Let us turn for a moment now to another patent, more or less contemporaneous with these earlier Berliner patents, namely, that of Bell and Tainter, No. 241,214, issued on May 4, 1886. Let us look, for example, at Figure 2 on Sheet 1 of the drawings, or at Figure 18 on Sheet 2. Here there are clear and unmistakable disclosures of phonographs employing disc records with spiral grooves. The sound grooves in this case were formed by

"cutting or engraving the record in the form of a groove with sloping walls, the sound waves being represented by elevations and depressions at the bottom of the groove or otherwise. The advantage of this form of record is that it forms an efficient guide to the reproducing style." (Page 1, lines 76 to 83.)

The word "otherwise" of the above quotation would of course include the laterally undulatory groove of Berliner as well as the vertically undulating groove which Bell and Tainter more particularly disclosed. For the moment, we are stressing Bell and Tainter to the effect merely that they described and elaborately pictured disc records having spiral sound grooves. The language of Berliner's claim No. 35, which was involved in the Leeds & Catlin suit, reads

squarely and unequivocally upon the record which is illustrated and described in the Bell and Tainter patent, for the reason that Berliner's claim makes no distinction between lateral undulations and vertical un ulations, or indeed between records of the disc form and records of the cylinder form. It will be remembered in this connection that the language of the claim is, "a traveling tablet having a sound record formed thereon." It is impossible in the light of the Bell and Tainter patent to maintain the position taken by counsel for the petitioner, to the effect that the record part of the Berliner patent involved in the Leeds & Catlin case was a separately new and patentable element.

The above quotation from the Bell and Tainter patent is interesting, however, in another respect, because it bears upon Judge Lindley's analysis of the scope and character of the invention of the later Berliner patent, No. 534,543, which was involved in the Leeds & Catlin case.

As indicated by our emphasis in the last preceding quotation from the Bell and Tainter patent, one of the advantages of the spiral groove disc record which is referred to in the specification and illustrated in the drawings, was that this kind of a record "forms an efficient guide to the reproducing style."

In order to determine just what constituted the advance over the prior art as represented by Berliner's patent 534,543, let us consider a little further the disclosure of the Bell and Tainter patent.

The graving or record cutting stylus 11 is shown in association with diaphragm H in the mounting 20 (Figures 1 and 2).

The reproducing diaphragm and stylus (K, Figure 8 or Figure 13, Sheet 2) are adapted to be substituted in the mounting 20 for the graving stylus.

The rotating table for the record disc was associated with

a feed screw, geared to the record table in such a way that when the record tablet was rotated, its axis was also moved slowly and steadily in a lateral direction. The result was that the graving stylus cut a spiral groove in the face of the record.

So, also, when the sounds were to be reproduced, the disc or tablet was not only rotated but was also slowly moved sidewise in such a way that it would have maintained a fixed stylus within the spiral sound groove.

However, as said by Bell and Tainter (page 1, line 84, et seq.):

"The invention consists, fourthly, in loosely mounting the reproducing-style so that it can readily be guided by the record. Preferably the reproducing style, or rather what may be called the 'head' of the reproducing instrument is mounted on an universal joint, and the style is pressed against the record by the yielding pressure of a spring or weight. Practically in the instruments made by us the pressure is due to the weight of the instrument, modified by the elasticity of a section of soft-rubber tube, which supports the same and constitutes a universal joint; but evidently there are many devices which can be used to mount the reproducer, so that it is free to follow the sound record . or phonogram, and which, therefore, would be within the spirit of the invention. The reproducing-style, mounted as just explained, is specially adapted for use in connection with a record in the form of a groove with sloping walls, and this combination is specially claimed: but it may also be usefully employed in connection with other forms of record."

And relative to the reproducer K (Page 4, line 55, et seq.):

"For use the tube 33 is slipped into the tube 19 in the manner shown for the tube 18 of the recorder.

"The reproducer K when so placed is mounted upon a hollow standard composed of the tubes or tubing 31, 32, 33, and 19, and in consequence of the flexibility of the rubber tubing 32 it is free to follow the record. No special care is necessary to insure its adjustment, for if the reproducer K be allowed to rest against the record with the style upon the engraved line the style will

of itself gravitate to the bottom of the groove.

"There exists always a liability to disarrangement in some part of the machine either in the recorder or the support therefor or the recording-tablet or its support, or if there be no disarrangement it would be difficult to insure that the reproducing-style should touch the record precisely at the proper point if the reproducer be held rigidly. Difficulties on these accounts are avoided by the loose or flexible mounting of the reproducer, the style automatically adjusting itself to the proper place on the record. It will be seen that the reproducer is mounted on a universal joint, so that it can move in any direction. The movement parallel with the face of the tablet, would, however, by itself allow the style to follow and adjust itself to the record to a useful extent."

Relative to Figure 13, Bell and Tainter say (page 5, lines

57-65):

"In this machine the reproducer K, instead of being mounted on the same bracket as the recorder when the latter has been removed, is carried by a separate bracket, 72, the tube 33 being hinged thereto, so that the recorder and reproducer remain, or may remain, always attached to the machine, it only being necessary to turn one or the other into position, as may be required."

As shown in this Figure 13, the reproducer K is mounted upon a pivoted tone arm in such a way that its stylus could follow the groove in the record tablet to some extent. However, in the machine as disclosed, the record tablet supporting plate has its axis shifted laterally as the record is being played, so that the only function of this mounting as actually used, was to permit the stylus automatically to follow the groove to the extent necessary to compensate for minor irregularities or eccentricities in the groove.

Now, as compared with Bell and Tainter, the Berliner invention of patent 534,543, which was involved in the Leeds

& Catlin case, consisted in permitting the stylus of the reproducer to be propelled by and along the sound groove of the record tablet all the way from its outer periphery to its inner end. For accomplishing this purpose the required mechanical structure was a mounting for the reproducer which would permit it to travel freely throughout the necessary distance from the periphery to the center of the record tablet. In the light, therefore, of the Bell and Tainter patent, Berliner's invention, as defined in claims 5 and 35, resided in giving the reproducer a greater degree of freedom of movement to follow the groove in the record tablet, and by this, eliminating the necessity of providing means (i. e. the screw feed) for relatively shifting the record tablet and reproducer.

It is inescapably clear, therefore, that in and of itself, there was nothing new in or about the disc record or tablet described in the specification of the Berliner patent 534,543.

Even the precise form of the laterally undulating sound greove was several years old in and by the issue of the earlier Berliner patents to which we have referred. Claim 35 of the Berliner patent, which was involved in the suit of Leeds & Catlin v. Victor, did not, however, contain any limitation to the laterally undulating groove. The claim was very definitely broad enough to include disc records or tablets having sound records formed thereon, either by a spiral groove of the laterally undulatory type or of the vertically undulatory type. The broad language of the claim in respect of the disc record was merely "a traveling tablet having a sound record formed thereon." In and of itself, such a disc record or tablet was old and well known in two different forms, long prior to the application for the Berliner patent involved in the Leeds & Catlin suit. It was old and well-known also in the form of a cylindrical tablet.

The claims in suit against Leeds & Catlin read directly upon Bell and Tainter patent No. 341,214 in everything except the unrestricted pivotal mounting, and therefore the freedom of the reproducer stylus to be propelled all the way across the face of the record disc solely by the spiral sound groove in the face of the record.

That the above is a full and correct statement of the invention of claims 5 and 35 of the Berliner patent No. 534,543 is shown by the opinions of the various courts which passed upon the matter.

We invite your Honors' attention particularly to the opinion of Judge Hazel in the original case in the Circuit Court, 140 Fed. 860, 863. We invite your Honors' attention to Judge Hough's majority opinion for the Second Circuit Court of Appeals in *Leeds & Catlin* v. *Victor*, 154 Fed. 58, and particularly to his description of the invention of claims 5 and 35 of the Berliner patent.

The Supreme Court of course affirmed Judge Hough's majority opinion. The precise point and effect of the Supreme Court's affirmance cannot, however, be more clearly brought to light than by reading the brisk opinion in which his Honor Judge Wallace dissented from the majority in the Second Circuit Court of Appeals. The unanimous opinion of the Supreme Court overruled the dissenting opinion of Judge Wallace and affirmed the majority opinion of Judge Hough and Judge Coxe. Judge Hough's majority opinion, which was affirmed by the Supreme Court, did not leave any room for doubt as to the nature of the question which the Circuit Court had decided (154 Fed. 60). Judge Hough's opinion had made it clear that the Leeds & Catlin records were capable of use in a non-infringing way with feed screw machines (154 Fed. 59).

A thorough-going study of the record in the Leeds & Catlin case confirms the accuracy of Judge Lindley's understanding and discussion of it. The Real Distinction Between the Leeds & Catlin Case on the One Hand and the Carbice and Leitch vs. Barber Cases on the Other Hand, Does Not Involve the Distinction Between the Sale of a New and Separately Patentable Element in the One Case and the Sale of an Old and Separately Unpatentable Element in the Other Cases, as Contended by the Petitioner. It Depends Wholly Upon the Radical Difference Between the Business Methods Which the Victor Company Employed in the Use of Its Patent and the Business Methods Employed by the Dry Ice Company and by the Barber Company in the Use of Their Patents.

The Business Methods Employed by the Stewart-Warner Corporation in the Use of Its Patent Are Identical With Those Employed by the Victor Company.

Our excuse for this long discussion of the facts of the Leeds & Catlin case is that it leads inevitably to the conclusion that the record or tablet element as described in Berliner's claim and as sold by Leeds & Catlin, was a thoroughly "old" element in and of itself for several years prior to the application for the Berliner patent 534,543, which was involved in the Leeds & Catlin case.

It is impossible, therefore, to agree with counsel for the petitioner as to the distinction between the Carbice and Barber cases on the one hand, and the Leeds & Catlin case on the other hand.

In all of these cases, the defendant was engaged in the sale of an element or thing which was separately old and unpatentable.

We have heretofore sufficiently indicated the real distinction between the Leeds & Catlin case and the Carbice and Barber Asphalt cases. It lay in the wholly different methods by which the patent owners attempted to "use their patents."

There was nothing in or about the Victor Company's conduct of its business of manufacturing and selling the whole of the invention of the Berliner patent, which could have caused the Court to refuse relief upon such grounds as were invoked in the Carbice and Barber Asphalt cases.

There is nothing in or about the Stewart-Warner Company's conduct of its business of manufacturing and selling the whole of the invention of the Butler patent, which should cause the Court to refuse relief upon such grounds as were invoked in the Carbice and Barber Asphalt cases.

Leeds & Catlin were enjoined against the further sale of records which in and of themselves were old and unpatentable. Counsel for the petitioner say that the headed nipples manufactured and sold by the Lincoln Engineering Company are in and of themselves old and unpatentable. Even if we were to accept this contention, without any reservations whatsoever, there is still nothing in or about the law of the Carbice and Barber Asphalt cases which would warrant a refusal to relieve the respondent of the competition of the Lincoln Company.

Our long discussion of the Leeds & Catlin case brings us to a point at which we may advantageously consider the petitioner's contention that the present case is ruled by the decision of this Court in the case of Rogers vs. Alemite. THE HEADED NIPPLE IS A NECESSARY AND PROPER ELEMENT OF THE COMBINATION INVENTED BY MR. BUTLER. WHEN COMBINED WITH THE OTHER ELEMENTS OF BUTLER'S COMBINATION, THE HEADED NIPPLE HAS NEW FUNCTIONS AND NEW COACTIONS WHICH NO HEADED NIPPLE EVER HAD HAD BEFORE THE DATE OF BUTLER'S INVENTION. THE HEADED NIPPLE CONTRIBUTES ITS NEW AND ESSENTIAL FACTOR OF COOPERATION TOWARD THE ACCOMPLISHMENT OF A WHOLLY NEW AND UNITARY AND ADVANTAGEOUS RESULT.

Why was it that the separately old and unpatentable phonograph record of the combination claim of Berliner's patent No. 534,543 could be included as an element of the combination claim which was held to be valid and enforceable in the Leeds & Catlin case?

It was because of the fact that when the old record was combined with a phonograph machine having a stylus which was mounted in such a way as to be free to be swung or propelled across the face of the record by the sound groove of the record, that record took on a new function which it never before had had. This new function was that of propelling the stylus and its associated diaphragm and tone arm. There was a new mode of operation, a new coaction, a new and unitary result.

Why is it that Butler's headed nipple may properly be included as an element of his combination?

It is for identically similar reasons. The headed nipples of the petitioner, like the headed nipples of the respondent, were specially designed, formed and dimensioned for precise and exact cooperation with the other parts of the Butler

combination as manufactured and sold by the respondent. They differed in all of these details from any headed nipple which had previously been known. But even if the headed nipples manufactured and sold by the petitioner could be considered as separately old and unpatentable, (and we agree that they were separately unpatentable because they would have had no new functions except in, and as a part of, the new combination) still they were properly and necessarily included as an element of the new combination. This is for the reason that the other parts of the combination required the presence and the coaction of the nipple in order to enable them to work at all, and more particularly because the headed nipple, when included as an element of Butler's new combination, had new functions, new coactions, new results, different from anything which any headed nipple had ever before experienced.

We have previously described some of these new coactions and results.

This new mode of operation, these new coactions, these new functions, were rather fully stressed and described in Judge Lindley's several opinions. Judge Lindley's opinions were in turn adopted and stressed in the opinion of the Court of Appeals.

As we have previously pointed out, the coupler mechanism of Butler's patent cannot respond to the grease pumping action of the associated compressor in such a way as automatically to establish a mechanical grip and a grease-tight seal between the two halves of the connector mechanism, except as the headed nipple has brought about a cocking or pre-setting of the coupler mechanism. This cocking operation, this pre-setting function, were things in which no headed nipple had theretofore participated. No headed nipple had previously cooperated in these ways or had contributed any such part in the accomplishment of any result whatsoever.

In our opinion it never would have occurred to anyone to question the propriety of including the headed nipple as one element of Butler's combination claim, except for the fact that the exigencies of the business of selling lubricating equipment of this type make it necessary for the manufacturer to price and sell the nipple parts separately from the compressor and coupler parts. (Indeed, it is only the need of supplying such assortments of the several parts as required by the respondent's customers which provides the opportunity for such contributory infringement as has been engaged in by the petitioner.)

In presenting many of their arguments, counsel for the petitioner entirely disregard claim 2 of Butler's patent as it really is, and assert that the Butler patent in suit claims the combination of

"the patentee's assertedly improved coupler and the old-style grease-cup and old-style pump". (Petitioner's brief p. 66)

What the petitioner does is to segregate and lump together five of the seven elements of the claim, and then to "concede" for their own purposes, that novelty (and, by inference, patentability) are to be found only within the confines of this five-element group, i. e., within the confines of the coupler only.

Why, however, should there be any such division between, and regrouping of, the seven elements of the claim? All of the elements cooperate in new ways in producing one single and unitary result. Each contributes its part in the accomplishment of that result. Each element acts and reacts in such a way as to modify and affect the operation of every other element.

The reason why petitioner's counsel split off a sub-group of five elements and assert that the novelty and patentability of the Butler invention, if any, inheres in this lesser group of elements, is that petitioner's counsel are anxious to have the court believe that Butler is attempting to appropriate and "monopolize" some allegedly old prior art device, -contrary, as they appear to believe, to the rules of the Carbice and Barber cases. Throughout their brief petitioner's counsel refer to the plaintiff's attempted "monopoly" of old-style nipples, and to the attempt of the respondent to "monopolize" such devices. It is for this reason only that the petitioner segregates the one element which it wishes to make and sell and then asserts that the "headed nipple" of claim 2 is any "old-style headed nipple",-whereas the real invention of the Butler patent inheres in the five elements of the coupler. And this, despite the fact that the coupler parts cannot begin to do their work until after the headed nipple has cocked and set them for that work.

Counsel would then have it appear that it is any and every "old-style nipple" which the plaintiff is seeking to "monopolize". Counsel would have it appear that this would-be "monopoly", has no relationship to the use of a very special and particular nipple which was never made or sold at all until the advent of the Butler invention upon the market and which was specially adapted for coaction and cooperation with the other six elements of Butler's claim, but that the proposed monopoly shall preclude the public from the free use of any old-style headed nipple in any of the situations or relationships in which "headed nipples" of various other kinds and forms have been freely used for decades.

This is a novel and ludicrous way of reading patent claims. The "headed nipple" of Butler is not just "any old headed nipple" any more than it is the nipple of a cow. The other parts of Butler's claim make it quite clear that Butler does not mean the nipple of a cow. The other parts of the claim tell us inferentially but clearly and defi-

nitely how Butler's nipple is to be formed and constructed so as to cooperate with the remaining six elements of the claim. The petitioner apparently is willing to agree that the remaining language of claim 2 is sufficient to indicate that Butler did not have in mind a bovine nipple or a "headed nipple" for feeding a baby. Petitioner's counsel do insist, however, upon stopping short of the logical conclusion which flows from their attempted reading of Butler's claim. They do not wish the absurdity of their argument to be made too apparent by carrying it to its ultimate conclusion. To avoid any reductio ad absurdum they are forced to concede that Butler does not mean literally "any old" nipple, but rather some more or less specific kind of a "headed nipple."

If, however, the petitioner's reasoning and analysis were to be followed consistently, it could be equally well urged that Butler included in his claim not only "any old-style headed nipple" and "any old-style compressor" but also "any old-style cylinder," "any old-style piston," "any old-style aperture," and any "old-style jaws". If the petitioner were seeking to exculpate itself from a charge of contributory infringement by manufacturing parts other than the headed nipples of Butler's claim 2, it would then make the same argument as to any of these other parts. Thus, if the defendant chose to make the cylinder, it would say that Butler's claim 2 does not specify any particular kind of a cylinder,—all that it specifies is "any old-style cylinder". Then the defendant would point to the cylinders of locomotives, ice cream freezers and tin cans generally, and say,

"Butler did not specify any particular kind of cylinder; Butler didn't invent cylinders; cylinders were old in the art; what Butler has done is to attempt to achieve an illegal monopoly of cylinders by the inclusion of 'any old cylinder' in his claim."

Under such circumstances, petitioner's counsel would

urge that the "asserted novelty" of Butler resided somewhere in or among the remaining elements of the combination,—that the old cylinder remains simply an old cylinder,—"a part of the public domain" etc.

Or again, the defendant-petitioner might manufacture the piston. Under such circumstances, the petitioner would excuse itself by saying that the only description of the piston is that it be "movable within the cylinder"; that "any old piston" is, of course, movable in its cylinder; that pistons are old in all sorts of mechanical appliances; that the plaintiff is seeking an illegal monopoly of pistons; that the novelty resides elsewhere; and that the respondent's patent must fall.

This analysis of the petitioner's position is not farfetched,—it is simply the logical conclusion which results from the petitioner's erroneous assumption that when Butler says "headed nipple", he means "any old-style headed nipple", whereas what he really means by any customary or accepted method of reading or interpreting patent claims, is just such a "headed nipple" as will operate and cooperate with the six remaining elements of the combination,—and no other.

The opinions of the lower courts describe the characteristics and attributes of the "headed nipple" of Butler's claim. These attributes and characteristics of the "headed nipple for receiving lubricant" of Butler's claim 2 permeate the entire claim. They do not leave the distinctions in co-operative action wholly to inference (as, indeed, however, would be amply sufficient). Let us quote the claim and indicate by bold face emphasis how completely the special characteristics of the "headed nipple" do permeate the entire claim:

"The combination with a headed nipple for receiving lubricant, of a lubricant compressor having a cou-

pling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder, and having an aperture for the discharge of lubricant thereof (therethrough), an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple, radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

The petitioner's brief is pervaded with the inferences and assertions that it is the respondent's purpose in some substantive way to monopolize really prior art devices because of the use in Butler's patent claim of words which can be applied to devices of the prior art. The respondent does not, of course, have any such purpose or intention. The respondent's position and contention does not ask for any such ruling or result at the hands of the court.

Opposite page 16 of their brief, petitioner's counsel parade a multiplicity of fragments of prior art machines and devices of various kinds, all snatched out of their mechanical contexts and then enlarged or diminished in size in such various ways as will make them have the appearance of being similar in some respects to the nipple of the Butler combination, and similar in some respects, therefore, to the nipples sold by the petitioner for (now admitted) use with the other parts of the Butler combination as incorporated in the respondent's "Alemite Hydraulic" equipment of the Butler patent. These are the "old-style headed nipples" which it is said that the respondent proposes now to "monopolize".

Some of these prior art fragments are essentially like the mine car oil cups shown to have been manufactured and sold by the Lincoln Engineering Company itself as early as 1922 and more or less continuously from that date down to the present time (R. p. 77).

It is an interesting commentary upon the brief of petitioner's counsel that while the defendant protests vehemently against the suppositious evil intentions and legal claims of the respondent to monopolize such prior art nipples, still the petitioner has been manufacturing and selling, and will continue to manufacture and sell with impunity, headed nipples essentially like some of those shown in the parade chart opposite page 16,-for use, of course, in other situations and in other combinations. And the defendant will, of course, continue to do so. These mine car fittings thus long manufactured and sold by the petitioner could not conceivably be used with an Alemite Hydraulic coupler, nor with any other form of Butler's coupler. Obviously, there was no intention when the petitioner made and sold such fittings that they should be used in this or in any other infringing way. They are so constructed and so formed that they are not the "headed nipples" called for in claim 2 of the Butler patent.

The manufacture and sale of these obviously immune mine car "headed nipples" is something quite different and aside from the petitioner's manufacture and sale of the "headed nipples" of claim 2 of the Butler patent against which the respondent does complain.

The Essence of the Distinction Between the True Combination of Butler's Claim 2 in the Instant Suit, and the Unenforceable Aggregations of the Gullborg Patent as Determined in Rogers v. Alemite, 298 U. S. 415.

The petitioner's arguments bring us now again to the decision of the Supreme Court in the cases of Rogers v. Alemite and Bassick v. Hollingshead (298 U. S. 415, 80 L. Ed. 782).

We have previously discussed this case with respect to

the petitioner's attempt to show that the Supreme Court has recently and in effect abolished the long-established and applied rule and law of contributory infringement. We found, however, that this case went off on grounds which did not involve any consideration of the law or attributes of contributory infringement.

We come back now to this case of Rogers v. Alemite in connection with the petitioner's attempt to convince your Honors that claim 2 of the Butler patent is invalid or unenforceable for the same reasons as those which were applied by the Court in deciding the case of Rogers v. Alemite.

We have shown that the "headed nipple" was a proper and necessary element of Butler's combination claim for reasons substantially identical with those why the phonograph record was a proper and necessary part of Berliner's combination claim involved in Leeds & Catlin v. Victor.

It is to be recalled at the outset that the opinion of the Court in the Rogers case practically reaffirmed the law of the Leeds & Catlin case. This was done by citing and distinguishing it. In his opinion in the instant case, his Honor Judge Lindley referred categorically to the distinctions of the Leeds & Catlin case as enumerated in the opinion by Mr. Justice Roberts, and then categorically applied these distinctions to the facts of this suit upon the Butler patent.

There is one phrase in Mr. Justice Roberts' opinion in the Rogers and Hollingshead cases which reconciles the opinion in those cases with the re-affirmation of the decision in the Leeds & Catlin case. It is a phrase which belies the use which counsel for the petitioner seek to make of the Supreme Court's opinion. It is a phrase which counsel for the petitioner do not dare to discuss,—and yet it is the phrase which provides the key to the entire situation.

We refer to the phrase which we now emphasize in our repetition of the question posed in the opinion by Mr. Justice Roberts in the Hollingshead and Rogers cases:

"The question then is whether, by this method, the patentee by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element."

"Whose construction and operation is otherwise unchanged"!

In the Rogers case the Court had found the fact to be that the combination of a compressor, a bayonet coupler, and some kind of a bayonet pin fitting, was old and well-known in the art. The finding of fact was that in this combination Gullborg had merely substituted an improved form of pin fitting, i. e., a pin fitting having a cross pin, in lieu of a fitting having pin-like lugs projecting from opposite sides of the fitting. The fact was, furthermore, that Gullborg's improved pin fitting had been separately described and claimed in his earlier patent No. 1,307,733. The question then was whether the substitution of Gullborg's improved pin fitting in the old combination gave rise to any new construction or operation of the old coupler and compressor parts.

The Court held that the operation of the compressor and coupler parts was identically the same when used with Gullborg's improved pin fitting as when used with the older lug-type fitting.

In the present case we have a very different situation. In testing the applicability of the rule of the Rogers case, we are to assume (rightly or wrongly) that the headed nipple of Butler's combination is old. We are to assume, perhaps, that this headed nipple had previously been used with some coupler mechanism, as, for example, that of the

Seng patent (R. p. 542). In the coupler of the Seng patent the engagement and disengagement as between the nipple and the coupler parts was effected wholly by a manual operation of the coupler mechanism. The nipple had no part in the operation of the coupler mechanism. Its manual operation could be effected in precisely the same way regardless whether the nipple was associated with the coupler mechanism or whether it was laid completely to one side. When in Seng's coupler the sleeve b is manually pushed upwardly, the balls i will be moved inwardly. When, on the other hand, the sleeve b is manually pulled downwardly, the balls i will move outwardly. The presence or absence of the nipple has nothing whatsoever to do with these operations. The nipple does not contribute in any way to the operation.

In the invention of the Butler patent, the coupler mechanism does not require any manual actuation whatsoever. Its operation is entirely automatic. That automatic operation is utterly dependent, however, upon a certain action and coaction by the headed nipple. The automatic gripping cannot occur at all unless the piston mechanism has first been cocked or set, i. e., returned to its innermost position. This is for the reason that the piston cannot be moved forwardly to effect the gripping operation unless it has first been brought back to its starting position. This cocking or resetting of the piston mechanism is automatically effected by the headed nipple during its disengagement from the coupler half of the combination. Furthermore, if the coupling mechanism has lost its "preset," during the interval between its disconnection from one nipple and its connection with another, then the second nipple will bring about this cocking or presetting of the piston mechanism of the coupler during the initial engagement between the coupler parts and the nipple parts,—that is to say, during the slipping of the head of the nipple into the space between

the jaws of the coupler prior to the subsequent operation of the compressor while in the act of forcing grease into the coupler and thence on into the interstices of the bearing to be lubricated.

The combination was a new one. The operation was new. The automatic gripping and automatic and more or less independent end sealing were new. The result was new. The new mode of operation and the new result were accomplished by the appropriate coactions of all of the parts. In all of these new coactions, the nipple played just as prominent and just as important a part as did any or all of the elements of the complete combination. The headed nipple contributed just as much to the new result as did any other part.

Such things as these are the test of a true and patentable combination as distinguished from an unpatentable aggregation, all as elaborately and effectively set forth in the convincingly clear opinion of his Honor Judge Evans, speaking for the Seventh Circuit Court of Appeals in the instant case.

The books afforded numerous illustrations of such mere aggregations as this Court held to have been described in claims 14 and 15 of the Gullborg patent which was involved in the case of Rogers v. Alemite. The Supreme Court held, relative to claims 14 and 15 of the Gullborg patent, that they involved such a mere aggregation;—indeed such an extreme case of aggregation as to have involved substantially an attempted double patenting in No. 1,307,734 of the real invention which was described in Gullborg's earlier patent No. 1,307,733.

The question formulated by Mr. Justice Roberts in his opinion in the Rogers case, expressly recognizes and inferentially states that when the construction or operation of the old elements of the combination are changed as a

result of their association with other elements (or the addition or substitution of one or more new elements), then the new assembly becomes a true and patentable combination and as such, subject to the rules laid down in Mr. Justice McKenna's famous definitions in the Leeds & Catlin cases.

His Honor Judge Thacher, while sitting in the United States District Court for the Southern District of New York in the case of Bassick v. Adams, 39 Fed. (2d) 904, had occasion to consider claims 14 and 15 of the Gullborg patent, which was subsequently involved in the case of Rogers v. Alemite. He reached the same conclusion as that subsequently reached by this Court, and in so doing, said:

"I am satisfied that claims 14 and 15 cannot be so broadly read as to include any old grease gun connected by any old bayonet coupler to one of the plaintiff's patented pin fittings. This conclusion follows from a consideration of what, if anything, can be said to be novel in such a combination. So far as the coupler and grease gun are concerned, we start with the concession that they are old. Whether they can properly be claimed in combination with the pin fitting must therefore depend upon their functional relation to the pin fitting. If that relation is such that, either in making the detachable connection with the fitting or in delivering the grease, a new function is performed or a new result accomplished, then the combination claims must be construed to include that as part of the invention embodied in the combination, and not merely in one of its members. If, on the other hand, novelty is found only in the specific form of the fitting, and if the function which it performs in making the detachable connection with the coupler and in receiving the grease is old, the combination claims must be limited upon Gullborg's disclosure to a combination including a coupler having the novel features disclosed in his specification."

Judge Thacher went on to reach the conclusion

"that there was no functional novelty in combining such a pin fitting with a bayonet coupler and a grease gun. The old combination of the gun, the bayonet coupler, and the pin fitting with ball and spring valve, would work as well and accomplish precisely the same result. To extend the combination claims to cover the use of any old gun and any old coupler on a Gullborg fitting, is clearly not permissible in view of the prior art which limits novelty in the pin fitting to a specific form of construction, and deprives the aggregation of elements of all patentable novelty as a combination."

We recur to Judge Thacher's statement of the test. Relative to the coupler and grease gun of the Gullborg patent, he said:

"Whether they can properly be claimed in combination with the pin fitting must therefore depend upon their functional relation to the pin fitting. If that relation is such that either in making the detachable connection with the fitting or in delivering the grease, a new function is performed or a new result is accomplished, then the combination claims must be construed to include that (i. e., the coupler and grease gun) as part of the invention embodied in the combination."

We respectfully submit that Judge Thacher very clearly and effectively stated the rule. This Court subsequently determined that Judge Thacher was right in his application of it to claims 14 and 15 of the Gullborg patent.

We respectfully submit that the assembly of elements enumerated in claim 2 of the Butler patent in suit, exactly and completely meets the test of a true combination as stated by Judge Thacher. Because of its cooperative association with the compressor and coupler mechanism, the headed nipple of the Butler combination performs new functions and participates in the accomplishment of a new result.

The test as formulated and so clearly stated by Judge Thacher, applies to the combination of claim 35 of the Berliner patent, involved in the Leeds & Catlin case. Because

of its association with the phonograph machine having the freely mounted tone arm and stylus, the old record performed the new function of propelling the stylus and its tone arm. It thus participated in the accomplishment of a new result. When measured by this test or by any fair test, the old and well-known disc record was a necessary and appropriate part of Berliner's combination. When measured by this test or by any fair test, the headed nipple (old and well-known, if such it be) was a necessary and appropriate part of Butler's combination. In so far as the inclusion of the record in the one case and the inclusion of the headed nipple in the other case, we can think of no distinction which would appropriately make one a proper part of the one combination without making the other an equally appropriate part of the other combination.

In the case of Rogers v. Alemite, it was held that claims 14 and 15 did not, in the light of the prior Gullborg patent No. 1,307,733, describe a true combination which was patentably distinct from the Gullborg pin fitting per se. Since claims 14 and 15 were held to be bad, and therefore unenforceable in any aspect, there was no determination which hinged upon any question of contributory infringement.

Claim 2 of the Butler patent does, in accordance with every recognized and authoritative test, meet the requirements of a true and patentable combination. Butler's claim to such a combination is entitled to such enforcement as is accorded to any other claim which describes a true and meritorious invention.

The owner of the Butler patent is entitled to just such protection against contributory infringement as is the owner of any patent containing a claim to a new and true combination. The respondent is entitled to the same protection against the competitive sale of the headed nipple part of the combination as it is against the competitive

sale of the cylinder part or the piston part, or any or all of the so-called "coupler parts" of the combination.

It was the new functions and attributes of the headed nipple part of the Butler combination, when combined with the other parts of the connector mechanism, to which his Honor Judge Lindley referred when, in his first opinion, he said:

"The headed nipple which cooperates with the sealing seat and jaws of the coupler and thus with the piston and cylinder, is just as essential a part of the Butler invention as any of the several elements of the coupler. There is cooperation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the gripping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of direct cooperation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In detaching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

"Butler was the first to utilize a headed nipple and a compressor as cooperating elements of a combination whereby a grease tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping operation

of the compressor alone.

"The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new, useful and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and cooperated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg case is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved, - something never accomplished before. Just as the Supreme Court said of the Berliner patent, 'every element is necessary to the operation of the other.' "

(Judge Lindley's Opinion of July 15, 1936, R. pp. 616-617) 15 Fed. Supp. 571.

THE LUBRICATING APPARATUS MANUFACTURED AND SOLD BY THE RESPONDENT, STEWART-WARNER CORPORATION, DOES EMBODY THE IN. VENTION OF CLAIM 2 OF THE BUTLER PATENT IN SUIT. THE COMBINATION OF THE PETITIONER'S HEADED NIPPLE WITH THE OTHER PARTS OF THE COMBINATION AS MANUFACTURED AND SOLD BY THE STEWART-WARNER CORPORATION, EMBODIES THE INVENTION OF CLAIM 2 OF THE BUTLER PATENT IN SUBSTANTIALLY THE SAME WAY. THE LINCOLN COMPANY'S SALE OF THE HEADED NIPPLE PART OF THE COMBINATION. WITH THE KNOWLEDGE AND INTENT THAT THE USER SHALL COMBINE IT WITH THE OTHER PARTS AS FURNISHED BY STEWART-WARNER, IS A CONTRIBUTORY INFRINGEMENT OF THE RUTTER PATENT IN SUIT.

Claim 2 of the Butler patent reads clearly and word for word on the combination of the petitioner's nipple part and the respondent's hydraulic compressor and coupler parts. The petitioner seeks to avoid infringement by reading additional limitations into Butler's claim 2 so that the coupler part of this claim does not apply to the Respondent's hydraulic coupler. The evidence in this case persuasively shows that Butler's claim 2 is valid as allowed by the Patent Office, and that there is no justification whatsoever for limiting this claim in the manner contended for by petitioner.

The petitioner does not base its argument for reading additional limitations into the claim in suit upon any evidence adduced in this case. Instead, petitioner claims to rely upon the decision of the Eighth Circuit Court of Appeals in Stewart-Warner v. Jiffy, 81 Fed. (2d) 786. The

fact is that petitioner's argument is not even in harmony with the decision in Stewart-Warner v. Jiffy. In our answer to the argument advanced by petitioner on this point we propose to show:

- (a) That petitioner's argument is not consistent with the holding of the Eighth Circuit Court of Appeals in Stewart-Warner v. Jiffy;
- (b) That the decision in Stewart-Warner v. Jiffy was based upon a conceded misunderstanding of the Butler invention;
- (c) That the decision of the Eighth Circuit Court of: Appeals in Stewart-Warner v. Jiffy is in conflict with the views of the Patent Office experts, whereas the decision of the Seventh Circuit Court of Appeals in the instant case conforms to the views of the Patent Office; and
- (d) That the petitioner's own evidence in this case practically estops the petitioner from urging the correctness of what is claimed to have been the decision of the Eighth Circuit Court of Appeals in Stewart-Warner v. Jiffy. The decisions of the Seventh Circuit Court of Appeals and of the Patent Office are correct.

The decision of the Eighth Circuit Court of Appeals in Stewart-Warner v. Jiffy held that claim 1 of the Butler patent, which was the only claim there in suit, must be limited to a coupler having spring fingers. The claim itself is not so limited. Claim 2 of the Butler patent, which is here in suit, differs from claim 1 in being directed to a headed nipple, and its co-operative relationship with the other elements of the combination. Claim 2 is not limited to a coupler having spring fingers. We shall first discuss the structure and function of that part of the Butler coupler which is referred to in Butler's specification as "spring fingers," and the erroneous conclusions reached by the Eighth Circuit Court of Appeals with respect thereto.

### The Structure and Function of Butler's Mechanism for Compressively Actuating the Locking Jaws.

In the Jiffy case the plaintiff offered in evidence a sample of the coupler shown in Figure 2 of the Butler patent. In the instant case respondent offered in evidence, as its Exhibit 63, a sample embodying its own understanding of Figure 2 of the Butler patent. The two samples or versions are just alike. In each of these samples the part marked 42 in Figure 2 of the Butler patent is represented as being cylindrical, the left-hand end as viewed in the patent drawing forming a true cylinder in which the sealing member 51 is free to slide, and the right-hand end being longitudinally slitted to form three spring fingers which engage the locking segments 40 to clutch them about the throat of the nipple 35. A study of the specification of the Butler patent establishes the fidelity of these two samples, both as to the function performed by the spring fingers and as to the form and shape assumed by the spring fingers.

#### The Function of the Spring Fingers.

The specification of the Butler patent describes "the spring fingers 42" as having the following functions: of "being forced forwardly, maintaining the segments 40 in close engagement with 39" (p. 2, l. 124); of "maintaining the segments 40 in engagement" "with the throat" of the nipple "by the pressure being greater on the piston within the coupling than any relief of the pressure that will be possible through the passage of the lubricant through 48" (p. 3, l. 18). "The shoulder 41 on 38 prevents the retraction of these segments 40 due to the fact that they are held in position on the throat by the spring fingers 42" (p. 2, l. 104).

The function of the spring fingers 42 in forcing the jaws

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or "segments 40" into engagement with the nipple, is implicit in the statement of what occurs upon the relief of grease pressure:

"As soon as the pressure is relieved it is then possible to withdraw the coupling from the member 35 as the pressure on the fingers 42 will be relieved and the spaced segments 40 will slip over the shoulders 41 due to the pressure of 33 against the ends of the several segments 40."—(p. 3, 1. 23.)

The "spring fingers 42" must be strong enough and stiff enough to perform these functions.

In claim 2 the radially movable locking elements are described as, "actuated by said piston for compressively clutching the elements upon the nipple, whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

In claim 1 the gripping jaws and their associated mechanism are described as, "means carried by the cylinder for compressively engaging about the nipple for locking said parts together against longitudinal displacement and actuated by said piston whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said means, while the lubricant is passing through said connecting parts."

The compressive engagement of the locking jaws about the nipple must be such as to resist the very considerable disruptive force due to the pressure of the grease. At the outset of the specification Butler says:

"My invention relates to lubricating apparatus and in particular to a force feed lubrication for bearings and the like in automotive equipment."—(p. 1, l. 1.)

In the second paragraph of his specification, he says:

"It is my object to provide a means of forcing under high pressure fluid and semi-fluid lubricating compounds into bearings."—(p. 1, 1. 6.)

The pressure with which the lubricating compound must be forced into the bearings is indicated by the requirement, "that foreign material and used lubricant therein may be forced out of the bearing." (p. 1, 1. 10.)

Referring to the particular form of grease gun shown in the patent drawings, Butler says:

"By maintaining such a seal and by the use of the worm, I am enabled to secure pressure up to 1,500 pounds within this gun."

Butler was, therefore, dealing with very high grease pressures. He was dealing with tremendous forces tending to disrupt the coupler from the nipple. The inescapable inference is that he was providing a coupler mechanism which would "forcibly compress" the gripping jaws about the nipple with a power sufficient to prevent disruption under the tremendously high grease pressure which the associated grease gun would develop.

The form of these clutching segments in a plane through the axis of the coupler, is clearly shown in Figure 2. It is to be noted that the upper jaw 40 is shown in cross-hatched outline. The lower jaw is not cross-hatched. This is in accordance with the universal convention employed in making mechanical drawings. The assumption is that the coupler and nipple shown in Figure 2 have been sawn through the middle on a plane coincident with the axis (except that the spring and valve member 36, since they are the innermost parts, are not sawn through the middle). The hypothetical saw cut is supposed to have passed through the "slight space" (p. 2, l. 102) between the two adjacent segments. The end of the segment is, therefore, seen in elevation and no cross-hatching is employed. The hypothetical saw cut has passed through the middle of the upper segment 40. The saw cut through this segment is, therefore, indicated by the cross-hatching.

Unmistakably, therefore, the drawing indicates an odd number of slightly spaced gripping segments or jaws. Presumably the number of jaws is three. This is for the reason that the other figures (which show manually actuated couplers rather than automatically actuated couplers), also indicate the presence of three jaws. Figure 9 is a cross-sectional view showing one of three jaws 76 at the top of the figure. The lower jaw 76 is shown in precisely the position which it would occupy if there were three equally spaced jaws. The third of the three jaws has been removed by the hypothetical saw cut through the axis of the coupler. Figure 3 shows an odd number of jaws, the upper jaw 40 being cross-hatched and the lower jaw 40 being not cross-hatched, because the section is taken between two jaws.

Similarly, in Figure 4, the upper jaw 73 is shown in cross-hatching, the lower jaw 73 is shown in elevation. Three jaws is the natural, reasonable and almost universal practice where the jaws are to be actuated from a single source. The reason is that three jaws will all grip equally upon a cylindrical object. Some other number (e. g. 4) might not do so. The jaws 40 must substantially surround the nipple with only "slight spaces" between them. If they did not thus form an almost complete ring around the nipple, then the jaws would drop out through the hole in the forward end of the coupler upon its removal from a nipple.

The obvious way to manufacture the three jaws 40 of the coupler shown in Figure 2 of the Butler patent, is to turn up a somewhat conically shaped ring, and then to make three equidistant saw cuts which divide the ring into three "segments 40 slightly spaced from one another" (p. 2, 1. 101). Each of the segmental jaws 40 is provided with a tapering wedge or cam surface against which the forward beveled end of a "spring finger 42" presses. When, therefore, the spring finger cylinder 42 moves forward under the pressure of the grease when developed behind the piston 43, 44 and 45, there is an inevitable "wedging action" between the beveled forward end of the spring finger cylinder and the reversely beveled surfaces of the segmental jaws 40.

Now, no matter how stiff or how weak the spring finger parts of the cylinder 42 may be, the inevitable result of the forward movement of the cylinder will be to press or compress the segmental jaws 40 inwardly toward the associated nipple. The flange-like wall 33 at the forward end of the coupler absolutely prevents the jaws 40 from moving to the right. The pressure of the beveled end of the spring finger cylinder upon the beveled surfaces of the jaws must necessarily, therefore, result in a tendency on the part of the segmental jaws 40 to be pressed inwardly toward the nipple.

If the spring fingers are stiff and strong, then the segmental jaws 40 will be pressed inwardly about the nipple with great force. If the spring fingers are weak and flimsy, then the segmental jaws will be pressed inwardly with less force (dependent upon the force required to flex the spring fingers to a point where they have slid all the way up the beveled surfaces of the jaws 40). But in either case, the forward movement of the beveled end of the spring finger cylinder under the force of the grease pressure, behind the piston 43, 44, 45, will inevitably be to compress the segmental jaws radially inward about the nipple.

In claim 1 of the Butler patent the segmental jaws are described as "means carried by the" (large outside) "cylinder for compressively engaging about the nipple for locking said parts together against longitudinal displacement" "whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said means."

In claim 2 the segmental jaws are described as "radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements."

It is impossible to understand the details of Butler's specifications and drawings in any way which will eliminate the action of the spring fingers in pressing the segmental jaws inwardly "for compressively engaging about the nipple" (claim 1) and "for compressively clutching the elements upon the nipple" (claim 2).

Not only is it undeniable that the beveled forward ends of the spring fingers will inevitably exert some radially inward compressive force upon the segmental jaws;—it is undeniable also that with a nipple shoulder having a 45 degree bevel, as shown in the Butler patent, some radially inward compressive force is required to prevent the disruption of the union between coupler and nipple at the time of applying grease pressure.

What shall be the amount of this radially inward compressive force?

The patent does not, of course, answer this question in ounces or pounds. It does, however, answer it in terms of purpose and function:

"It is my object to provide a means of forcing under high pressure fluid and semi-fluid lubricating compounds into bearings and into bearing reservoirs in order that foreign material and used lubricant therein may be forced out."—(p. 1, l. 6.)

"It is a further object of my invention of providing automatic and semi-automatic means of connection between the bearing valve (i. e., the nipple) and the lubricating pressure means or grease gun so-called."—(p. 1, 1. 19.)

"It is a further object of my invention to provide

automatic and semi-automatic connections between the grease gun and the bearing valve which may or may not be locked in position as desired by the operator or may be automatically locked."—(p. 1, 1. 58.)

"Returning to Fig. 2 and its operation, it will be understood that the coupling on the end of 25 is thus pushed over 35, the segments 40 engage with the throat and are maintained in engagement by the pressure being greater on the piston within the coupling than any relief of the pressure that will be possible through the passage of the lubricant through 48."—(p. 3, l. 14.)

The specification makes it clear that the construction and mode of operation of the parts are such that the pressure of the lubricant shall maintain this engagement until the grease pressure is relieved, for, as Butler says:

"As soon as the pressure is relieved it is then possible to withdraw the coupling from the member 35 ds the pressure on the fingers 42 will be relieved and the spaced segments 40 will slip over the shoulders 41 due to the pressure of 33 against the ends of the several segments 40."—(p. 3, 1. 23.)

Butler made it clear, furthermore, that the compressive engagement of the segmental jaws 40 about the nipple for locking the parts together against longitudinal displacement, and the maintenance of this engagement until the grease pressure is relieved, is to be accomplished automatically solely by the application of grease pressure; for he contrasts this automaticity with the manual operations of the prior art, saying in this connection:

"It will be seen that this coupling eliminates the necessity for a delicate adjustment by the operator of the coupling to the valve member (i. e., the "headed nipple") which is often times difficult in restricted areas frequently found on automotive vehicles where this type of equipment is especially useful."—(p. 3, 1. 30.)

If these functions and results are to be accomplished by the mechanism shown in Fig. 2 of the Butler patent, then clearly the spring fingers 42 must be strong enough to force and compress the segmental jaws 40 inwardly and compressively about the nipple. If the spring fingers 42 are made too weak, they cannot perform the functions and accomplish the results described in the specification.

#### The Form and Shape of Butler's Spring Fingers.

There will be no question but what most of the parts shown in Fig. 2 of the Butler patent are round,—i. e., solids of revolution like cylinders or cones. Many of these parts are given names which cannot be applied to anything else. The specification says, for example, "the outer end of this head has internally threaded therein a collar 32" (p. 2, l. 91), "a conical head proper 38" (p. 2, l. 99), "a piston head" (p. 2, l. 109), "a leather sealing washer 45" (p. 2, 1. 111), "a tubular member 46" (p. 2, 1. 113), "it will be understood that 35 is threaded into the bearing" (p. 3, 1. 6), "the coupling comprising a cylinder, a piston movable within the cylinder" (p. 4, l. 41), "a coupling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder" (p. 4, 1. 58). In Fig. 2, all of these conical and cylindrical parts are shown in crosssection in accordance with the usual convention. The showing of the "spring finger" part 42 corresponds with the showing of the outer shell of the coupler into which the collar 32 is screwed, and this part is specifically described and named as a cylinder.

The piston which reciprocates in this outer cylinder is of course round. It is described as follows: "a piston head that consists of 43, a metallic washer 44 embracing between it and 43 a leather sealing washer 45" (p. 2, 1. 99. Such a sealing washer is always round, as shown for example in the many prior art patents of record. The

part 51 is described in claim 1 as "an apertured seat for engagement with the end of the nipple," and in claim 2 as "an apertured sealing seat carried by said piston for engagement with the end of the nipple." In the specification it is described as follows: "The washer 51 provides a ready means of adjusting the junction of 38 with the remainder of the mechanism, and effectively seals the connection so that the lubricant will pass through 48 into 52 after having pushed back the rivet or stud 36." The name "washer" implies that this apertured sealing seat is round, like the sliding sealing seat 26 of the coupler of Gullborg patent No. 1,307,734 (R. p. 534).

If, as we contend, the sealing washer 51 is a round leather disc, more or less tightly fitting within the bore of a cylinder 42, then these parts would appear in a longitudinal cross-section precisely as they do appear in Fig. 2 of Butler's drawings. An accurate cross-sectional view could not show them in any other way. Even the edge of the hollowed forward face of this washer is shown extending around behind of the left-hand end of the nipple precisely as though it lay within the hollow bore of a cylinder 42.

The dotted hatching of 51 corresponds with the dotted hatching of 45. 45 is expressly described as "a leather sealing washer" (p. 2, l. 111). This is the conventional manner of representing leather in accordance with the Patent Office rule book. 51 is therefore a leather washer. The sealing discs of the manually operated couplers shown in Fig. 3, Fig. 4, and Fig. 9, are hatched in dots to indicate leather sealing washers. This sealing member in Fig. 3 is described in a sentence saying, "Adjustments in size, wear and position are provided for by the yielding washer 71 between 38 and 58" (p. 3, l. 72). In his description of Fig. 9, Butler refers to "the usual washer 71 for the accommodation for the size of the parts and their wear."

In Fig. 3, the leather sealing washer 71 is undoubtedly mounted in a cylindrical bore, since the space in which 71 is mounted is a forward extension of the screw-threaded part 60 which leads to a collar, to which the following reference is made: "The collar has a cup-shaped outer end at 62 adapted to fit the *conical* head of 35, designated 38. 61 is cut away at its outer end to form a cylindrical member of smaller diameter than the rest of the body, which is designated 63" (p. 3, 1. 41).

For like reasons, the leather end sealing washers shown in Fig. 4 and in Fig. 9 are obviously located in cylindrical bores.

Fig. 2 is consistent with Figs. 3, 4, and 9 as to the manner in which this leather end sealing washer is mounted within a cylindrical bore.

If 51 is a leather washer within the cylindrical bore of 42, then obviously it is free to slide forward under grease pressure, thereby conforming with Butler's statement that "the washer 51 provides a ready means of adjusting the junction of 38 with the remainder of the mechanism, and effectively seals the connection" (p. 2, 1. 126). Similar language is used in describing the sliding sealing washers shown in the other figures. Thus, for example, in connection with the coupler of Fig. 3, Butler says, "Adjustments in size, wear, and position are provided for by the yielding washer 71 between 38 and 58" (p. 3, 1. 72). Of the construction shown in Fig. 9, he refers to "the head thereof, in which is located the usual washer 71 for the accommodation for the size of the parts and their wear" (p. 3, 1. 91).

These end sealing washers could not serve the purpose of adjusting themselves to size, wear, and position of the parts unless they were slidably mounted within the bores of their respective cylinders. Fig. 3 shows a relatively

short conical head for the nipple. Accordingly, the end sealing washer has been pushed quite far forward. In Fig. 4 the conically cupped end of the coupler is rather short, and accordingly the sealing washer 71 is shown in a somewhat forward position. The conical heads of the nipples as shown in Fig. 2 and in Fig. 4 are somewhat longer. In both of these figures, therefore, the sliding sealing washer is shown in a position at the back end of the bore.

These leather washers are subject to some considerable compression under the force of grease pressure. They could not, therefore, "effectively seal the connection" unless they were mounted to slide forward under the pressure of grease. If the leather sealing washer 51 of Fig. 2 were not mounted to slide forward in the bore of a cylinder 42, it would be squeezed and compacted under grease pressure in such a way that grease would inevitably leak out through any opening at the base or back side of the sealing washer.

The part 42 extends forwardly from the piston part 43 with an internal diameter corresponding with that of the end sealing washer 51. At a point corresponding approximately with the greatest diameter of the head of the nipple, the diameter of 42 is reduced approximately to that of the shoulder of the nipple. If, therefore, 42 is in the form of a cylinder (as we contend it to be), then the end sealing washer 51 is free to slide forward until the forward edge of the sealing washer engages the reduced diameter of the cylinder in which it slides,—in other words, until it engages the shoulder in the cylinder approximately opposite the greatest diameter of the nipple head.

We can think of no way in which these leather sealing washers shown in Figs. 2, 3, 4, and 9 could perform their described functions unless they were slidably mounted to reciprocate in cylindrical bores. These functions are described in the phrases, "the washer 51 provides a ready means of adjusting the junction of 38 with the remainder of the mechanism," "adjustments in size, wear, and position are provided for by the yielding washer 71 between 38 and 58," and "the usual washer 71 for the accommodation for the size of the parts and their wear."

If the round leather end sealing washer 51 of Fig. 2 is to function in the manner ascribed to it and to the corresponding end sealing washers of the other figures, showing manually operated couplers, it must be mounted in the bore of a cylinder 42 extending forward from the base 43 of the piston member. If 42 does represent such a hollow cylinder extending forward from 43, then the leather sealing washer 51 will operate perfectly to accomplish its required purpose as described in the specifications. If, on the other hand, 42 be taken to represent completely independent prongs extending forwardly from the base 43 of the piston member, then grease is bound to escape from the space at the back of the leather washer whenever it is pushed forward to the slightest degree. In the opinion of the Eighth Circuit Court of Appeals, it is said at page 793 of 81 Fed. (2d) that "It is not certain that said washer was intended to move away from its seat upon the face of the piston, as it appears that spring fingers mounted upon the piston would not afford a suitable environment for such movement." We agree that if "spring fingers" necessarily means wholly independent prongs extending forward from the face of the piston 43, they would not afford a suitable environment for such movement because such movement would permit all of the grease to ooze out between the base 43 of the piston and the sealing disc 51 in such a way as to destroy the very utility and purpose of the entire mechanism. Furthermore, the mere compression or forward flexing of the periphery of the sealing washer would, in the case of wholly independent and prong-like

"spring fingers," result in the same kind of disastrous escape of all of the grease.

We have heretofore urged that 42 represents what the Eighth Circuit Court of Appeals refers to in its opinion as an "inner cylinder projecting from the forward face of the niston." One of our reasons for asserting that 42 does represent such an "inner cylinder" is that if 42 be taken to mean wholly independent and disassociated prongs, then there would be a fatal escape of all of the grease from underneath the back side of the end sealing washer 51. We respectfully submit that our contention as to the form of the "spring finger" member is not answered by suggesting that the washer 51 may not have been intended to move away from its seat upon the face of the piston, because the "spring fingers mounted upon the piston would not afford a suitable environment for such movement." The fact that they would not afford a suitable environment for such movement is perhaps the most compelling reason for our contention that the spring fingers are not independent prongs but that they are the slotted or slitted ends of an "inner cylinder projecting from the forward face of the piston."

If the base 43 of the piston member be provided with an "inner cylinder projecting from the forward face of the piston," as in the plaintiff's sample of the Butler construction (Plaintiff's Exhibit 63), and if the forward and inwardly beveled end of this inner cylinder be slitted or slotted in accordance with this exhibit sample, then every purpose and function of the entire mechanism as described in the specification of the patent will be perfectly performed. No one has as yet suggested any other construction which will conform with all of the specifications and drawings, and which will perform the functions and accomplish the results described by Butler.

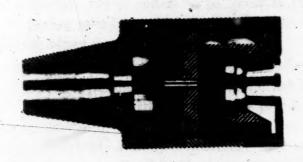
It is true that no slotting or slitting of the forward end of the inner cylinder is revealed in Fig. 2 of the Butler patent. The headed nipple occupies a position such that one cannot see the inside of the small cylinder 42; where the slits would otherwise appear. Whether or not such a slit or slot appeared in such a cross-sectional view as that of Fig. 2 would, however depend solely upon the matter of the angle at which the cross-sectional cut was taken. If the cut were taken through one of the slits or slots, then the slit or slot would appear in Fig. 2 in elevation and without cross-hatching, rather than with such cross-hatching as is shown in Fig. 2.

As a part of this brief, we are submitting a photograph of a half cross-sectional duplicate (Plaintiff's Exhibit 40) of the coupler shown in Fig. 2 of Butler's drawings. The forward end of the inner cylinder 42 is provided with three slits. The section is taken in a plane such that the appearance of the inner cylinder corresponds exactly with that shown in Fig. 2 of Butler's drawings.

The photograph shows also the cut-away half of the piston member with its "inner cylinder" in which one of the three slits quite clearly appears. (There might, of course, be more than three slits. Since, however, the custom of teaching of the art would be to provide three segmental jaws, it would seem reasonable to provide three spring fingers rather than four or five or six, or any larger number.)

The slitting or slotting of the forward end of an inner cylinder projecting from the face of an actuating piston is in accordance with the teaching and practice of the mechanical arts. Such slits are definitely shown in Fig. 4 of Lavoie patent No. 1,236,453 (R. p. 508), where the lower wedge of the part 42 (see Fig. 3) is shown in elevation, whereas the upper wedge is shown in cross-section.





The respondent made a sample of the Butler coupler in accordance with the respondent's understanding of Figure 2 of the Butler drawings and the accompanying specification. It then sawed this sample into two halves along a longitudinal plane through the axis. It then drew cross-section lines on the parts exposed by the saw cut and then took a photograph of one-half of the coupler. The lower figure is a photograph of one-half of this sample. It corresponds exactly with the showing in Figure 2 of Butler's patent, - except that the headed nipple has been removed from the coupler (Plaintiff's Exhibit 46).

In the upper figure, the piston member has been removed from its association with the other parts in order to show how the forwardly projecting cylinder was slitted into so-called spring fingers.

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In the accompanying photograph of the model (Plaintiff's Exhibit 40) built in exact conformity with Fig. 2 of Butler's drawings, we have, as previously stated, included, in the upper view, the second half of the piston and "inner cylinder" member (Plaintiff's Exhibit 40-A). The third of the three slits appears clearly in this picture. The other two slits of the trio are of course to be found in the second half of the piston member, which in this photograph is in place with the other mechanism.

If, therefore, an inner cylinder projecting forward from the face of Butler's piston 43 be slitted or slotted at its forward end in accordance with the common practice of the art, we have something which is entirely consistent with all of Butler's drawings and specifications, and something which will accomplish all of Butler's purposes and functions. There is nothing in Butler's specifications or drawings which is inconsistent with such an understanding of his structure as exemplified in the Plaintiff's Exhibit 63.

Indeed, Butler himself shows just such a slitting of a forwardly projecting cylindrical member in the manually operated construction of Fig. 4. Here it will be observed that a cylindrical member 72 extends forwardly to the right. The right-hand end of this member is bent inwardly at a 45° angle to provide jaws for gripping underneath the head or shoulder of the nipple. In this case, the hypothetical saw cut provided by the draftsman for making his crosssectional view, shows the upper cut in full cross-section, and therefore correspondingly cross-hatched from end to end. On the lower side, however, the cross-hatching extends only about a quarter of the distance from the left. Beyond that point, this member 72 is shown in elevation. means, of course, that in this case the cross-sectional cut was taken through one of an odd number of slits. cross-sectional view had been taken in some other plane, it

might have missed all of the slits, as was the case in Fig. 2. This cylinder of Fig. 4, slitted as it is at the forward end, is described as providing "spring fingers",—exactly the same name as that applied to what we very confidently understand to be the same kind of an arrangement in Fig. 2. Of this arrangement as shown in Fig. 4, Butler says, "The fingers 72 are slightly separated from one another, have turned-in ends 73 to engage with 41 of 38, and are adapted when not under compression to spring outwardly. The collar 67 is adapted to compress these spring fingers just as in Fig. 3." (P. 3, 1. 78.)

One of the reasons given in the opinion of the Eighth Circuit Court of Appeals for believing that Butler did not disclose a construction which would provide any substantial gripping of the nipple, and for believing, therefore, that Butler's spring fingers must be comparatively weak and flexible, was that "Ample room is left in the cylinder for the free play of the spring fingers" (Opinion, p. 793). We do not believe that the space between the "spring fingers" and the outer shell of the coupler can fairly be taken as indicative of any intention on Butler's part to secure or insure any large movement of the spring fingers. In any mechanism, one of the requisites is that it be possible to put the parts together: Another requisite is that it be possible to manufacture each of the several parts.

In order to be able to assemble the mechanism of Fig. 2 of the Butler patent, the outer shell is made in two parts so that the collar part 32, 33 may be unscrewed from the forward end of the cylindrical part of the head 31. When these two parts of the outer shell are separated, the piston 43, 44, and 45 may be inserted into the outer cylinder from the forward end. So also when these parts are separated, the three segmental jaws 40 may be inserted and arranged in a ring within the cylindrical bore of the collar part 32.

If this bore were not of this relatively large diameter, it would be difficult, if not impossible, to insert these parts before screwing the two halves of the coupler shell together. The diameter of the coupler shell must of course be large enough to accommodate the piston 43, 44, and 45. The piston must have large diameter as shown in the patent drawing, in order to provide an area sufficient to enable the grease pressure to exert the requisite force. When this large diameter of the cylinder must be and is provided for this purpose, and when all of the parts must be inserted from one end or the other within the two halves of the coupler shell, it does not seem reasonable to us to ascribe to the diameter of the inner bore of the forward part of this shell the purpose of providing space for any wide movement of weak and easily flexible "spring fingers".

The forward end of the collar 32 must provide an inturned flange portion 33 against which the segmental jaws 40 may abut. These jaws must be capable of a radially in and out movement sufficient to permit the insertion and withdrawal of the head of the nipple. This screw threaded collar member 32 must be made in some kind of a lathe by turning and boring operations. It is vastly easier and cheaper to bore out the collar 42 at one diameter (comparable with the outermost diameter of the segmental jaws 40) than to bore a small diameter (comparable with that of the "inner cylinder") followed by an internal peripheral groove into which the outer peripheral flanges of the jaws might be inserted. The space between the "inner cylinder" and the bore of the shell 32 is readily explained, therefore, on the mere score of facility and economy in manufacture.

There is no warrant, therefore, for ascribing any particular significance to this space.

If the spring fingers are reasonably stiff, it does not make a particle of difference how much space may intervene between them and the surrounding shell. There are ample reasons, other than the accommodation of the movement of the spring fingers, for any space which may intervene between the spring fingers and the surrounding shell.

For all of the many reasons hereinabove indicated it seems to us to be an inescapable conclusion that Butler described a coupler in which an "inner cylinder" projected forwardly from the face of the piston 43 and that the end sealing leather washer 51 was mounted to slide forwardly within the bore of this inner cylinder upon the application of grease pressure, and that it was merely the forward end of the inner cylinder which was slitted or slotted to provide fingers having a slight degree of springiness under the forces to be employed.

The sample submitted by the plaintiff as exhibit 63 conforms with this understanding of Butler's entire disclosure. Everything about the exhibit 63 sample is consistent with all that Butler has said in his specifications and shown in his drawings. Nothing in the specifications or drawings is inconsistent with the sample. We cannot conceive of any construction different from that which we have presented and which would be consistent with Butler's drawings and description of construction, mode of operation, and result.

With an inner cylinder projecting forwardly from the base of the piston and slitted or slotted at its forward end, the jaws will necessarily operate to grip or clamp the fitting as distinguished from merely latching beneath the head of the fitting. It is fundamental that the resistance offered by a spring increases with the amount of deflection from its normal at rest position. This fundamental law mechanics is known as Hooke's Law, and is usually stated: "Strain is proportional to stress." The law is illustrated in a spring balance wherein the spring is strained to a certain distance when weighing a one pound fish, and wherein

the spring is strained or stretched to ten times that distance when subjected to the gravitational pull of a ten pound fish. Butler's spring fingers 42 are necessarily flexed as they are pushed forwardly by the piston. The greater the flexure, the greater will be the inwardly directed force upon the jaws, and the tighter will be the gripping effect of the jaws upon the nipple. If locking only had been the desired function, it would have been necessary merely to provide a means which would move the jaws into position beneath the head of the fitting,—it would not have been necessary to increase the pressure of the jaws around and against the nipple upon an increase in lubricant pressure.

In order to accomplish Butler's general purpose of "high pressure" "force feed" lubrication, the spring fingers must necessarily be quite stiff. They may desirably have a very small amount of springiness. Such was demonstrated upon the trial to be characteristic of an inner cylinder extending forwardly from the base 43 of the piston and slitted or slotted at its forward end so as to provide arcuate sectors of a cylinder to engage with the segmental jaws 40. The reason for this strength can be well demonstrated by means of a calling card. When the card is flat, it may be very easily bent along a transverse line. If, however, the card is bent into a longitudinally extended trough shape, a force probably a hundred times as great will be required to bend it along a transverse line. Butler's "spring fingers" would necessarily be trough shaped or arcuate in transverse cross section. If constituted by the slitting of the forward end of an inner cylinder, they would therefore have strength against bending very much greater than would be their strength against such bending if they were of flat or other non-arcuate cross section.

Such spring fingers as Butler, therefore, contemplated

and described, would necessarily be very stiff and strong and their stiffness and resistance to bending would increase proportionately with the extent to which they were moved from normal position. As a result, the force with which the "spring fingers" press the jaws 40 against the nipple, greatly increases as the piston pushes the "spring fingers" against the jaws, and the tightness of the grip of the jaws on the nipple is necessarily proportional to the lubricant pressure acting upon the piston.

There Is Identity of Function and Result No Matter What May Be the Form and Shape of the Spring Fingers Within the Limitations of Butler's Drawing.

We have found it impossible, as has been said, to formulate any conception of a Butler device which does not have an "inner cylinder" extending forwardly from the piston 43, 44, 45, and within which the end sealing leather washer 51 is reciprocally located, and which would correspond with Butler's specifications, drawings, and claims, and which would operate in the manner described by Butler to accomplish the results described by him. Nevertheless, we have made up a sample of a piston having four wholly independent and unconnected fingers extending forwardly from the face of the piston. We have inserted a leather end sealing washer within the embrace of these four fingers. A photograph of this sample is here inserted in this brief.

This photograph corresponds with what seems to us to have been the Eighth Circuit Court of Appeals' conception of the thing described and illustrated in the Butler patent. We submit that if this piston having these four projecting prongs or fingers does represent the Eighth Circuit Court of Appeals' conception of what the Butler patent intended to illustrate and describe and claim, then for the reasons previously outlined, it rather concretely and clearly dem-



This photograph represents what we understand to have been the conception of Butler's piston member as entertained by the Eighth Circuit Court of Appeals. Any such conception of the Butler invention was quite contrary to the respondent's understanding. It was explicitly repudiated by the evidence offered by the petitioner in the instant suit.

A piston having "spring fingers" of the kind shown in this photograph could not possibly "work," - because the grease would leak out of the space between the base of the piston 43 and the sealing disc 51. The leakage would occur between the several "fingers" in such a way as to prevent the development of any grease pressure behind the sealing disc 51 and in such a way, therefore, as to prevent the accomplishment of the sealing of the joint between the end of the nipple and the coupler.

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In the accompanying photograph of the model (Plaintiff's Exhibit 40) built in exact conformity with Fig. 2 of Butler's drawings, we have, as previously stated, included, in the upper view, the second half of the piston and "inner cylinder" member (Plaintiff's Exhibit 40-A). The third of the three slits appears clearly in this picture. The other two slits of the trio are of course to be found in the second half of the piston member, which in this photograph is in place with the other mechanism.

If, therefore, an inner cylinder projecting forward from the face of Butler's piston 43 be slitted or slotted at its forward end in accordance with the common practice of the art, we have something which is entirely consistent with all of Butler's drawings and specifications, and something which will accomplish all of Butler's purposes and functions. There is nothing in Butler's specifications or drawings which is inconsistent with such an understanding of his structure as exemplified in the Plaintiff's Exhibit 63.

Indeed, Butler himself shows just such a slitting of a forwardly projecting cylindrical member in the manually operated construction of Fig. 4. Here it will be observed that a cylindrical member 72 extends forwardly to the right. The right-hand end of this member is bent inwardly at a 45° angle to provide jaws for gripping underneath the head or shoulder of the nipple. In this case, the hypothetical saw cut provided by the draftsman for making his crosssectional view, shows the upper cut in full cross-section, and therefore correspondingly cross-hatched from end to end. On the lower side, however, the cross-hatching extends only about a quarter of the distance from the left. Beyond that point, this member 72 is shown in elevation. This means, of course, that in this case the cross-sectional cut, was taken through one of an odd number of slits. If this cross-sectional view had been taken in some other plane, it

might have missed all of the slits, as was the case in Fig. 2. This cylinder of Fig. 4, slitted as it is at the forward end, is described as providing "spring fingers",—exactly the same name as that applied to what we very confidently understand to be the same kind of an arrangement in Fig. 2. Of this arrangement as shown in Fig. 4, Butler says, "The fingers 72 are slightly separated from one another, have turned-in ends 73 to engage with 41 of 38, and are adapted when not under compression to spring outwardly. The collar 67 is adapted to compress these spring fingers just as in Fig. 3." (P. 3, 1. 78.)

One of the reasons given in the opinion of the Eighth Circuit Court of Appeals for believing that Butler did not disclose a construction which would provide any substantial gripping of the nipple, and for believing, therefore, that Butler's spring fingers must be comparatively weak and flexible, was that "Ample room is left in the cylinder for the free play of the spring fingers" (Opinion, p. 793). We do not believe that the space between the "spring fingers" and the outer shell of the coupler can fairly be taken as indicative of any intention on Butler's part to secure or insure any large movement of the spring fingers. In any mechanism, one of the requisites is that it be possible to put the parts together. Another requisite is that it be possible to manufacture each of the several parts.

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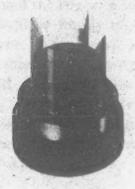
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onstrates the error of that conception, since all of the grease would escape around the edges of the sealing washer 51 and the structure would be wholly inoperative for any useful purpose whatsoever. As we stall point out in more detail at a later point in this brief, at the trial of the instant suit, the petitioner itself repudiated any such conception of the Butler invention. It is practically estopped by its own evidence in the present case, to urge the correctness of the view which seems to have been entertained by the Eighth Circuit Court of Appeals.

### The Claim in Issue Is Not Directed to a Coupler Having Spring Pressed Jaws.

Petitioner erroneously construes the word "compressively," appearing in claim 2 of the Butler patent, as limited to spring pressure. In so doing petitioner departs widely in another direction from the opinion of the Eighth Circuit Court of Appeals. In so doing it is not supported either by the opinion in Stewart-Warner v. Jiffy, by the dictionary, or by the specification of the Butler patent itself.

In no place in its opinion does the Eighth Circuit Court of Appeals suggest that the word "compressively" is limited to spring pressure. The dictionary makes it clear that this word is not so limited. Thus, in Webster's Collegiate Dictionary (5th Ed.) the word "compressively" is defined as, "tending to compress," and the verb "to compress," is defined as meaning "to press or squeeze together." There is no suggestion whatsoever that such pressing or squeezing can be accomplished by a spring but not by a relatively rigid piece of metal.

The specification of the Butler patent itself is a good refutation of petitioner's argument in this regard. The claim in issue uses both the noun "compressor" and the

"to compress," the noun "compressor" meaning "one that serves to compress." The Butler patent discloses the compressor in Figure 1. It shows a cylindrical container 9 having a piston which is positively advanced by a screw threaded stem 2 attached to the actuating handle 1. In describing this rigid and unyielding device, Butler conforms to the practice of the art wherein it is common to apply the term "compressor" to describe various kinds of positive devices for discharging lubricant under pressure.

We submit that petitioner is entirely unwarranted in attempting to construe the word "compressively" as being limited to spring pressure, as distinguished from unyielding pressure.

The Decision of the Eighth Circuit Court of Appeals Does Not Conform to the Holding of the Patent Office, Whereas the Decision of the Seventh Circuit Court of Appeals Is in Agreement with the Patent Office.

The opinion of the Eighth Circuit Court of Appeals in Stewart-Warner v. Jiffy contains an admission that its ideas of the disclosure of the Butler patent are at variance with those held by the United States Patent Office, which granted the patent. On this point the Eighth Circuit Court of Appeals said at page 793:

"Although we consider the Jiffy coupler a clear mechanical equivalent of the coupler which has been made up by the plaintiff to demonstrate the Butler patent, we find the latter to be a departure and different from the real disclosure of that patent. The file wrapper of the Patent Office in the matter of the patent to August Johnson, No. 1,984,878," reflects that claims made by Johnson were denied on account of the prior patent to Butler. The rulings indicate an

<sup>•</sup> This patent disclosed and claimed the specific structure of the Jiffy coupler.

opinion in the Patent Office as to the scope of the Butler patent differing from that reached by the District Court, but the courts are not bound to follow the Patent Office. Dwight & Lloyd Sintering Co. v. Greenawalt (C. C. A. 2) 27 F. (2d) 823, 832."

The decision of the Seventh Circuit Court of Appeals in the instant case, however, holds that the sample coupler (Plaintiff's Exhibits 62 and 63) made by respondent to demonstrate the Butler patent corresponds to the disclosure of that patent. The Seventh Circuit Court of Appeals is thus in complete agreement with the Patent Office experts concerning the real construction and mode of operation of the apparatus illustrated and described in the Butler patents.

The Evidence in the Instant Case Shows That the Butler Invention Is Not Limited to a Coupler Having Spring Fingers and That the Respondent's Commercial Apparatus Embodies the Invention of the Butler Patent.

In this suit against the Lincoln Engineering Company of Illinois the District Court and the Circuit Court of Appeals had before them evidence which was not offered in the Jiffy case and which incontrovertibly proves that the claim in issue is entitled to its literal meaning and thus covers the combination of the respondent's hydraulic coupler and the petitioner's headed nipple. This additional evidence is the testimony of the inventor, Mr. Butler, and also the testimony and exhibits presented by petitioner's own vice-president and expert, Mr. Fox. It is for this reason that petitioner's brief refers only to the decision of the Eighth Circuit Court of Appeals, and not to the evidence in the instant suit, as supporting petitioner's argument that the claim in suit is limited to what petitioner now chooses to consider as constituting spring fingers.

The original sample made by Mr. Butler and which sample was used by Butler's solicitors in preparing the application for the Butler patent in suit, was offered in evidence as Plaintiff's Exhibit 8 (R. p. 36). This original sample corresponds identically with the drawing of Figure 2 of the Butler patent in suit (R. p. 54). Mr. Butler testified that he had used this original sample in lubricating the bearings of automobiles (R. pp. 36, 37).

His testimony in regard to this matter is of much consequence in showing the utter inapplicability of the opinion of the Eighth Circuit Court of Appeals in the Jiffy case to the facts and questions involved in the present case. For the moment, and in the present connection, we refer the court particularly to the testimony of the plaintiff's expert witness at R. pp. 54-56.

He demonstrated upon the trial that the invention of the Butler patent works equally well, and in substantially the same way, regardless whether the tubular extension 42 is solid or whether it is slitted into spring fingers at the right-hand end (R. pp. 55, 245-252). Because of the loss of two of the three jaws of Butler's original device, Plaintiff's Exhibit 8, it was impossible to demonstrate its operation; but an exact and complete duplicate, Plaintiff's Exhibit 62, was demonstrated and it operated perfectly (R. pp. 245-252).

The plaintiff also introduced in evidence as Exhibit 63 another sample of the Butler device. This other sample corresponded identically with Figure 2 of Butler's patent drawings, but it embodied the spring fingers referred to in Butler's specification by such a longitudinal slitting of the tubular cylinder 42 as has been described. This "spring finger" sample also operated perfectly, thus showing that the Butler invention may assume either that form in which the cylindrical projection is slitted into spring fingers, or

in the form represented by Butler's original sample, Plaintiff's Exhibit 8, in which the cylinder 42 is not slitted into "spring fingers" (R. pp. 248-257).

These demonstrations showed that with both of these minor variants of the Butler invention, the grip between the coupler and nipple was automatically effected by the lubricant pressure, and was proportional to the degree of that pressure (R. pp. 245-250). Also, in each instance (since the slits did not extend all the way to the base part 43 of the piston member), the sealing means 51 functioned perfectly to provide a lubricant tight seal between the coupler and the nipple (R. pp. 245-254).

For all of the purposes of this suit, the defendant's position relative to this "spring finger" matter was such as to reject absolutely the "crochet needle" concept or any other such concept as the Eighth Circuit Court of Appeals apparently had relative to the "spring finger" remark of Butler's patent specification. Through its vice-president and expert witness, Fox, the defendant presented a sample of the Butler construction. (Defendant's Exhibit A-61.) In the defendant's sample, as in ours, the base 43 of the piston was provided with a tubular or cylindrical extension 42 in which the sealing washer 51 was mounted to reciprocate under the pressure of the grease admitted through the aperture 48 in the base of the piston. This cylindrical extension was, in the defendant's sample, slitted in several places at its forward end so as to provide such resiliency as would admit of the appellation "spring fingers" (Defendant's Exhibit A-61, Fox testimony, R. pp. 101-103).

<sup>\*</sup>The defendant's witness Fox made an elaborate attempt to imply and to impress the Court with the fact that in order to be operative at all, the Butler device must have "spring fingers" of very considerable resiliency, and therefore of very pronounced filmsiness,—such pronounced filmsiness that the "spring fingers" could not exert sufficient pressure upon the jaws 40 to grip the parts together with the pressure of grease. Fox's demonstrations involved the use of a tight ring (see the lower figure of Defendant's Exhibit C-21 drawing) (R. p. 105) which could be slipped

In essence this slitting of the cylinder 42 conforms exactly with the plaintiff's views as to the disclosure of the Butler patent. It was, however, directly in conflict with the views expressed by the Eighth Circuit Court of Appeals (81 Fed. (2d) 786, 793). As more fully explained in the accompanying footnote, the defendant's own sample, when relieved of a certain falsification in relative dimensions, demonstrated beyond question that the Butler construction was entirely operative to accomplish Butler's results, regardless whether the forward end of the cylinder 42 be quite rigid or whether it have some slight "give" or resiliency,—as might be effected by an appropriate slitting of an appropriate cylinder.

The sample which the defendant itself produced (Defendant's Exhibit A-61 herein, R. p. 102) to show the construction which is described and illustrated in Butler's patent, corresponded in every important respect with the

over the slitted right-hand end (for some reason the defendant awkwardly reversed the direction in which the device faces) of the cylindrical extension 42 in such a way as to eliminate any possible "give" of the "spring fingers." With this ring in place,—corresponding, as he rightly said, with an anslitted cylinder 42, he attempted to demonstrate his inability to separate the coupler from the nipple at the conclusion of a greasing operation. With the ring removed, he attempted, on the other hand, to demonstrate that only very low grease pressures could be developed because of the inability of the filmsy "spring fingers" to wedge or cam the jaws 40 with sufficient force to withstand the disrupting tendency of the grease. (R. pp. 99-104)

All of these demonstrations and arguments were completely blasted when in rebuttal the plaintiff's witness Lynn Williams, Jr., discovered and demonstrated that the real reason for the defendant's inability to operate its sample, when the filmsiness of the "fingers" was eliminated by the employment of the surrounding ring, was the fact that, contrary to the drawing, Defendant's Exhibit C-21, which Mr. Fox had presented ostensibly to illustrate his model, was that the defendant's sample was provided with a shell which did not conform either with the drawing of the patent or with Mr. Fox's drawing Defendant's Exhibit C-21. This enclosing shell C was so short from end to end that all of the piston and jaw mechanism was at all times clamped tightly between the base of the shell. The result was that there could be no longitudinal movement what seever of the piston member relative to the jaws or of the piston 45, 43, 42 relative to the cylindrical shell C. (48, pp. 235-237) In other words, it did not in this regard conform with Bütler's drawings and specifications. As soon as Mr. Williams slightly elongated the cylinder C by unscrew-

ing its forward end a thread or two, so as to correspond with Butler's disclosure the piston was given the requisite play with respect to the

full size operative sample which the Stewart-Warner Corporation exhibited and demonstrated in the Jiffy suit as representative of the disclosure of the patent. In both the plaintiff's sample in the Jiffy suit and in the defendant's (ring) sample in the present suit, the extension 42 of the piston was stiff and strong enough to effect a very great pressure upon the jaws. In both samples the cylindrical extension 42 provided a perfect cylinder in which the sealing washer 51 was slidably mounted in such a way as to respond to the pressure of the grease and to engage the end of the nipple to effect a seal therewith.

The Eighth Circuit Court of Appeals adopted an untenable contention advanced by the Jiffy Company, to the effect that the "spring fingers" must for some unknown reason extend the full length of the tubular extension 42, and therefore in such a way as to eliminate any tubular or cylindrical form in which the sealing washer 51 could slide,

shell and with respect to the jaws. This slight change overcame the defendant's falsification of its own drawing and of that of the Butler patent. As soon as this falsification was removed, the defendant's model operated perfectly and in accordance with the description and disclosure

of the Butler patent. (R. pp. 237-239)

We had then from the defendant's own hands a sample of the Butler derice which confirmed all of the plaintiff's contentions relative to the real disclosure of the Butler patent, and furthermore a model which completely rejected the theory of flimsy "spring fingers" which had been advanced by the Eighth Circuit Court of Appeals,—upon which theory slene the Eighth Circuit Court of Appeals reached the conclusion that the strong wedging and gripping action of the Jiffy Company's coupler was something quite different from some weak and flimsy action of the Butler patent,—the difference upon which alone the Eighth Circuit Court of Appeals reached the conclusion that the Jiffy Company's device did not infringe claim 1 of the Butler patent.

infringe claim 1 of the Butler patent.

All of the defendant's evidence,—all of its representations and pretenses in connection with the construction and mode of operation of the Butler device as disclosed in the patent in suit, were so completely shattered on rebuttal that they are nowhere advanced or even alluded to throughout the whole of the appellant's brief in this Court.

In this Court, counsel for the appellant point to the decision of the lighth Circuit Court of Appeals upon a different product, and trigs that this Court find that the plaintiff's commercial coupler is so rigid and so strong as to "avoid" claim 2 of the Butler patent, thereby leading to a holding of "mon-infringement,"—and this, despite the fact that in this case the defendant itself has shown by its own sample of the Butler construction that the very basis of the resoning and opinion of the Eighth Circuit Court of App. Als was erroneous and untenable.

or could be subjected to the pressure of the grease. It was upon this very matter that the Eighth Circuit Court of Appeals said, at page 793 of its opinion:

"We have considered the argument of the plaintiff that the saw slots cut into the smaller cylinder of its device result in arcuate end portions and bring the smaller cylinder of the device within the specification of 'spring fingers,' but we are not persuaded. It inner cylinder projecting from the forward face of the piston is specified in the Butler patent and we are not persuaded that one is implied by the presence of the washer 51 shown in the drawing and specified as 'providing a ready means of adjusting the junction of 38 with the remainder of the mechanism.' It is not certain that said washer was intended to move away from its seat upon the face of the piston as it appears that spring fingers mounted upon the piston would not afford a suitable environment for such movement.

"Although we consider the Jiffy coupler a clear mechanical equivalent of the coupler which has been made up by the plaintiff to demonstrate the Butler patent, we find the latter to be a departure and different from the

real disclosure of that patent."

What the Eighth Circuit Court of Appeals here says, is in effect that

"The Jiffy coupler is a clear mechanical equivalent of the coupler which has been made up by the plaintiff in the Jiffy suit to demonstrate the Butler patent, and a clear mechanical equivalent of the couplers which have been made up both by the plaintiff and by the defendant in the Lincoln suit to demonstrate the Butler patent."

What the defendant has said in this suit, is in effect:

"The sample which we have made up to illustrate and demonstrate the construction and operation of the Butler patent, is identical with the samples made up by the plaintiff in both the Jiffy suit and in the present suit. The real disclosure of the Butler patent corresponds with our sample and with those of the plaintiff. The Eighth Circuit Court of Appeals considered the Jiffy coupler to be a clear mechanical equivalent both

of our sample and of the plaintiff's samples of the construction illustrated and described in the Butler patent."

Mr. Butler was not a witness in the Jiffy suit, and his original sample was not there in evidence.

In and by its record in the instant suit, the petitioner itself rejected the only ground upon which the Eighth Circuit Court of Appeals reached its decision of non-infringement in the Jiffy case. Nevertheless, and in spite of the fact that the defendant so elaborately proved the error of the Eighth Circuit Court of Appeals, the defendant relies wholly upon a mere dictum of the Eighth Circuit Court of Appeals,—a dictum which was an outgrowth of identically this same fundamental error, and then urges this court to adopt and apply this admittedly erroneous dictum of the Eighth Circuit Court of Appeals and to do so directly in the face of the petitioner's own testimony and exhibits in the present suit.

A Brief Summary of the Concurring Evidence of Both Parties to the Effect That the Inconsequential Dictum of the Eighth Circuit Court of Appeals Was in Error, and That the Stewart-Warner Corporation's Hydraulic Lubricating Apparatus Does Embody the Construction and Operation of the Invention of Claim 2 of the Butler Patent in Suit. All of the Testimony and Exhibits of Both Parties to This Suit Reject the Views Entertained by the Eighth Circuit Court of Appeals, and Force the Conclusion That Claim 2 of the Butler Patent in Suit is Embodied in Any Combination of the Petitioner's Headed Nipple with the Respondent's Compressor and Coupler.

Upon the basis of the petitioner's testimony and exhibits in this suit (and upon the basis of the respondent's concurring testimony and exhibits), the petitioner cannot possibly urge that the Stewart-Warner Company's hydraulic lubricating apparatus does not embody the invention of claim 2 of the Butler patent;—it cannot possibly urge that the combination of the petitioner's headed nipple with the respondent's compressor and coupler does not embody claim 2 of the Butler patent in suit. The petitioner's evidence confirmed the respondent's evidence.

At the trial of the instant suit, the petitioner was obviously aware that the view entertained by the Eighth Circuit Court of Appeals was untenable. It undertook to show, therefore, that although this view was untenable, there were nevertheless other grounds upon which non-infringement might be urged. These other grounds of alleged non-infringement were completely demolished by the discovery and proof that the petitioner's demonstration apparatus had in some way been falsified.

Now, in this Court, therefore, the petitioner has entirely abandoned the contentions of non-infringement to which its evidence was directed in the District Court. It is now asking this Court to adopt the view which was entertained by the Eighth Circuit Court of Appeals despite the fact that it was a view which both parties in the instant suit demonstrated to be erroneous and untenable.

It is wholly upon the basis of this admitted and demonstrated error of the Eighth Circuit Court of Appeals that the petitioner now asks this Court to construe claim 2 of the Butler patent in such a way that it does not even apply to the Stewart-Warner Company's own lubricating apparatus.

Upon the sole basis of this contention that the parts of the equipment sold by the Stewart-Warner Company itself do not embody the invention of its own patent, the petitioner is asking this Court to hold that the Stewart-Warner apparatus does not embody the invention of the Butler patent, regardless whether its own headed nipple or the headed nipple of the Lincoln Company be incorporated as a part of it.

We respectfully submit that the contention is utterly unsound and untenable, and is contrary to all of the evidence offered by both parties in the instant suit.

We respectfully submit that the Stewart-Warner Corporation's lubricating apparatus does embody claim 2 of the Butler patent in suit.

We respectfully submit that when the petitioner's vendees combine the petitioner's headed nipple with the respondent's compressor and coupler, there is a complete and perfect embodiment of the invention of claim 2 of the Butler patent in suit.

We respectfully submit that the petitioner's manufacture and sale of its headed nipple with the knowledge and intention that its purchasers shall and will combine it in use with the Stewart-Warner Corporation's compressor and coupler parts of the complete combination, is an act of contributory infringement which the Stewart-Warner Corporation is entitled to have enjoined and stopped.

IV.

NOTHING IN THE PRIOR ART ANTICIPATES AND THEREFORE INVALIDATES THE BUTLER PAT. ENT IN SUIT.

BUTLER WAS THE FIRST TO HAVE DEVISED A LUBRICATING SYSTEM OF ANY KIND WHATSO. EVER IN WHICH THE TWO HALVES OF THE CON. NECTOR MECHANISM WERE AUTOMATICALLY GRIPPED TOGETHER, AND IN WHICH THE END OF THE NIPPLE HALF WAS AUTOMATICALLY SEALED TO THE COUPLER HALF OF THE CON-NECTOR BY THE NORMAL OPERATION OF THE COMPRESSOR WHILE IN THE ACT OF INJECTING GREASE INTO AN ASSOCIATED BEARING, AND IN WHICH THE HEADED NIPPLE PART AUTO. MATICALLY COCKED AND RESET THE GRIPPING MECHANISM END SEALING COUPLER PARTS FOR COOPERATION WITH A SECOND NIPPLE UPON DISCONNECTING THE COUPLER FROM A FIRST NIPPLE (AND IF NEED BE UPON INITIAL CONNECTION WITH THE SEC. OND NIPPLE).

NO ONE PRIOR TO BUTLER EVEN RECOGNIZED THE DESIRABILITY OR THE POSSIBILITY OF SUCH A LUBRICATING APPARATUS IN ANY FORM WHATSOEVER.

Upon the trial, Mr. Alexander P. Fox, the defendant's Vice-President and Chief Engineer and expert witness, stated on pages 221 and 226 of the record, that he regarded the Winkley Reissue patent (R. 526) as the closest thing in the prior art to the invention of the Butler patent. In

this Court, counsel for the petitioner completely abandon the Winkley patent, and stress the Newton patent No. 1,118,876 (R. 502) for an air brake hose testing device as substantially anticipating and invalidating the Butler patent in suit.

On pages 60 to 67 of this brief, we have discussed briefly and referred explicitly to the parts of the record showing that this contention is absolutely unwarranted and untenable.

### ٧.

THE BEST EVIDENCE THAT THE BUTLER PATENT DISCLOSES A REAL INVENTION OVER ANYTHING AND EVERYTHING IN THE PRIOR ART, IS THE RECORD OF THE DEFENDANT'S UNSUCCESSFUL EFFORT IN BRASS AND IRON TO INCORPORATE SUCH CHANGES AND MODIFICATIONS AS WOULD RECONSTRUCT NEWTON'S AIR BRAKE HOSE TESTING DEVICE INTO THE LUBRICATING APPARATUS OF THE BUTLER PATENT.

The testimony and exhibits which record this attempt and its failure, are briefly presented in our statement of the facts at pages 61 et seq. of this brief. This statement of the facts refers explicitly to the applicable parts of the record.

#### VI.

THE DEFENDANT'S ANSWER DOES NOT PLEAD OR RAISE ANY ISSUE WITH RESPECT TO THE PETITIONER'S CLAIMS NOW MADE IN THIS COURT FOR THE FIRST TIME THAT THE PLAINTIFF HAS VIOLATED THE CLAYTON ACT (A MATTER WHICH IS NOT IN ANY EVENT A PERMISSIBLE DEFENSE TO A BILL FOR PATENT INFRINGEMENT), OR THAT THE DEFENDANT HAS BEEN LICENSED BY THE CONDUCT OF THE PLAINTIFF TO MANUFACTURE AND SELL THE HEADED NIPPLE PARTS OF THE BUTLER COMBINATION.

The foregoing caption states all that need be said relative to these two new matters, neither of which was presented or urged in the District Court nor in the Court of Appeals.

Since neither the Clayton Act defense nor the license defense was in any way put in issue by the pleadings, neither party adduced any evidence relative to these de novo defenses.

Even if this Court were for the first time in this suit, to consider the matter of alleged violations of the Clayton Act, upon the basis of a record which was not directed to that subject in the slightest degree, we are satisfied that it must reach the conclusion that the petitioner has not violated nor attempted to violate the Clayton Act. The Clayton Act prohibits certain contracts of lease or sale. The record is barren of any evidence that any lease or contract of sale was ever even entered into by the Stewart-Warner Corporation.

As to the new defense now presented in this Court for the first time, that the Stewart-Warner Corporation has impliedly licensed the Lincoln Company to manufacture and sell the headed nipple parts of the Butler combination, the authorities are uniform in holding that any defense of license must be pleaded, and that it cannot be raised unless it has been pleaded.

No such defense was pleaded in this suit. Neither party adduced any evidence directed toward this matter of an alleged license. Any consideration which the Court might be tempted to give the matter can be based only upon surmise as to what the real facts are.

The petitioner's de novo arguments alleging an implied license to the defendant, assume the fact to be that when Stewart-Warner first sold the compressor and coupler parts of the Butler invention, the world was full of old headed nipple parts with which the purchasers could use these compressor and coupler parts. The fact of the matter is that until the Stewart-Warner Corporation put the Butler invention on the market for the first time in April, 1933, there had not been in all the world a headed nipple with which these compressor and coupler parts could be combined in use.

The record shows that within a few months of the commercial advent of the Butler invention upon the market, every automobile and every automobile truck in America was being equipped at its factory with an installation of the Butler lubricating apparatus. The petitioner's theory of an implied license means that every farmer who bought a new automobile thus equipped at its factory with the lubricating apparatus of the Butler patent, had the right thereupon to make for himself enough additional headed nipples to "increase the repertory" (Leeds & Catlin v. Victor, 213 U. S. 325, 331) of his one compressor and coupler, sufficiently to enable him to grease his reaper, his mower, his threshing machine, and his two old automobiles; in do-

ing so, he was to have the benefit of the complete lubricating apparatus of the Butler patent; he was to use the compressor and coupler parts which the automobile manufacturer had bought from the respondent and placed in the tool kit of the new car, whose bearings were equipped with the headed nipple parts which the car manufacturer had purchased from the respondent. The petitioner's theory is that since the farmer acquired some sort of a license indefinitely to expand the size and use of one small installation of the Butler invention, the Lincoln Engineering Company had the right some eighteen months later to step in and begin for the first time to manufacture and sell something which no one other than Stewart-Warner had ever manufactured or sold before, namely, headed nipple parts of a new kind, to be supplied to the farmer to enable him thus to enlarge his use and enjoyment of the Butler combination. The petitioner's theory is that, having the right to supply any number of additional nipple parts to one farmer, it has a right to do the same thing in the case of every one of the purchasers of all of the millions of automobiles which have been sold since April, 1933.

The petitioner's theory is furthermore that when the Stewart-Warner Corporation sold one of its Butler compressor and coupler units to a garageman, so that he might combine these compressor and coupler parts with the headed nipple parts of any one of the 5,000,000 automobiles whose bearings had been equipped at the automobile factories with the headed nipple parts of the complete combination, that that one sale impliedly licensed the garageman not only to grease any one of these 5,000,000 cars but also to make and sell enough additional headed nipple parts to enable him to use the complete combination of the Butler patent in greasing all of the 25,000,000 automobiles which had been sold prior to the advent of the Butler invention upon the market. The record shows (p. 40) that between

April, 1933, and March 31, 1936, the Stewart-Warner Corporation had sold 218,555,000 of the headed nipple parts of the combination. The petitioner's theory is that when the garageman bought a compressor and coupler unit from the Stewart-Warner Corporation, so that he might use it in greasing the cars equipped with all of these millions of headed nipples, he necessarily understood from the Stewart-Warner Company that the Stewart-Warner Company had thereby given him the privilege of making and selling enough of the headed nipple parts to equip the bearings of all of the automobiles which might ever be made in the future. The theory is that upon its first sale of its first compressor and coupler unit to a garageman, the Stewart-Warner Corporation lost all right to the protection of the patent laws in so far as the headed nipple parts of the combination are concerned.

The reverse angle of the petitioner's theory is this: that when Stewart-Warner first sold a dozen of Butler's headed nipple parts without insisting upon the inclusion in that sale of an additional compressor and coupler unit (as, for example, in the case of a farmer who wanted to equip the bearings of his mowing machine), then the purchaser of the nipple parts understood Stewart-Warner to be telling him that he had acquired by virtue of his 25¢ purchase of nipple parts, the right to make for his own use and for sale and use by others, an additional one, or an additional ten million compressor and coupler parts of the combination.

The theory is that since the purchaser of a dozen headed nipples from the Stewart-Warner Corporation acquired the right to make for himself, unlimited quantities of the compressor and coupler parts of the combination, the Lincoln Engineering Company acquired also the right and license to make and to sell these parts to him,—and to everybody else.

The theory is that by the close of its first day's business, the Stewart-Warner Corporation had by necessary implication lost every shred of any exclusive right to make, use or sell any part or parts of the combination which constitutes the invention of its Butler patent in suit.

Just such a theory was advanced by the defendant in the case of Leeds & Catlin v. Victor. This Court rejected the theory.

In the present suit the petitioner's theory of implied license is advanced, as we have said, without one word of evidence from any customer of the Stewart-Warner Company or from anyone else, as to what were the understandings or implications involved in the Stewart-Warner Company's sales of the invention of the patent in suit.

The petitioner invites this Court, in the absence of either pleading, or issue, or evidence, to tell the Lincoln Company and all of the world, that Stewart-Warner has licensed them to make, use, and sell all of the component parts of the very best and at the same time the very cheapest lubricating apparatus which the world has ever known.

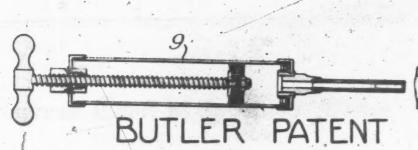
### IN CONCLUSION.

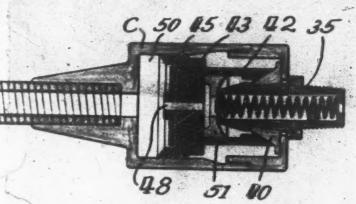
We submit that the decree of the Seventh Circuit Court of Appeals should be affirmed.

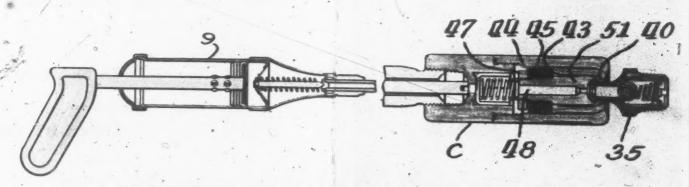
Respectfully,

LYNN A. WILLIAMS,

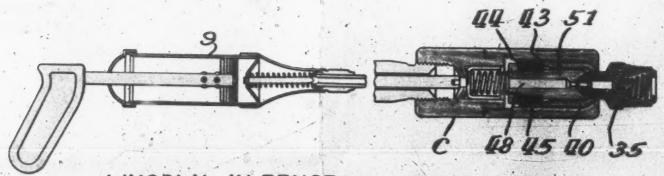
Counsel for the Respondent.







COUPLER AND NIPPLE PLAINTIFF'S EX.34



ALEMITE HYDRAULIC COMPRESSOR

AND COUPLER PLAINTIFF'S EX. 36

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IN THE

## Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

No. 608

LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner.

vs.

STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

## APPENDIX TO RESPONDENT'S BRIEF.

#### CONTAINING

- 1. Sec. 4884, Sec. 4886 and Sec. 4888 Revised Statutes.
- 2. The Opinions, Findings and Conclusions of the 7th C. C. A. and the District Court in This Cause.
- Excerpts from the Opinions in the 12 Cases Cited in Footnote 4 to the Opinion of the United States Supreme Court in Bassick v. Hollingshead and Rogers v. Alemite, 298 U. S. 415, 80 L. Ed. 1251.
- 4. Copies of Phonograph Patents Referred to in Discussions of Leeds & Catlin v. Victor.

LYNN A. WILLIAMS,

Counsel for Respondent.

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PAGE

## TABLE OF CONTENTS.

Revised	Statutes, Sections 4884, 4886 and 4888	PAGE 3
The opi	nions of the Seventh Circuit Court of Appeals he District Court in this case as follows:	0
(a)	Opinion of Judge Lindley upon merits of case delivered July 15, 1936 (R. 603-620)  Stewart-Warner Corporation v. LeVally and Lincoln Engineering Co., 15 F. Supp. 571-580	7
(b)	Findings of fact and conclusions of law entered by Judge Lindley on July 15, 1936 (R. 431-437)	17
(c)	Opinion of Judge Lindley upon petition for rehearing delivered October 5, 1936  Stewart-Warner Corporation v. LeVally and Lincoln Engineering Co., 16 F. Supp. 778-783.	24
(d)	Opinion of Judge Lindley upon application for stay of injunction delivered October 26, 1936. Stewart-Warner Corporation v. LeVally and Lincoln Engineering Co., 31 U.S. P. Q. 195-197.	30
(e)	Opinion of United States Circuit Court of Appeals for the Seventh Circuit delivered on June 29, 1937 (R. 628-644)	33

ions in the 12 cases cited in ion of the United States Suk v. Hollingshead and Rogers 5, 80 L. Ed. 1251
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534,543
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#### REVISED STATUTES.

Referred to on pages 97, 94 and 87 respectively of respondent's brief. The statutes here incorporated are those in force on the date of the filing of the application for the Butler patent in suit on February 19, 1923. They were subsequently amended to provide for plant patents.

Section 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Section 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Section 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the

same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor.



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## SUPREME COURT OF THE UNITED STATES.

No. 608.—OCTOBER TERM, 1937.

Lincoln Engineering Company of Illi- On Writ of Certiorari to nois, Petitioner.

Stewart-Warner Corporation.

the United States Circuit Court of Appeals for the Seventh Circuit.

[March 28, 1938.]

Mr. Justice Roberts delivered the opinion of the Court.

The District Court¹ and the Circuit Court of Appeals² have held be petitioner guilty of contributory infringement of the Butler Patent No. 1,593,791. We granted certiorari because of alleged conflict with our decision in Rogers v. Alemite Corporation reported with Bassick Manufacturing Co. v. Hollingshead Co., 298 U. S. 415. Like that in the Rogers case, the patent in suit has to do with apparatus for lubricating bearings, especially those of automobiles, by the use of a nipple or fitting connected with the bearing, a gun consisting of a compressor or pump for propelling the horicant under high pressure, a hose or conduit to connect the fump with the fitting, and a means of coupling the conduit to the fitting to make a tight joint during the operation of greasing. Both respondent and petitioner market apparatus for pressure lubrication, including fittings and guns. The charge is that the petitioner salls fittings such as are described in the respondent's patent which are usable, and intended to be used, in connection with the gun and coupler of the patent.

What was said in our earlier decision in respect of the prior art need not be repeated. Butler's alleged invention is in the same field and deals with similar apparatus as did Gullborg's patent, considered in the Rogers case. As there shown, it was old practice in the lubrication of bearings to use in combination a fitting conrected with the bearing through which oil or grease was to be

<sup>16</sup> P. Supp. 671; 16 F. Supp. 778.

<sup>991</sup> F. (2d) 757.

propelled into the bearing and a gun, which was joined to the fitting by a coupler. In the greasing operation the coupler is fastened to the head of the fitting and the pump is operated to drive the lubricant through the fitting to the bearing. Not only was this combination old but the elements long used in the art varied in design and dimension. Fittings were of different sizes and shapes and had diverse arrangements for their closure when not in actual use for the injection of lubricant. Guns were of many sizes and types. Various forms of coupler had been used for sealing the connection between the pump hose and the fitting In the Rogers case it appeared that fittings with lugs or pins to be engaged by the coupler were old but that Gullborg had obtained a patent for a new form of pin fitting the novel feature of which was means of automatic closure and opening for admittance of the grease in connection with a pin which passed through the bore of the fitting. This was not the patent there in suit. Gullborg also obtained a patent in which the novel feature of certain claims was a bayonet-slotted coupler so designed as to cooperate with a pin fitting (including one of the type covered by his other patent), to permit the building up of very high pressure and, by its operation upon disengagement, to obviate exudation of grease about the head of the fitting. In other claims Gullborg claimed a combination of a pin fitting, of the type covered by his fitting patent, a pump, a discharge conduit secured to the pump, and a hollow coupling member of any type (whether old and unpatented or of the improved construction disclosed in the patent) for receiving the closed end of the fitting. In the Rogers case the owner of the patent asserted the sale of any grease gun for use with the patented pin fitting of Gullborg, or the sale of any pin fitting, whether of the Gullborg type or of an old type, susceptible of use with the improved Gullborg coupler, constituted contributory infringement of the patent. We held that as the combination of pump, connecting conduit, coupler, and fitting was old, Gullborg could not, by inventing a new and improved type of coupler or fitting claim either of these in combination with the old forms of the other elements so as to exclude the public from the use and sale of the old forms of fittings or grease guns even though these might be used respectively with Gullborg's improved coupler or his improved pin fittings, because, in the combinations claimed, an old-type pin fitting, or an old-type

coupler had no novel function over those of the prior art. We said that if Gullborg had invented anything he had invented an improved pin fitting and an improved coupler and that to allow him to claim either in combination with old elements which performed no new function, would be to permit him to extend the monopoly of his invention to those old and well known devices.

With this background we turn to the patent in suit. Like that of Gullborg, the claim is for a combination. It is as follows:

"2. The combination with a headed nipple for receiving lubricant, of a lubricant compressor having a coupling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder, and having an aperture for the discharge of lubricant thereof, an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple, radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

In its petition for certiorari, and in argument upon the merits, the petitioner insisted that the respondent's commercial form of coupler was not that of the Butler patent; that the Circuit Court of Appeals for the Eighth Circuit Court had so held, and that the courts below erred in not reaching a similar conclusion. In view of the grounds of our decision we find it unnecessary to pass upon this question.

The petitioner's principal contention is that our decision in the Rogers case is controlling. We so hold. As has been said, the combination of elements disclosed is old in the art. As the Circuit Court of Appeals held, a headed nipple or fitting connected with the bearing, and to be coupled to the conduit from the grease gun, is old and unpatentable. A compressor or pump for propelling lubricant is old and unpatentable as such. The invention, if any, which Butler made was an improvement in what he styles in his specifications the "chuck" and in his claim a "coupling member".

Stewart-Warner Corp. v. Jiffy Lubricator Co., 81 F. (2d) 786.

<sup>&</sup>lt;sup>4</sup>The District Court for Western Pennsylvania has so held: Stewart-Warner Corp. v. Rogers, 15 F. Supp. 410; and see Jacques v. Universal Lubricating Systems, D. C. W. D. Pa., decided Feb. 4, 1938.

It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. Butler may have devised a patentable improvement in such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think he did no more than this. As we said of Gullborg in the Rogers case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.5 And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination. Though the respondent so concedes, it urges that, in the combination of the Butler patent, the headed nipple performs a new and different function from that which it has heretofore performed, in other combinations, in that, when the coupler is withdrawn from the nipple, at the end of the greasing operation, the rounded head of the nipple "cocks" the jaws of the coupler for the next operation. The suggestion seems to be an afterthought. No such function of the nipple is hinted at in the specifications of the patent. If this were so vital an element in the functioning

<sup>&</sup>lt;sup>5</sup> Pickering v. McCullough, 104 U. S. 310; Burt v. Evory, 133 U. S. 349; Brinkerhoff v. Aloe, 146 U. S. 515; Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co., 174 U. S. 492.

<sup>6</sup> Heald v. Rice, 104 U. S. 737, 754; Underwood v. Gerber, 149 U. S. 224, 227, 229; Deering v. Winoma Harvester Works, 155 U. S. 286, 302; Perry v. Cooperative Foundry Co., 12 Fed. 436, 438; Yale Lock Mfg. Co. v. Berkshire Nat. Bank, 17 Fed. 531, 532, 535; Troy Laundry Machinery Co. v. Bunnell, 27 Fed. 810, 813; Gates Iron Works v. Fraser, 42 Fed. 49, affirmed 158 U. S. 332; Abbott Machine Co. v. Bonn, 51 Fed. 223, 226; In re McNeill, 20 App. D. C. 294; In re Ratican, 36 App. D. C. 95; Kursheedt Mfg. Co. v. Naday, 103 Fed. 948; Langan v. Warren Are & Tool Co., 184 Fed. 720, 721; In re Bliss, 39 App. D. C. 453; Robinson v. Tubular Woven Fabric Co., 248 Fed. 526, 542; Troy Wagon Works Co. v. Ohio Trailer Co., 274 Fed. 612, 621; General Electric Co. v. Ohio Brass Co., 277 Fed. 917, 924; Radio Corporation v. Lord, 28 F. (2d) 257, 260; Schiller v. Robertson, 28 F. (2d) 301, 305; Fruehauf Trailer Co. v. Highway Trailer Co., 54 F. (2d) 691, 709; In re Germantown Trust Co., 57 F. (2d) 365, 366; McGrath Holding Corp. v. Anzell, 58 F. (2d) 205; Kodel Electric Co. v. Warren Clock Co., 62 F. (2d) 692, 695; Alemite Corp. v. Lubrair Corp., 62 F. (2d) 898, 900; In re Reed, 622 Corp. 2020 Corp. v. Lubrair Corp., 62 F. (2d) 898, 900; In re Reed, 622 Corp. 2020 Corp. v. Lubrair Corp., 62 F. (2d) 898, 900; In re Reed, 622 Corp. 2020 692, 695; Alemite Corp. v. Lubrair Corp., 62 F. (2d) 898, 900; In re Reed, 76 F. (2d) 907, 909.

of the apparatus it is strange that all mention of it was omitted." Moreover, the argument is unsound since the old art includes instances where the head of a nipple or fitting performs a similar function when the chuck is disengaged from it. The same argument was unavailing in the Rogers case. It was there contended that the pin fitting of the Gullborg patent performed a new function in causing the beneficial operation of the coupler at the moment of disengagement. We commented upon the matter thus: "The design of the bayonet slots is such that, in uncoupling, the coupling member of the gun will at first be moved slightly forward on the pin fitting thus backing up the perforated washer in the bore of the coupler." But there, as in the present case, it was the peculiar and improved mechanism of the coupler which brought about the result and not the form of the fitting. We suppose that a headed nipple has always been so headed in order that the jaws of the chuck may slip over the head in the coupling and uncoupling operation. The weakness of the respondent's position is well illustrated by what developed at argument. When interrogated as to how in the claimed combination the function of the nipple could be thought novel in any different sense than the function of the pump, counsel replied that the pump performed a novel function because the pressure it generated forced forward the piston in the coupler and caused the movable jaws to engage the fitting. If this argument is sound, the respondent may convict every one who sells a grease pump of contributory infringement. answer is the same as in the case of the headed nipple. The function of a pump has always been to force a fluid or a grease through a conduit. The fact that this function of the pump is utilized in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck does not alter the function of the pump. The invention, if any, lies in the improvement in the coupling device alone.

The courts below and the respondent rely upon Leeds and Catlin v. Victor Talking Machine Co., 213 U. S. 301, 325. In the Rogers case we held that authority not controlling. Berliner disclosed an entirely novel principle; he utilized the flat disc having a smooth bottomed groove with spiral waves in its sides not only

<sup>&</sup>lt;sup>7</sup> Union Edge Setter Co., v. Keith, 139 U. S. 530, 539; Ball and Socket Fastener Co. v. Kraetzer, 150 U. S. 111, 116; MacColl v. Knowles Loom Works, 95 Fed. 982; Kursheedt Mfg. Co. v. Naday, 103 Fed. 948, 950.

## 6 Lincoln Engineering Co. vs. Stewart-Warner Corp.

to agitate the needle connected to the diaphragm, but, in combination with a swinging arm, to propel the needle lengthwise the groove. In his combination, the disc not only performed a new function but performed it in combination with another new element,—the swinging arm which carried the needle.

We conclude that Butler's effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void.

Decree reversed.

Mr. Chief Justice Hughes and Mr. Justice Cardozo took no part in the consideration or decision of this case.

A true copy.

Test:

Clerk, Supreme Court, U. S.

## STEWART-WARNER CORPORATION v. LE VALLY et al.

No. 13955.

District Court, N. D. Illinois, E. D. July 15, 1936.

1. Patents \$26(1)

"Combination patent" may consist elther of one or more old elements, plus one or more new elements; or of a plurality of elements, all of which are old; or of a plurality of elements, all of which are new.

[Ed. Note.—For other definitions of "Combination Patent," see Words & Phrases.

2. Patents @= 26 (1%)

Old elements in new valid combination constitute "invention" and are as much a unit in contemplation of law as a single or noncomposite instrument.

[Ed. Note.—For other definitions of "Invent; Invention," see Words & Phrases.]

3. Patent == 26 (136).

No one element of combination patent is gist of combination, but it is the cooperative, co-ordinating, unified result, wherein the various elements contribute to one. unitary result, which constitutes "invention."

4. Patents @= 26 (2)

New combination of old elements, each of which contributes to new and unitary result, is patentable.

5. Patents == 260.

Defendant in suit for contributory infringement of patent which did not begin manufacture of infringing device until after commercial success was achieved by assignee of patent was estopped from asserting that patentee's nonuse rendered patent subject to strict construction.

6. Patents 328

Butler patent, No. 1,593,791, claim 2, describing combination for lubricating automobiles, held valid and contributorily infringed by manufacturer of fittings which

were sold with knowledge and understanding that they were to be used in co-operation with one element of patented combination.

In Equity. Suit by the Stewart-Warner Corporation against John R. Le Vally and another, doing business as the Lincoln Engineering Company of Illinois, and another for contributory infringement of one claim of a patent.

Decree in accordance with opinion.

Williams, Bradbury, McCaleb & Hinkle, of Chicago, Ill., for plaintiff.

Wilkinson, Huxley, Byron & Knight, of Chicago, Ill., and Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., for defendants.

LINDLEY, District Judge. .

Plaintiff, as assignee and owner of patent No. 1,593,791 to Butler, applied for February 19, 1923, and allowed July 27, 1926, sues the Lincoln Engineering Company of Illinois for contributory infringement of claim 2. The defenses are invalidity and noninfringement.

Claim 21 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nipples. The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such a manner as tocause the locking or gripping jaws to clutch or grab about or upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat. carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing, or clutching of

¹Claim 2. The combination with a headed nipple for receiving lubricant, of a lubricant compressor having a coupling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder, and having an aperture for the discharge of lubricant thereof, an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the pis-

ton aperture with a passage through the nipple radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts.

the nipple is effected automatically, and engagement of the seal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the coupler and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for Yet each of the two performing them. functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable variation in the precise dimensions in the forms and parts involved.

Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, an opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws. Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to accomplish a new result.

The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with grease and then to be coupled in succession to each of the nipples in order to friect grease into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car. manufacturer of the car buys the headed nipples and inserts them in the bearings. An automobile may require 25 to 60 such fit-Some bearings can be conveniently greased with a straight nipple; others with an elbow nipple, at angles varying from 90° to 221/2°. Some of the nipples are long, others short, and they are screwed into holes tapped with different pipe thread Consequently, the manufacturer of the device separately lists and prices each of the sizes of compressor which may be coupled to and used in conjunction with the nipples. Thus the purchaser may buy such nipples as he desires and a compressor of small capacity or one of large capacity, or even a power-driven compressor. An automobile owner may never use a compressor. He may have his car greased at a garage,

and in such case the combination occur only when the car is greased.

from that usually found in industry. Ordinarily, a manufacturer makes and sells the complete combination, but in the business of high-pressure lubricating equipment, the parts are necessarily sold separately. So prior to the commencement of this suit some 6,000,000 Alemite hydraulic guns of compressors claimed to have been embodied within the Butler patent were sold by plaintiff, and during the same period is distributed some 218,000,000 of its so-called Alemite hydraulic system nipples.

For seven years prior to January, 1983 the Lincoln Engineering Company of St Louis, Mo., who is defending this suit, and who is treated herein as the real defendant, had manufactured grease guns for plaintiff. The latter took all of its product Stewart-Warner had furnished coupler and nozzle to Lincoln, and the latter had incorporated them in compressors, which it in turn sold to Stewart-Warner. These compressors and nozzles were used in combination with hundreds of millions of Gullborg pin fittings and Zerk push typ fittings manufactured and sold by plaintiff.

Early in 1933, the Lincoln Company de cided to undertake the direct sale of it compressors to service stations and garage and took steps to create a distributing of ganization for such purpose. Prior to the time, for many years, practically all Amer can-made automobiles had been equippe at their factories with pin fittings sold an manufactured by plaintiff under Gullbon or with push type fittings, manufacture Hu and sold by plaintiff under Zerk. dreds of millions of these nipples were the field, practically to the exclusion anything else adapted to lubrication of a Consequently, the Li tomobile bearings. coln Company, in order to sell its con pressors, found it necessary to incorpora a terminal of such character as would co nect with and co-operate satisfactorily wi these Gullborg and Zerk nipples. As result it brought out its N-1 needle ty nozzles.

In April, 1933, plaintiff through its solidary the Alemite Corporation, put to on the market its new Alemite hydraul system involving the combination now lied upon. Soon thereafter the Linco Company, in its advertising, claimed the its compressors could be used not on with Guilborg fittings and Zerk push to

noszles but also with the headed nipple of the Alemite Corporation which plaintiff claims is protected by the Butler combination patent.

In July, 1934, Lincoln's advertising literature illustrated all three types of fittings as the various kinds of nipples with which the Lincoln compressor and nozzle were intended to be combined and used. Thus far, however, the Lincoln Company had not manufactured or sold any nipples of any kind for use in the lubrication of automobiles. But in the summer or early fall of 1934, after the Alemite system had been on the market for one and a half years, Lincoln entered upon negotiations with General Motors Corporation to sell to it in lieu of Alemite hydraulic fittings, theretofore manufactured and sold to it by plaintiff, a new fitting to be manufactured for the first time by Lincoln. The negotiators had under discussion round-headed and straight-sided nipples, without head, shoulder, or peripheral groove, not adapted for co-operation with the gripping jaws of the Alemite hydraulic coupler, but properly adapted for use in conjunction with the Lincoln N-1 nozzle and Lincoln Snap-On coupler.

No straight-sided nipples, other than a few samples, were manufactured or sold. On the other hand, Lincoln began to manufacture a peripherally grooved, shouldered, and headed nipple of form, size, and dimensions as to afford perfect co-operation with the gripping jaws of the Alemite hydraulic coupler. The first of these nipples were shipped to the Oldsmobile factory on November 24, 1934, and displaced the purchase and use of the Alemite fitting, Shortly thereafter, Cadillac, Buick, and Pontiac switched from the peripherally grooved and headed nipples of plaintiff to those of Lincoln. These branches of General Motors, however, except as to cars sold in foreign countries, included no purchase of couplers.

For eighteen months plaintiff had attempted to put its new coupler into the hands of every garage and service station in the United States. On April 1, 1935, 2,385,148 such couplers had been sold. It appears clearly that the sale of Lincoln Kleenseal fittings dates from the shipment made to Oldsmobile and that the fittings satisfactorily serve with plaintiff's compressor. Thus, the purchasers of automobiles from General Motors divisions could have their cars, equipped with Kleenseal

fittings, greased with the Alemite hydraulic compressors and couplers then in the hands of the service stations and garages through the country.

Mr. Fox, an engineer for Lincoln, became familiar with plaintiff's headed nipple shortly after its first appearance on the market in April, 1933. The automobile trade papers were, in that spring, summer, and fall, replete with advertisements and reading notices illustrating and describing every detail of plaintiff's hydraulic coupler, and Lincoln in July, 1984, illustrated in its circulars, Alemite headed nipples as being capable of combination with the Lincoln compressor. It is only a fair inference that during all of this period Lincoln, which seems to have been alert in its business, knew about and understood the Alemite compressor. At any rate, Mr. Fox admits that he became familiar with the coupler in January, 1935. and from that time on, Lincoln sold its peripherally grooved, shouldered, and headed nipples, adapted for satisfactory cooperation with the Alemite hydraulic compressor, with the knowledge that the purchasers of the Lincoln nipples could use them and would use them in conjunction and combination with the Alemite compressors and couplers. Furthermore, that company became familiar with the Alemite fittings immediately upon their appearance in April, 1933, and when the Lincoln nipples were first put on the market in November, 1934, they were in some thirty odd styles having arbitrary dimensions corresponding with those of the Alemite headed nipples and having their structure of such size, form, and dimensions as to make them completely interchangeable with Alemite nipples.

On April 17, 1935, a representative of plaintiff went to the place of business of Lincoln in Chicago and said to the man behind the counter that he wanted to purchase some nipples to be used with a gun which he then produced, an Alemite hydraulic compressor and coupler. The man produced Lincoln fittings. The witness tried them in co-operation with the gun and found that they co-operated with the Alemite compressor and coupler; purchased the fittings and took them away with him. He subsequently made other purchases of similar fittings for the same purpose. It thus appears in evidence that Lincoln sold the fittings upon the express understanding that they were to be used in combination with plaintiff's compressor

then exhibited to the salesman. At all times thereafter, Lincoln sold its peripherally grooved, headed, and shouldered attings in commercial displacement of plaintiff's fittings with the knowledge and understanding that the Lincoln nipples thus sold could be used and would be used by the purchaser in conjunction with plaintiff's compressor and coupler part of the complete combination under the Butler patent.

This brings us, then, to the issue in this case; that of contributory infringement. If the combination of the Lincoln nipples with the plaintiff's hydraulic compressor and coupler embodies claim 2 of the Butler patent in suit and that claim is valid, then we have a clear case of contributory infringement.

The testimony shows a complete response of the combination of the Lincoln fittings and plaintiff's Alemite hydraulic compressor and coupler to claim 2 of the Butler patent. Every element included in claim 2 is included in such combination, and the demonstrations disclose that the co-operation and the functions thereof in this combination are the same as the combination of the plaintiff's compressor coupler, and fittings.

But defendant insists that claim is in-It relies largely upon the case of Stewart-Warner Corporation v. Jiffy Lubricator Co., 81 F. (2d) 786, 792 (C.C.A. There the court held claim 1 of the Butler patent, while valid, not infringed by the Jiffy Company's sale of a certain coupler intended for use in conjunction with the cylindrically projecting end of an Alemite pin fitting. Claim 1 is not involved in this case. It included a fitting in the combination, and the claim is similar to claim 2, but the nipple is not headed. In the Jiffy Case, the nipple considered did not have head, throat, or shoulders. It was a perfectly smooth straight cylinder, and the Circuit Court of Appeals was of the opinion that the gripping action of the segmental jaws as disclosed in the Butler patent would not be sufficiently powerful to hold the coupler to such a plain, cylindrical nipple under the force of grease under pressure of several thousand pounds per square inch. The court said:

"But when we turn to the Butler patent specifications disclosing the 'means' he had in mind for 'compressively engaging about the nipple for locking said parts together,' we find no reference to any elements corresponding to such positive wedging means as above described. He describes a nipple having a head, a throat, and a shoulder. and segments adapted to slip over the head of such a nipple and embrace the throat Then he specifies spring fingers mounted on the forward face of the piston. Ample room is left in the cylinder for the free play of the spring fingers. As the piston is moved forward by the pressure of the lubricant, the spring fingers do engage and press upon the segments so that the segments are pressed upon the throat of the nipple. But the nipple is not specified to be held against longitudinal displacement by the force of the gripping. The language of the specifications is that the serments are held in position on the throat by the spring fingers, but it is the 'shoulder' on the nipple which 'prevents the retraction of the segments' or pulling away from the nipple. We conclude from consideration of all the specifications and the drawing that the inventor excluded disclosure of elements which would be actuated by the forward movement of the piston to lock the coupler to the nipple by any unyielding wedging action, but that he disclosed only such a yielding compression as should be accomplished by spring fingers.

"We find the difference between the Butler patent and the Jiffy coupler substantial, in that the mechanical or engineering principle on which the Butler patent compresses the jaws of its chuck about the bearing nipple is different from that relied upon in the Jiffy structure. As they are not mechanical equivalents and as it does not appear that Butler invented or disclosed such a chuck as that made by Jiffy, there was no infringement."

Consequently, the opinion is of no aid in the decision of this case. Here we are dealing with a nipple of the character described by Butler in claim 2, with a head, a throat, and a shoulder. The coupler incorporates segments adapted to slip over the head of such a nipple and embrace or grasp the throat thereof. It is the shoulder on the nipple which prevents the retraction of the segments. The nipple discussed in the Jiffy Case, as the court pointed out, was not of such construction. would not prevent longitudinal displacement by the force of the gripping of a compressor of Butler's type, although the would co-operate with the Jiffy compressor held not to infringe. It did not have the shoulder which prevents retraction of the

segments or the pulling away from the nipple. Lincoln sells a headed nipple, to be substituted for the plaintiff's headed nipple. It has a head, a throat, and shoulders, and when used in conjunction with the Alemite hydraulic coupler, the segments of the coupler slip over the head of the defendant's nipple and embrace the throat thereof and clutch the head within the meaning of Butler's specifications and claims.

Defendant insists that this case is controlled by the recent decisions of the Supreme Court in Bassick Manufacturing Company v. R. M. Hollingshead Company (G. S. Rogers et al. v. Alemite Corporation), 56 S.Ct. 787, 80 L.Ed. ——, and it becomes necessary to examine those decisions with some care.

These cases went to the Supreme Court when the Gullborg patent was about to expire. The question of validity of the patents involved had been raised in many District Courts and the patents held valid and infringed in various Circuit Courts of Appeals. Unfortunately, the record was rather short. Plaintiff in the Hollingshead Case offered in evidence a sample of defendant's device and relied upon physical demonstration to show that uncoupling involved the suction effect of Gullborg.

From a decree finding infringement in the sale of the compressor and coupler of the type complained of, the Hollingshead Company appealed and argued that the device complained of had no suction effect. The Circuit Court of Appeals affirmed, 73 F. (2d) 543 (C.C.A.6). Supreme Court took jurisdiction, and the question presented was as to the validity of the Gullborg patent, and whether the device complained of utilized the suction effect of the Gullborg claims. The Supreme Court held the claims valid, but said that the suction effect construction had not been proved and that the accused device did not involve the novel feature claimed in the patent. Clearly the case was determined upon a question of fact and the decision is of no help here, except in so far as it implies that if the device had been shown to be of the suction effect type, its manufacture and sale would have been held to constitute contributory infringe-

The language of the opinion indicates no intention to upset or to reverse anything that had been previously announced

as to the character of a combination pat-Such an invention is defined by Mr. ent. Justice McKenna in Leeds & Catlin Co. v. Victor Talking Machine Co., 218 U.S. 325, at page 332, 29 S.Ct. 503, 505, 53 L. Ed. 816, as follows: "A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single noncomposite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. can make no difference as to the infringement or noninfringement of a combination that one of its elements or all of its elements are unpatented."

In the companion case of Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, at page 318, 29 S.Ct. 495, 500, 53 L.Ed. 805, he said:

"A combination is a union of elements which may be partly old and partly new, or wholly old or wholly new. But, whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To become that they must be united under the same. co-operative law. Certainly, one element is not the combination, nor in any proper sense, can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. making a combination, an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of patent laws. It is in accordance with the policy of \$ 4887 of the Revised Statutes, which is urged against it."

I find nothing in the Hollingshead Case that purports in any way to disturb the previous announcements of the Supreme Court. Rather, it seems to me, the court reaffirms its adherence to its former holding.

[1-8] It is well to observe that there are three classes of combination patents as follows:

one or more new elements.

- (2) A plurality of elements, all of which are old.
- (3) A plurality of elements, all of which are new.

Obviously to any trial judge, in their final analyses, almost all patentable combinations are of the second class; namely; those in which all of the elements are of themselves old. The old elements in a new valid combination, as the Supreme Court says, constitute invention and are as much a unit in contemplation of the law as a single or noncomposite instrument. There is no one element that can be said to be the gist of the combination, but it is the co-operative, co-ordinating, unified result, wherein the various elements contribute to one unitary result, which constitutes invention. It is misleading, therefore, to speak of any one element as the essence of the invention. Thus, in Automotive Parts Co. v. Wisconsin Axle Co., 81 F. (24) 125, at page 126 (C.C.A.6), the court said: "The invention is for a composite thing, embracing several elements or parts, all of which are necessary to and co-operate in the operation of the patented unit. We cannot subscribe to the view that the test of contributory infringement in the furnishing of parts for a combination invention is whether the parts furnished constitute the gist or essence of the invention; indeed, we cannot see how it may be said that any one element or another marks the advance step or is the essence of such an invention. There are cases, it is true, in which the phrase 'essence of the invention' is used; but in our view, when the facts in those cases are considered, it cannot be said that the conclusions reached were the result of a logical selection of one or more elements of the combination as the girt or emence of the invention."

And the Supreme Court said in Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 29 S.Ct. 495, 500, 53 L. Bd. 905, "Certainly, one element is not the combination, nor, in any proper sense, can it be regarded as a substantive part of the invention represented by the combination."

The word "substantive" means "an esscattal part" or "constitutent" or "relating to what is essential."

[4] The question, of course, always, is whether there is a new patentable combination which produces a new and unitary result. The operation and functioning of all of the old elements of the new combins. tion must be affected by their presence in the new combination and each part must contribute its part to the unitary whole Otherwise, we have an unpatentable ar-But if the operation or funcgregation. tioning of each of the old elements is in some way affected by its presence in the new combination in such a way as to contribute to the accomplishment of a new and unitary result, then we have a valid patent claim.

In the Rogers Case, apparently, in the District Court the trial revolved about the question of whether the defendant sold its products with the knowledge that they would be used in conjunction with the parts sold by plaintiff. But in the Supreme Court this question of fact was abandoned and the defendant's contentions were that Gullborg patent was invalid and that the plaintiff was illegally extending its menopoly. The court held that the plaintiff might not extend the monopoly of its pat-But we do not understand that the decision in any way sought to review any prior announcement of the Supreme Court upon the subject of contributory infringement. The court did not so expressly hold, and I find in the opinion no such implication. A 1 T

However, the court held that the evidence was that the prior art embraced the use in combination of a grease gun composed of a chamber or pump, a hose, a hose coupler, and a spring-closed fitting, the coupling being of the pin and slot or bayonet type. This prior art arose from Gullborg's earlier patent, No. 1,807,733, and the Seng French patent, No. 468,869. The court observed that the plaintiff's position was that when defendant furnished a gun, a part of this old unpatented and unpatentable combination, for use with the pin fitting of Gullborg, No. 1,307,783, it contributorily infringed claims 14 and 15 of the patent in suit, because those claims describe the combination of any grease gus with the patented pin fittings. For the isvention of his fitting, Gullborg had previously applied for and obtained a patent No. 1,307,783, not then in suit. Claim 15 of the Gullborg patent then in pait described a combination consisting of the pin fitting of Gullborg's patent, No. 1,307,788, with any grease pump having a bayonet type

The court said that the question then, was whether claims 14 and 15, unless restricted to the combination of a grease gun and coupler and a pin fitting such as are described in the specifications of the patent, are void as attempting to extend Gullborg patent, No. 1,307,788, to the use therewith of any grease gun not having the suction device of the patent in suit. It held that though claims 14 and 15 are for a combination using a device of a prior patent, with grease gun or coupler of any type, they must be read as claiming only a combination of pin fittings and a gun, with coupling device having the suction effect set forth in Gullborg's patent; otherwise, the claims would be void as unlawful attempts to extend the monopoly of the pin fitting in patent 1,307,733.

The court observes that Rogers neither made nor sold pin fittings of the type covered by Gullborg. No. 1,307,738, and observed that the question was whether the patentee might further claim the combination between the patented pin fittings and any form of grease gun. He would thereby in effect be repatenting the old combination by reclaiming it with the improved element substituted for the old element. This the court said could not be done.

The thought underlying the court's remarks was that except for the suction-effect coupler combination, Gullborg had made but one invention; namely, his particular form of pin fitting; that his right to patent protection had been exhausted in his patent 1,307,733; and that he could not be permitted to extend the monopoly of this old patent. The court, in effect, reaffirmed Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 325, 29 S.Ct. 496, 53 L.Ed. 806.

The rather startling feature of the Supreme Court's opinion is the announcement that the Leeds Case patent to Berliner, No. 534,548, was a pioneer patent. I conaider this unimportant, because evidently the Supreme Court has extended, intentionally or otherwise, the meaning of the word "pioneer," for in the Leeds Case the two earlier patents, 372,786 and 382,790, described and claimed substantially everything in Berliner, 534,543, then being considered, in the way of disc, record, cabinet, and record in phonograph machines. There was an improvement, however, which I shall later discuss. As a matter of fact, the original phonograph goes back to Edison's patent in 1878. Many other

delvers in the art have procured patents since then, but Pell and Tainter, No. 341,-214, includes most of the prior art. As compared with that the Berliner invention consisted in permitting the stylus of the reproducer to be propelled by and along the sound groove of the record tablet all the way from its outer circumference to its inner end. To accomplish this, it made use of a mounting for the reproducer which would permit it to travel freely throughout this distance. Berliner's invention resided in giving the reproducer a greater degree of freedom of movement to follow the groove in the record, and, by doing so, eliminating the necessity of providing means for relatively shifting 'the record and reproducer. The new thing was the unrestricted plyotal mounting. This was pointed out by Judge Hazel in the trial court (Victor Talking Machine Co. v. American Graphophone Co. [C.C.] 140 F. 860) and by Judge Hough in the Circuit Court of Appeals in Leeds & Catlin Co. v. Victor Talkink Machine Co., 154 F. 58, 23 L.R.A.(N.S.) 1027. Consequently, the statement of the Supreme Court in the Leeds "(Rogers?)" Case that the patent "(in the Leeds case)" was a pioneer must be taken into consideration with the record disclosing its place in the history of the art.

In Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 311, 29 S. Ct. 495, 53 L.Ed. 805, the court had to do with a combination consisting of the elements: (1) A traveling disc having a sound record formed thereon; (2) a reproducing stylus, shaped for engagement with the record and free to be vibrated and propelled by it. It was, therefore, a true mechanical combination device, producing by the co-operation of . Its constituents the result specified in the manner specified. The Leeds records were equally suitable for use in connection with the Victor machine as well as their own machines. The court held that there was contributory infringement.

The result was in general the old result of producing or reproducing articulate sounds. But the new and unitary result was the production of articulate sounds by the automatic swing of the stylus across the disc record; in this respect only the patent was a pioneer. Everything circ was old. The new thing was the pivot or hinge for the stylus so that it might be propilled by the record all the way across the face of the record. The various elements pos-

15 F.Surr. -- 87

combination. Each element was necessary to the operation of the whole.

From an examination of the Leeds opindon I believe (d) that the basis of the decision relative to the Gullborg patent was that this inventor of (the) pin fitting, part of the complete combination, part of which had already been separately patented, did not bring about any new mode of operation or co-operation in or among the other elements thereof. It did not alter or modify or give new functions to any of the other parts of the combination; and, therefore, the old parts did not participate in a new way in the accomplishment of a new and unitary result. As pointed out by Judge Thacher in the District Court in Bassick Mfg. Co. v. Adams, Grease Gun Corporation 39 F. (2d) 904, 905, in discussing the Gullborg patent, where he says: "The novelty in Gullborg's fitting was merely in the use of the same pin to furnish bearings for the slot and an abutment for the spring, and it was only this specific form of construction which was patentable. Lyman Mfg. Co. v. Bassick Mfg. Co. (C., C.A.) 18 F. (2d) 29. Thus it will be seen that there was no functional novelty in combining such a pin fitting with a bayonet coupler and a grosse gun. The old combination of the gun, the bayonet coupler, and a pin fitting with ball and spring valve would work as well, and accomplish precisely the same result. To extend the combination claims to cover the use of any old gun and any old coupler on a Gullborg fitting is clearly not permissible in view of the prior art, which limits novelty in the pin fitting to a specific form of construction and deprives the aggregation of elements of all patentable novelty as a combination. Whether its elements be old or new a combination is an invention distinet from them."

The ground for decision appearing in these opinions is not applicable to the Butler patent, claim 2. Here the question is whether Butler produced a combination which achieved a new and unitary result by the co-operation of all the elements, whether all the elements have new or modified functions as a result of changes or substitution, or whether the old elements have only the old functions operating and co-operating in the old way to produce only an old result. We have seen that the combination consists of seven elements, all of which are old; that invention arises not from any one element, but from the

new unitary result. Defendant insists that the essence of the combination is the coupler, but we have seen this is a fallacious theory, for if it were correct and available to the second the nipple to the second the nipple to the second the nipple to nipple to

The headed nipple, which co-operates with the sealing seat and jaws of the conpler and thus with the piston and cylinder. is just as essential a part of the Butler invention as any of the several elements of the coupler. There is co-operation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the griping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of direct co-operation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In detaching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

Butler was the first to utilize a headed nipple and a compressor as co-operating elements of a combination whereby a grease-tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping operation of the compressor alone.

The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new.

15 F. Supp. 571

nseful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and co-operated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg Case (56 S.Ct. 787, 791, 80 L.Ed. \_\_\_\_) is applicable, for in the sense that the Supreme Court used the term ploneer, Butler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. Just as the Supreme Court said of the Berliner patent, "each element was necessary to the operation of the other."

What has been said with reference to the Holfingshead and Rogers Cases is equally applicable to the recent decision of Judge Schoonmaker in Stewart-Warner v. Rogers, and Stewart-Warner v. Universal Lubricating System, Inc., 15 F.Supp. 410, in the District Court for the Western District of Pennsylvania.

Defendant insists that the history of file wrapper is fatal to Butler's claim in view of the fact that the third claim was canceled and that the present claim construed as contended by plaintiff is equivalent to the rejected claim. I do not believe such result follows, for the plaintiff is not asking to have claim 2 interpreted or construed in such way as to include the mechanism of canceled claim 3. There is no estoppel as contended.

Defendant argues that to decree this combination valid is to deprive prior patentees of valid old elements included in the combination of their rights and to limit them and their uses. But we believe that the complaint is not well founded. Befendant is free to make and use the old articles for use in the old manner taught by the prior art, but when these old elements are included in the new combination, achieving a new and unitary result, we may not deny validity; "then, indeed, the protection which is promised by the tonstitution and laws of the United States to inventors is a poor sham. Many of the most valuable patents are combinations monpatentable elements, and the only effective mode of preventing infringement is by suits against those who, by furnishing

the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who, by advertisement of the sale of such parts and otherwise, intentionally solicit and promote such invasions of the patentee's rights." Thomson-Houston Hectric Co. v. Ohio Brass Co., 80 F. 712, 721 (C.C.A. 6), opinion by Judge Taft.

Defendant argues at length that the sealing mechanism of Butler is not in combination with the gripping mechanism but constitutes mere aggregation. It is to be observed, however, that the operation of the gripping mechanism is absolutely dependent upon the operation of the sealing mechanism and that the operation of the latter is dependent upon the operation of the former. Each is dependent upon the other. Functioning in co-operation and co-ordination is necessary to produce the desired result. This is not aggregation.

A great deal of attention has been given to the argument that the Butler invention must be limited to a filmsy spring finger between the piston and the jaws of the coupler. Irrespective of the decision of the Circuit Court of Appeals for the Eighth Circuit (Stewart-Warner Corporation v. Jiffy Lubricator Co., 81 F. (2d) 786), the record of which is not before us, it is sufficient to my that the evidence here presented discloses clearly that the operability of the Butler invention was not dependent upon any particular degree of springiness; that the device will operate satisfactorily to accomplish all the results described by Butler, if the piston is rigid or very springy, or only slightly so. Furthermore, there is nothing in the claim of the Butler invention which does not apply to the rigid assembly of Butler's original device, in evidence, in the same manner as it applies to the flexible sample made and produced by defendant. Butler in no place makes any claim which recognizes as essential this factor. I cannot read into claim 2 any requirement of apringinous or spring Angers.

Defendant cites certain pajor art. Newton patent, No. 1,118,876, discloses a device for use in testing under pressures of 100 or 150 pounds per square inch the air brake hose couplings of cars in railroad trains. It includes no headed nipple, lubricant compresser, aparture for discharging, grease, apertured scaling scat darried by a piston for ungagement with the nipple, and nothing whereby the pres-

move the said element on the piston will move the said element to compress forcibly while the lubricant is passing through the connecting parts. It teaches nothing of what Butler achieved. The modified structure produced by the defendant I believe does not follow the teaching of Newton. It is impractical for Newton's purposes, and does not teach what Butler taught.

Defendant insists that Lincoln cannot contributorily infringe the Butler patent because plaintiff's coupler part is not constructed according to the Butler patent, and chim 2 does not properly cover plaintiff's hydraulic apparatus. I believe the premises are not well founded, but that plaintiff's construction follows the teaching of claim 2.

[5] Defendant contends that nonuse of Butler device for some time renders the patent therefor subject to a strict construction, and that it should be construed so that it will not be infringed by Kleenseal fittings. It seems that Butler did not manufacture under his patent for two or three years, but immediately upon the purchase of the patent, plaintiff began to manufacture under the same and put its product into the widest possible commercial use, and such use has grown to the extent that the combination is used on 99 per cent. of the automobiles made and sold in America. This success had been attained a year prior to the commencement of manufacture and sale of the nipple of defendant. There is so legal reason why, when commercial success has resulted and a late infringer means to defend, he should be allowed to my that the patent is limited in some way because in the first two or three years of its life no manufacture took place. There is estoppel where defendant did not begin its manufacture until after commercial success had been achieved by the new owner of the patent.

Defendant contends that its nipples may be used in association with compressors and nomics other than those of the Butier patent. To my mind this is an unimportant fact. The round-headed and straight-eided nipple which defendant first

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designed could be used with all of these other compressors, but could not be used with devices built in accord with Butler. When defendant changed from a noninfringing device which it could use with other noszles, to infringing devices which could be used and were intended to be used in combination with plaintiff's couplers, it began its infringement.

As Welker on Patents (6th Ed.) p. 554, said:

"But where the machine or other property thus furnished, is useful for some other purpose than to be a part of a patented combination, or to make a patented article, or to be operated upon by a patented machine, or to be used in performing a patented process, and where he who furnishes the property, does not intend or know, when furnishing the same, that it is to be thus used, he incurs no liability to an action for infringement.

"But if he knew or intended that the property furnished by him was to be used in either of the infringing ways, he cannot defeat an action for infringement, by showing that the furnished property could have been used in some non-infringing way.

"In the absence of specific proof of knowledge or intent, the fact that the property furnished could be used with an article or machine which in itself could not be an infringement and that there are many such articles or machines in use is sufficient to absolve one who supples such property from the charge of infringement."

[6] I conclude, therefore, that claim 2 is a walld patentable combination; that the defendant's fittings sold, with the knowledge and understanding that the same were to be used in co-operation with the Alemin compressor, are a contributory infringment, and that there is nothing in defendant's contentions to avert the resulting consequences.

The findings of fact and conclusions of law incorporated herein will be included in my formal findings and conclusions adopted this date. IN THE

### DISTRICT COURT OF THE UNITED STATES

FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION.

STEWART-WARNER CORPORATION,
Plaintiff.

US.
LEVALLY, BT AL.,
Defendants.

### FINDINGS OF FACT AND CONCLUSIONS OF LAW.

I find the facts to be as follows:

(1) Plaintiff is a Virginia corporation and is the owner of the Butler patent No. 1,593,791, and of all rights thereunder.

(2) Defendant Lincoln Engineering Company of Illinois is the distributor for the Chicago territory of lubricating apparatus manufactured by the Lincoln Engineering Company of St. Louis, Missouri, a Missouri corporation.

of St. Louis, Missouri, a Missouri corporation.

(3) The defense of this suit is being conducted by and under the control of Lincoln Engineering Company of St.

Louis, Missouri, a Missouri corporation.

(4) The Butler patent in suit No. 1,593,791 illustrates, describes, and claims lubricating apparatus in which a headed or shoulder d nipple or fitting is provided for attachment to each bearing of an automobile or other machine to be supplied with lubricant from a lubricant compressor or pump by successively attaching to the nipple, a coupler with which the nipple cooperates to make a lubricant-tight connection by engagement against the end of the nipple, and which coupler has jaws engageable about the throat of the

604 nipple automatically to grip the nipple when the compressor is operated in the customary way to deliver lubricant to a bearing. The tightness of the seal effected between the nipple and the coupler, and the tightness of the grip between the nipple and the coupler, are increased proportionately with increases in the pressure of the lubricant being supplied to the bearing.

(5) In practical operation grease pressures running up to thousands of pounds per square inch are frequently required in order to force the grease into the interstices of a bearing.

(6) When the compressor is operated to inject grease under these high pressures, the tendency is to burst the compressor, coupler and the nipple, and to break open the con-

nection between the coupler and the nipple by forcing these

parts asunder.

(7) Because of the tremendous pressures which must be developed in a lubricating system, it is important in order to prevent leakage of lubricant to secure the maximum tightness of seal and the maximum mechanical grip. Both the strength of the grip and the tightness of the seal must be proportional to the pressure of the grease to be transmitted. If the seal is not sufficiently tight, the grease will escape,—and the requisite pressure cannot be developed. If the grip is not sufficiently strong, the parts will be forced asunder.

(8) In the Butler combination the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal

and grip becomes greater.

(9) In the Butler patent the end seal member is moveable and thus may adjust itself to fittings of slightly different dimensions.

605 (10) Any resiliency in part 42, referred to in the Butler patent as constituting "spring fingers," serves the purpose of compensating for any slight out-of-roundness

of the fitting.

(11) Butler, applicant for the patent in suit, presented to his solicitors for the purpose of preparing the application for the patent in suit, a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow cylindrical part, corresponding exactly to the disclosure in Fig. 2 of the Butler patent here in suit. Claim 2 of the patent describes this early sample of the invention.

cating system in which the sealing of the joint between the end of the nipple and the coupler, and the mechanical grip between the nipple and the coupler, were effected automatically by the pressure of the lubricant in and by the normal

pumping operation of the compressor.

(13) Claim 2 of the Butler patent describes in more or less detail, a combination of seven elements which may be enumerated as nipple, compressor, cylinder, piston, aperture, jaws, and sealing seat. Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result.

(14) Prior to manufacturing and selling the Alemite Hy-

draulic system of the patent in suit (exemplified in Plaintiff's Exhibits 13 to 20 and 22 to 25, inclusive) plaintiff sold lubricating apparatus (Plaintiff's Exhibits 9 and 12) of the types illustrated in Gullborg patent No. 1,307,734 and Zerk patent No. 1,475,980.

606 (15) Plaintiff commenced selling the Alemite Hydraulic lubricating equipment exemplified in Plaintiff's

Exhibits 13 to 20 and 22 to 25, inclusive, in April, 1933.

(16) Plaintiff sold 281,555,000 of the Alemite Hydraulic fitting parts of the combination during the period from April, 1933, to March, 1936, and during this same period sold 6,306,000 of the Alemite Hydraulic coupler parts thereof.

(17) Of the 6,306,000 Alemite Hydraulic coupler parts sold during the period from April, 1933, to March, 1936, approximately 4,485,000 were sold with their associated compressors to automobile manufacturers, to be put in the tool kits of the cars at the factory.

(18) The Alemite Hydraulic lubricating equipment embodying the invention of the patent in suit rapidly superseded the Gullborg and the Zerk lubricating equipment be-

cause:

(a) Under this equipment, it was not necessary to manipulate any coupler mechanism in the operation of attaching and detaching the coupler to and from the fitting,—as was necessary in effecting a connection between a Gullborg

coupler and fitting, and

(b) It was not necessary for the user to apply force to hold the coupler against the fitting to prevent separation of these parts,—as was required in effecting a connection between the coupling nozzle and fitting of the Zerk lubricating system.

Within eight months after its introduction on the market, the plaintiff's Alemite Hydraulic system had been adopted as the factory lubricating equipment of every automobile and truck made in the United States, with the single exception

of the Duesenberg.

607 (19) The mechanism embodied in the means by which the jaws are compressed about the nipple of the Alemite Hydraulic system, is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts.

(20) The Alemite Hydraulic system comprises the combination of elements set forth in claim 2 of the Butler patent.

(21) The Lincoln Engineering Company of Missouri initially engaged in the business of making and selling automobile lubricating equipment in 1925, supplying its equipment exclusively to plaintiff. This relationship between the Lincoln Company and the plaintiff continued for several years thereafter, until 1933.

(22) When, shortly after January 1, 1933, Lincoln Engineering Company began selling automobile lubricating apparatus to others than Alemite, the sales of such apparatus, equipped with couplers or nozzles of its own manufacture, were made with the knowledge and expectation that the purchasers would use the apparatus in combination and conjunction with Alemite fittings.

designing engineer of Lincoln Engineering Company of Missouri, became familiar with the nipple parts of the Alemite Hydraulic system. Although he had known of the compressor and coupler parts at an earlier date, he became familiar

with them at least as early as January, 1935.

(24) The Lincoln Company's Kleenseal nipples were thereafter sold with the knowledge that they could be substituted for the plaintiff's nipple part of the Alemite Hydraulic combination, and that they would be so combined in use. Claim 2 applies to the combination in the same way, regardless whether it incorporates the Lincoln Company's Kleenseal nipple part or the plaintiff's nipple part.

608 (25) The dimensions of the Lincoln Kleenseal fitting are exactly such as to make it cooperate satisfactorily with an Alemite Hydraulic coupler. If the dimensions selected had been slightly different, such cooperation would have been impossible. Similar fittings of slightly different dimensions would have had all other utilities which have been ascribed to the Lincoln Company's fittings, and would have cost no more to make.

(26) The defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, sell

any Lincoln Kleenseal fittings.

(27) Defendants sold "Lincoln Kleenseal" fittings with the knowledge that they were to be used in combination with the compressor and coupler parts of the Butler combination as sold by the plaintiff for use with plaintiff's Alemite Hydraulic coupler equipped grease guns.

pected that automobiles equipped with the Lincoln nipple part of the combination and sold in the United States, would be lubricated at garages and service stations. The plaintiff had previously sold millions of the compressors and coupler parts of the combination, and had endeavored to supply every public garage and service station in the United States.

(29) The Lincoln Engineering Company of Missouri in its Kleenseal fittings, duplicated, fitting for fitting, all of the arbitrary dimensions of the entire line of Alemite Hydraulic

fittings.

(30) The Lincoln Engineering Company did not sell any of its grease guns or nozzles to automobile manufacturers for tool kit equipment of automobiles sold in the United States, even though the automobiles were equipped with Lincoln Kleenseal fittings.

609 (31) There is nothing in the Butler patent which requires the use of spring fingers which can yield a sub-

stantial amount.

(32) The Lincoln Engineering Company initially submitted to the Standards Division of General Motors Corporation a fitting like the Kleenseal fitting, but without the peripheral groove or shoulder or head. But General Motors never purchased these ungrooved fittings. Instead, it purchased the Kleenseal fittings having the groove, and cooperable with Alemite Hydraulic couplers.

(33) The Alemite Hydraulic coupler will grip and form a sealed connection with a Lincoln Kleenseal fitting as well as with an Alemite Hydraulic fitting and claim 2 of the Butler patent describes one combination as well as the other.

(34) Defendant's model of Fig. 2 of the Butler patent does not accurately or fairly represent the invention of Butler.

(35) Defendants' Exhibit A-61 does not correspond to the alleged drawing thereof Defendants' Exhibit C-21.

(36) Defendants' expert, stated, that none of the prior art except Winkley Reissue Patent No. 14,667 accomplishes the

results obtained by the Butler patent.

(37) The Winkley Reissue patent No. 14,667 does not disclose the radially movable locking elements, the piston, or the means actuated by the piston for compressively clutching the locking elements upon the nipple, as Butler's invention is defined in claim 2 of his patent. The Winkley patent discloses a coupler having a spring pressed sealing member. It is not in any way analogous to the combination of elements defined in Butler's claim 2.

610 (38) The particular shape of the oil cup shown in the Richardson patent No. 8,251 has no significance of func-

tional utility.

(39) The patents to Paul No. 621,276, Ulleland No. 1,253,-309, and Pinel French No. 327,557, each discloses a construction readily distinguishable from that claimed by Butler in that in each of these prior art patents the locking elements are not actuated by any piston nor automatically by the pressure of the grease.

(40) The patent to Newton No. 1,118,876 discloses a train hose testing appliance which was never intended to be used for high pressure lubrication and could not be used for such purpose without making a great many alterations of an inventive character in its construction. It does not embody the

combination of Claim 2 of the Butler patent.

(41) Defendants' representation, Exhibit A-68, differs in many material respects from the disclosure of the Newton patent No. 1,118,876, but even with all of the changes which have been incorporated in it in an endeavor to make it work, it is not a commercially feasible or practically operative device for high pressure lubrication.

My conclusions of law are as follows:

(1) This Court has jurisdiction of this suit and of all of the parties thereto.

(2) The Lincoln Engineering Company of Missouri is

bound by the decree herein.

(3) Defendants John R. LeVally and Frederick A. Faville did not, as individuals, either jointly or severally, infringe claim 2 of the Butler patent, and the bill of complaint should be dismissed as to these parties.

(4) Claim 2 of the Butler patent No. 1,593,791 describes a new and useful improvement in lubricating apparatus.
 611 The combinations of elements set forth in this claim are

not anticipated by any combination disclosed in any patent, publication, or prior use antedating the application for the Butler patent.

(5) Butler was the first to have invented the combination

set forth in claim 2 of his patent No. 1,593,791.

(6) The Butler patent contains an adequate disclosure of a novel form of lubricating apparatus which could be made and used for the intended purpose by a mechanic skilled in the art of making lubricating apparatus.

(7) All of the parts of the lubricating system invented by Butler and disclosed in his patent, cooperate in a novel man-

ner to produce a new and unitary result. Each part is dependent upon the other for the performance of its functions, and each part performs new functions because of the presence and cooperation of the other parts.

(8) Claim 2 of the Butler patent No. 1,593,791 is valid.
(9) Defendants have contributorily infringed claim 2 of

the Butler patent by their sales of Kleenseal nipples or fittings exemplified in Plaintiff's Exhibits 27a and 27b.

(10) Plaintiff is entitled to a writ of permanent injunction enjoining and restraining the defendant Lincoln Engineering Company of Illinois, its officers, agents, employees, associates and confederates, from making, using, and selling lubricating apparatus, particularly fittings of the kind exemplified in Plaintiff's Exhibits 27a and 27b, or any other device or devices embodying the invention of claim 2 of Butler patent No. 1,593,791, or any of the parts thereof, or any of the coupler or fitting parts adapted and intended to be used in combinations embodying the invention of said patent, and from offering or

advertising so to do, and from aiding or abetting, or in 612 any way contributing to the infringement of said patent.

(11) Plaintiff is entitled to recover from the defendants the profits which said defendants have made, and the damages which plaintiff has suffered by reason of the said defendants' infringement of the Butler patent in suit, and to recover its costs and disbursements of this proceeding, in accordance with the statutes and rules in such cases made and provided.

I adopt as a part of these findings and conclusions of law and incorporate herein as a part hereof by reference all findings and conclusions of law included in my memorandum

opinion entered as of even date hereof.

Entered this \_\_\_\_\_ day of July, A. D. 1936.

Walter C. Lindley, Judge.

Filed July 15, 1930.

## STEWART-WARNER CORPORATION v. LEVALLY et al.

No. 13955.

District Court, N. D. Illinois, E. D. Oct. 5, 1936.

### 1. Equity \$\ightharpoonup 392

Practice of rearguing issues previously determined in petition for rehearing is not to be encouraged.

### 2. Patents = 315

In patent infringement sult, reasonable diligence before hearing in procuring evidence offered as newly discovered, as ground for rehearing, held not shown, where such evidence consisted of statements made to Patent Office in course of solicitation of another patent which were available before trial.

### 3. Equity \$\ightharpoonup 392

Trial court cannot consider evidence on rehearing which could have been discovered with reasonable diligence before trial.

### 4. Patents @=315

New evidence must be material or helpful in determining issues to constitute, ground for granting rehearing in patent infringement suit.

### 1. Patents 4=315

Statements of counsel for plaintiff who prevailed in patent infringement suit as solicitors for another patent which were proffered as newly discovered material evidence, held not to warrant a rehearing.

### 4. Patents == 26(1)

New combination involving only a variation in method of reducing original idea to practice, or which varies idea of means without changing essential character, or giving substantial increase to practical efficiency, is mere change of form, not constituting invention.

### 7. Patents =10

Change indicating introduction into the idea of means of a different force, a different object, or a different mode of application, is a separate invention.

### 8. Patents =316

Decree enjoining manufacture and sale of nipple contributorily infringing patent beyond limits of United States held too broad and would be limited to operation within United States.

On petition for rehearing.

Rehearing denied, original decree vacated, and decree rendered in conformity with opinion.

For former opinion, see 15 F. Supp. 571.
Williams, Bradbury, McCaleb & Hinkle, of Chicago, Ill., for plaintiff.

Wilkinson, Huxley, Byron & Knight, of Chicago, Ill., Delos G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., and Leonard L. Kalish, of Philadelphia, Pa., for defendants.

LINDLEY, District Judge.

Subsequent to the entry of decree herein, defendant Lincoln Engineering Company of Illinois filed its petition for rehearing, supported by affidavits and exhibits. Piaintiff appeared in defense thereto and filed its counter affidavits and exhibits. Extended oral arguments were heard and briefs of no inconsiderable length submitted.

[1] Defendant's first premise is the alleged discovery of additional material evidence; its second, alleged error by the court in its findings, conclusions and decree. Defendant's action in the latter respect is equivalent merely to an attempt to reargue issues previously determined, after a vol-

uminous record had been made and full and complete briefs and arguments submitted. Such practice is not to be encouraged, for, if a court has once rendered its best efforts to arrive at proper solution of questions submitted, upon complete presentation, it should not be subjected to a demand to consider the same again. Otherwise, litigation would never end; "suits would become immortal, and the decision be postponed indefinitely." Jenkins v. Eldredge, Fed.Cas. No. 7,267, 3 Story, 200, 305 (Story, J.).

[2, 3] Defendant alleges that, since the trial, it has discovered additional material evidence, consisting basically of statements made to the Patent Office in the course of the solicitation of Bystricky patent No. 2,016,809, issued on October 8, 1935 to plaintiff, as assignee. Aside from any question as to materiality, when the patent was issued on October 8, 1935, its contents and the file wrapper thereof became available to the public, including defendant. Any time thereafter any one could have obtained a complete transcript of the record in and about the application for and allowance of the patent. Moreover, at the time of the trial herein, defendant's counsel had in its possession a transcript of the record of Stewart-Warner v. Rogers and Stewart-Warner v. Universal Lubricating Systems, Inc., et al., suits tried in the District Court for the Western District of Pennsylvania, wherein defendants offered in evidence, the Bystricky patent and wherein, according to the said transcript, arguments were submitted to the court as to its admissibility and testimony was introduced regarding it, 29 pages in length, on October 30 and 31, 1985. Counsel for defendant stated, at the trial of this cause in April, 1936, that he had five volumes constituting the entire transcript in the said suit. Consequently, he was charged with notice of the contents thereof, and of the fact that the Bystricky patent had issued and that he had access to the file wrapper at any time. Furthermore, amoclate counsel, who now appears in the case, tried those cases in Pennsylvania: Thus, there is utter failure to show that defendant exercised reasonable diligence before the hearing in this cause, in procuring the evidence now proferred as newly discovered. This essential lacking, the court cannot rightfully consider the evidence. Pittsburgh Reduction Co. v. Cowles I tric Smelting & Aluminum Co. (C.C.) 04

F. 378; McLeod v. New Albany (C.C.A.) F. 378; Allis v. Stowell (C.C.) 85 F. 481; Moneyweight Scale Co. v. Toledo Computing Scale Co., 199 F. 905, 118 C.C. A. 285; Australian Knitting Co. v. Wright's Health Underwear Co., 121 F. 1917, 56 C.C.A. 678.

Thus in Combustion Utilities Corporation v. Worcester Gaalight Co. (C.C.) 190 F 155, a rehearing was denied where the defendant claimed to have discovered that another patent anticipated the one in suit, when such patent was referred to in the defendant's brief and record upon the original hearing. Similarly, because of the discovery of a mortgage on the patent, which was shown by the file wrapper then put in evidence. Money-Weight Scale Co. v. Toledo Computing Scale Co. (C.C.A.) 199 F. 265.

[4] However, despite the insufficient showing in this respect, the court, at a sacrifice of no inconsiderable time and labor, has examined the offered evidence and the other suggestions of counsel with a view to determining whether, had the plaintiff exercised diligence, there is anything in the newly offered evidence which would have changed the result or which bore materially upon the issues adjudicated. Obviously, the first question to be determined, is whether the new evidence sought to be introduced would have been material or helpful in determining the issues. If not, its proffer is wholly futile. 647, Walker on Patents: Munson v. New York (C.C.) 11 F. 72; New York Grape Sugar Co. v. American Grape Sugar Co. (C.C.) 35 F. 212; Bates on Fed. Procedure, vol. 2, \$ 683; Foster's Fed. Practice · (2d Ed.) 352.

[5] The statement in the file wrapper, to which the defendant directs the attention of the court, was made by counsel for plaintiff herein as solicitors for the Bystricky patent, in the course of argument as to patentability of certain claims previqualy rejected, to the effect that the combination there submitted, had, in the short time it had been on the market, been universally accepted by manufacturers, and become standard equipment upon automobiles made in the United States. urged by the solicitor, therefore, that any doubts as to patentability should be resolvin favor of the applicant. In itself, of course, the statement is wholly value the record, but it is urged by defendant that, followed to its logical conclusion, it means that the Alemite Hydraulic System considered by the court in the present case was thereby admitted to be exclusively the invention of Bystricky.

Upon examination of the Bystricky patent and a re-examination of the record herein, although the validity of the patent is not before me, it seems obvious to me that Butler was a pioneer in the field of lubricant pressure in the sense that that term was used by the Supreme Court in the Leeds & Catlin Case (Leeds & Catlin Co. v. Victor Talking Machine Co.), 213 U.R. 801, 29 S.Ct. 495, 53 L.Ed. 805, and that Bystricky invented an improvement upon the Butler construction. The findings of fact and conclusions of law heretofore tered, which I see no occasion to modify. pointed out Butler's invention and found that the Alemite System embraced the But-Nothing now urged moves ler invention. me in the slightest degree to conclude otherwise.

Another statement of the solicitors in the file wrapper is that the Bystricky coupler was not "practically operative except in combination with a compressor of a certain definite type, in which means are provided to relieve or partially relieve pressure in the discharge conduit so as to facilitate disconnection of the coupler from the fitting," It is contended that this argument clearly indicated that the Alemite System does not embody the Butler invention, but rather that of Bystricky. Such statement is in nowise inconsistent with the record herein, for, as we have seen, Bystricky is merely an improvement upon Butler and used the same means for release of pressure. I conclude, therefore, that the proferred evidence, if received, would be immaterial, but if material, would not have affected the result.

The contention that the court has misconstrued the decision of the Supreme
Court in Bassick Mfg. Co. v. R. M. Hollingshead Co. (Rogers v. Alemite), 298 U.
S. 415, 56 S.Ct. 787, 80 L.Ed. 1251, is clearly reargument of something 'ully presented
at the original hearing. But I have again
examined the opinions of the Supreme
Court and have had submitted to me a
transcript of the record of the Hollingshead Case in that court, as an exhibit in
answer to the petition for rehearing. I
adhere to what I have said in my opinion,
findings, and consultation in that respect

In my memorandum, I made a statement to the effect that the record in the 18 35 Stapp. 175

Counsel for defendant disagree. The word is one of comparative connotation. The transcript shows 181 pages of testimony, which is a short record as compared with the present one. But whether the record was short or long, is, after all, wholly immiterial. The important thing was the limited character of the issue presented to the court.

Due to some mental aberration, in the original opinion, I made the statement that the Court of Appeals for the Sixth Circulative Court of Appeals for the Sixth Circulative Court of the holding of the lower court. Obviously the court did not affirm the decision of the district court, but did agree with its conclusions in the respects under consideration when I used the expression.

The word "affirmed" should have been "agreed." If we attribute to the word "affirm" its strict legal significance, the error, in the words of counsel for plaintiff, was merely lapsus linguae.

We may well again refer to the character of the Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip between the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greating of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Formar devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of these, some leakage occurred, and physical manipulation entailing some labor was necessary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable pressure, and with the saving of labor resalting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler in-

to the fitting, the coupler grabs held of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for greame to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure. This, I have said, was a step forward in the greasing of automobiles. No one had ever taken it, though the art is full of grease guns and nipples. It remained for Butler to devise an easy operable combination in which the nipple and the coupler automatically co-operate, each contributing its part to the one result of high-pressure grease delivery through a sealed connection, effected automatically and increasing in efficiency with the increase of the pressure. This, I said, was invention and the combination, I held, became, therefore, a ploneer invention in the sense that the Bupreme Court used that word in the Leeds & Catlin Case.

[6, 7] Obviously, most modern inventions are of combinations. Changes in the art are effected either by the addition of new elements, the withdrawal of existing elements, alteration in their qualities or arrangement or substitition of a new element for one previously employed. Each of these changes may effect a mere change of form, or an improvement of an old invention, or a new invention. If the new combination involves only a variation in the method of reducing the original idea to practice or if, while varying the idea of means, it neither changes its essential character nor gives substantial increase to its practical efficiency, it is a mere change of form, involving no invention. "If the change indicates the introduction into the idea of means of a different force, a different object, or a different mode of application, it is more than a change of form, more oven than an improvement; it is a separate invention. If it preserves the essential characteristics of the original invention, applying the same force to the same object by the same method, but accompitating results with higher excellence or with greater economy of time or no and is not the product of mechanical skill alone, it is an improvement." Robinson on Fatonts; vol. 1, ch. 11, § 215, p. 200. (Italin mine.)

"Where the apparent variation in the original invention produces no change in its effects or in the economy of time or piwer, if the factors and the mode of operation of the oniginal and improved inventions are the same, the variation must be m embodiment alone; if different, the inventions are entirely independent of each other. Where the effects produced by the invention in its changed condition differ in ture from those accomplished by it in the old, the change has passed beyond the limthe of a more improvement and has requited in a new invention. If the effects, although the same in nature, are so enhanced in excellence that the original idea of means, in no form of embodiment, could have produced them, the change is more than formal, but may be either an improvement or a new original invention. In this case, as in that wherein no change occurs in the effeets, the original and improved inventions must be compared as operative means and examined in their mode of action as well as in the subordinate idea of which each is composed. If this examination discloses a substantial difference, either in the nature of the peration or the means, the two inventions are distinct; otherwise the latter is a mere improvement on the earlier." Robinson on Patents, vol. 1, ch. 11, \$ 216. (Italics mine.)

So, here, Butler introduced into the art the idea of an automatic sealing connection achieved by the size and character of elements, which, in themselves, were old. But he employed a different mode of operation. He achieved his object by means of a different force and according to a different and new conception. His invention then was not an improvement but a new and separate invention, and, within the reasoning of the Supreme Court in the Leeds & Catlin and the Hollingshead and pers Cases, a pioneer. In the latter two es the court was not dealing with a mbination patent wherein, by the use of a nipple of a certain particular form and shape and dimensions co-operating with the gripping jaws of a coupler of special form and shape, an automatic unbreakable meetion was achieved, making possible t highly desirable thing in automobile militated measure. Butter did so a certain coupler with any let. He did not combine a certain nipis with any coupler. He was not, as the

Supreme Court believed Gullborg had done, trying to extend his patent to a combination of a certain nipple with one kind of grease gun. Quite to the contrary, he demonstrated conception of a new creative thought, the achievement of a new valid combination in which not only the coupler was essential, but in which also the nipole of peculiar shape and dimension was essential. He produced a new combination a new arrangement of known elements, by virtue of which he produced an entirely new and beneficial result. He developed new functions and new properties and achieved novelty, resulting in great commercial success.

In this situation, defendant entered the field and developed its nipple of equivalent form, shape, and dimensions, which it sold. obviously, for use with Alemite guns, supplanting in the combination of Butler the nipple essential to his success. It is a striking fact that a nipple of this shape and dimension was not necessary to the operation of defendant's greage gun or of any guns other than those of plaintiff or of infringers or licensees of plaintiff-a fact of tremendous significance in determining the purposes and intent of defendant. It sold grease guns which operated with straightheaded nipples as well as with nipples with head and shoulders. It first made straight-headed nipples and exhibited themto General Motors Corporation, but it sold to that company only nipples of infringing character, a character not essential to any combination other than plaintiff's,

Despite the fact that the court would have been justified in denying the petition for rehearing because nothing therein constituted newly discovered evidence and because the record shows that the defendant failed to exercise reasonable diligence to discover the evidence claimed to be newly discovered and despite the inclusion in certain affidavits of improper, well-nigh scandalous, irrelevant averments, I have examined everything submitted, re-examined the authorities, and again endeavored to make myself clear. Clearly, no new material evidence has been suggested. The attempt to reargue the merits of the case, though not exactly praiseworthy upon the part of counsel, has been met by a reexamination of the record and of my findines and conclusions. The petition for aring is denied.

[8] It appears that the decree was too broad in enjoining the manufacture and

### STEWART-WARNER CORPORATION V. LEVALLY

16 F. Supp. 778

sale of the nipple contributorily infringing, beyond the limits of the United States. Accordingly, the original decree is vacated, and a decree properly enjoining defendants only within the United States and in conformity with my findings of fact and conclusions of law and this memorandum will be entered.

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### District Court, N. D. Illinois STEWART-WARNER CORPORATION

JOHN R. LE VALLY and FREDERICK A. FAVILLE, doing business as Lincoln Engineering Company of Illinois, and Lincoln Engineering Co. of Illinois Equity No. 13965 Decided Oct. 26, 1936

Patents-Injunction-In general-

Whether court shall grant supersedeas lies within its discretion and that discretion should not be abused; supersedeas is denied where infringement is clear and can be avoided readily by slight change which defendant is already prepared to make.

Patents-Appeals to Circuit Court of Appeals-In general-

District Court approves bond on appeal, enters order and citation, but does not prove and court of errors which put into its words and citation, expressly disclaimed in its memoranda; court does not tell clerk what shall be incorporated in record or go in praccipe.

On defendant's petition for supersedeas and stay of injunction.

(See also 30 USPQ 343 and 31 USPQ 171.)

LYNN A. WILLIAMS for plaintiff; DELOS G. HAYNES for defendants.

LINDLEY, District Judge.-It is obvious. of course, that whether the Court shall grant a supersedeas, lies within its discretion, and that discretion should not be

This case has been before the Court for some time and a rather extensive record was made up on the trial of the case. The Court expended a great deal of time, care and study in the preparation of its memoranda, its findings of fact and con-clusions of law, and a decree was entered [30 USPQ 343]. A petition for rehearing was filed and an assignment of errors upon the part of the Court, and on September 12th, a rather extensive hearing was heard upon that, and again, the Court made a scrutiny of the record and again gave its best efforts to the examination of the record and the decisions which it was contended he had a complete misapprehension of, and again a memorandum was prepared and submitted to Counsel, and again a decree entered, modifying in one particular a provision of the decree which was obvious'y too wide [31 USPQ 171].

Now, it is desirable that litigation be ended; it is desirable that there be some diligence toward the prosecution of an appeal and the early disposition of it. I have the conviction that this patent is I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a continuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary—the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that

tort in the protection of the defendant's interests, I am not disposed at this time, in view of the time that has elapsed since the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals. That Court may grant a supersedeas. I want this case heard on appeal and heard soon, and I think if I deny supersedeas, I can speed matters up so that it can be heard at the January session. I can't see that this defendant can be injured in any way. Of course, it is a selling agency, but its selling agency is allied with the manufacturer and the manufacturer defended the case. They can make their nipples, as they proposed, with a straight side; they can eliminate the head and shoulder; they can do that overnight. They have their drawings all made they have had them for several years. They started out with the straight side nipple but the Oldsmobile people wouldn't take them.

The prayer for supersedeas will be denied, bond for the appeal to be fixed at Three Hundred (\$300.00) Dollars, and the form of the order will be the form submitted by Mr. Williams.

I don't approve of the assignment of errors, for they put into my words something which I expressly disclaimed in my memoranda, and I don't want the Court of Appeals to be misled as to what I did hold. I have tried to make it clear in the two memoranda which I prepared in this case, and I shall not be misquoted without an expression of my disapproval of the form of the assignment of errors, and I shall not tell the clerk at this time what shall be incorporated in the record and what shall go into the practipe, be-cause that is pre-judgment. The rule is that that should be made up when the praecipe is filed.

The bond for the appeal in this case shall be fixed at Three Hundred Dollars (\$300.00) and the citation be issued as of this date, and I suppose you can get service upon Mr. Williams at this time,

since he is present.

Mr. Williams: I accept service right

The Court: You have your bond, Mr. Haynes?

Mr. Haynes: It will be less effort to file a bond for One Thousand Dollars than Three Hundred Dollars, as I have a bond for that amount.

The Court: Very well, I will make it One Thousand (\$1,000.00) Dollars, so that you will have it. The Massachu-setts Bonding and Insurance Company is a recognised bonding company?

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THE COURT OF THE PARTY OF

Mr. Haynes: It has been signed by an attorney-in-fact who tells me his name the record show the bond approved, order entered and citation issued.

## NOIS V. STEWART-WARNER CORPORATION

No. 6103.

Circuit Court of Appeals, Seventh Circuit. June 29, 1937.

Rehearing Denied Sept. 150 1937.

### 1. Patents == 26 (1)

A "combination" contemplates a plurality of units, but patentable invention can only reside in a "combination" when it is considered as a unit.

[Ed. Note:-For other definitions of "Combination (In Patent Law)," see Words & Phrases.]

### 2. Patents ==41

If all elements of unit are old but have never appeared together in combination, and they coact so as to avoid charge of aggregation, the combination is not lacking in novelty so as to bar patentability.

### 3. Patents 42

. Where combination consists of five elements and inventor uses four elements in same way and for same purpose as in previous combination, but substitutes new element for remaining element of old combination and obtains desirable results, new combination is not lacking in novelty so as to bar patentability.

### 4. Patents == 41

Where combination consists of five elements and inventor uses four old elements in same way and for same purpose as in previous combination but substitutes for remaining element old and well-known element which has never been used in combination with such other four elements, new combination may be patentable.

### 5. Patents @= 28(114)

An old combination may not be repatented.

### 6. Patents == 328

Patent No. 1,598,791, claim 2, dealing with a lubricating apparatus, is not invalid for anticipation by prior art.

### 7. Patents 4-42

If a new product is found to be patentably novel, it is immaterial whether patentable novelty is of pioneer type or mere improvement type of invention.

### 8. Patents 4=328

Patent No. 1,598,791, claim 2, dealing with a fubricating apparatus, is valid, as de-

LINCOLN ENGINEERING CO. OF ILLI- scribing a "combination," and not an gregation."

> [Ed. Note.-For other definitions of "Aggregation," see Words & Parasse.]

### 9. Patents \$26 (1%)

The names of various parts embodied in patent did not determine whether unit was "combination" or "aggregation," and if there was coaction of elements so as to make single unitary structure, there was a patentable "combination."

### 10. Patents == 259 (2)

The supplier of an element in a valid combination embodied in a patent might be guilty of infringement, though element was not patentable, and was old.

### 11. Patents @= 255

If element of patented combination in very nature of its use wears out, new element may be furnished without producer's infringing.

### 12. Patents @== 226, 259 (1)

An infringer and a contributory infringer are tort-feasors.

### 13. Patents == 259 (1)

The maker, buyer, or seller of nonpatented article is guilty of "contributory infringement" only when it knows that nonpatented element is to be used in connection with other elements in valid combination covered by valid patent.

[Ed. Note.-For other definitions of "Contributory Infringement," see Words & Phrases.]

### 14. Patents 4=259 (1)

There can be no "contributory infringement" unless elements in question comprise a "combination," and not merely an "aggregation" since no valid patent can cover an "aggregation."

### 15. Patents -25/ -

As respects patents, the term "aggregation" defines a phase of general term "noninvention," and when claims compose plurality of elements and their individual or collective selection fails to evidence exercise of inventive faculty, it is not a patentable discovery, regardless of whether coacttion of elements is present, but inventive concept may reside in selection of part or parts of numerous old elements, if a is unusual and hitherto pressing ansolved problem is thereby evered

### 18. Palents 4=26 (1%)

Invention may be evidenced by modifying coaction of elements, but there may be invention without coaction.

### 17, Patents 4=25, 28(1)

"As respects distinction between "combination," which is patentable, and "aggregation," which is not, a "combination" is present if there be correlation or co-ordination of elements which mutually contributes to accomplishment of some result, and there need be no interdependency in sense of one element being dependent on the others for functioning.

### 18. Patents @=45.

As respects, patentable novelty, evidence of wide and popular acceptance of patented apparatus is controlling in doubtful cases.

### 19. Patents 4=328

Patent No. 1,593,791, claim 2, dealing with a lubricating apparatus, is not invalid for lack of patentable novelty.

### 20. Patents \$328

Patent No. 1,593,791, claim 2, dealing with a lubricating apparatus, was infringed.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

Patent infringement suit by the Stewart-Warner Corporation against the Lincoln Engineering Company of Illinois. From an adverse decree, defendant appeals.

### Affirmed.

Leonard L. Kalish, of Philadelphia, Pa., Deles G. Haynes and Lloyd R. Koenig, both of St. Louis, Mo., and Milton T. Miller, of Chicago, Ill., for appellant.

Lynn A. Williams, of Chicago, Ill., for appellee.

Before EVANS, SPARKS, and MA-JOE, Circuit Judges.

EVANS, Circuit Judge.

Appellee is the owner of the Butler Patent, No. 1,593,791. Appellant is the distributor of the Lincoln Engineering Company of St. Louis, Missouri, which is conducting and controlling the defense to this litigation. It is charged with infringing the Butler Patent. The trial was a long one, and the District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the

defenses, the state of the art, as well as other material issues. These findings favored the appellee.

Accompanying the findings was an opinion which set forth the reasons for the conclusions which the court reached. About three months later, upon a petition for rehearing filed by appellant, the court filed a second opinion, which may be found in Stewart-Warner Co. v. Levally (D.C.) 18 F.Supp. 778. Three weeks later the const. filed a third opinion which dealt with questions raised by appellant. The third opinion appears in 31 U.S.P.Q. 195. Reference in made to the places where these opinions appear because it will, we think, justify a more abbreviated statement of the facts. Different conclusions respecting the same claim (No. 2) of this patent, so appellant asserts. ere reached by other Federal courts. stewart-Warner Corporation v. Jiffy Lubricator Co. (C.C.A.) 81 F. (2d) 486; Stewart-Warner Corporation v. Rogers (D.C.) 15 F.Supp. 410.

The decree subsequently entered granted an injunction that restrained future infringements of the patent and directed an accounting of profits and damages occasioned by past infringements.

The application for the Butler patent was filed February, 1923, and the patent is sued July 27, 1926. It related to Lubricating Apparatus.

Claim No. 2, the one in issue, reads as follows:

"2 The combination with a headed nipple for receiving lubricant, of a lubricant compressor having a coupling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder and having an aperture for the discharge of lubricant thereof, an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple, radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressively clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts."

The patent deals with a lubricating apparatus. Butler's object, as stated by him, was "to provide a means of forcing under high pressure fluid and semi-fluid lubricat-

'ag compounds into bearinga, \* \* in order that foreign material and used lubricant therein may be forced out of the bearing. \* \* \*" His specifications described a "co-operating bearing and self sealing bearing lubricating valve, \* \* \* a bearing reservoir for lubricant and means for automatically feeding the lubricant therefrom to the bearing, \* \* \*" and "automatic and semi-automatic means of connection between the bearing valve and the lubricating pressure means \* \* \*" are described.

Judge Lindley, describing the patent, mid:

\*\* Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the and of the nipple and the coupler and the mechanical grip between the nipple and the coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, . . the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized \* \* \* due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure."

In short, the asserted superiority and virtue of the Butler lubricating apparatus are twofold: (a) The apparatus permits of the application of thousands of pounds of pressure with no loss of grease, and (b) an easily operable device wherein the coupler's grip increases with the pressure of the grease.

The substance of the more important findings of the trial court is:

1. In practical operations, grease pressures running up to thousands of pounds per

square inch are frequently required in order to force the grease into the interstices of a bearing.

- 2. When the compressor is operated under these high pressures, the tendency is to burst the compressor, coupler, and the nipple, and to break open the connection between the coupler and the nipple by forcing these parts asunder. To avoid this break or separation of coupler and nipple, the maxinum tightness of seal and the maximum mechanical grip must be obtained and must be proportional to the pressure of the grease to be transmitted.
- 3. In the Butler apparatus the automatic end seal and the automatic grip both become more effective as the lubricant pressure increases and the need for a more effective seal and grip becomes greater. Butler's seal member is movable and thus may adjust itself to fittings of slightly different dimensions.
- 4. In the Butler combination the end seal and automatic grip both become more effective as the lubricant pressure increases. The end seal member is movable and thus may adjust itself to fittings of slightly different dimensions. Any resiliency referred to in the patent as constituting spring fingers serves the purpose of compensating for any slight out of roundness of the fitting.
- 5. Butler presented to his solicitor a sample device including a coupler, the jaws of which were forced into clamping engagement with the nipple by a relatively rigid, hollow, cylindrical part corresponding exactly to the disclosure of Figure 2 in the Butler patent.
- 6. Butler was the first to devise a lubricating system in which the sealing of the joint between the end of the nipple and coupler and the mechanical grip were effected automatically by the pressure of the lubricant, which pressure was produced by the normal pumping operation of the compressor.
- 7. Claim 2 is the only one in issue and describes a combination of seven elements:
  (a) nipple, (b) a compressor, (c) cylinder, (d) piston, (e) sperture, (f) jaws, (g) sealing seat. "Each and all of these parts cooperate with one another in new ways in the accomplishment of a new and unitary result."
- 8. Appellee began selling Butley labelcating equipment in April, 1983, and prior thereto sold apparatus covered by the Gullborg and Zerk patents. From April, 1983,

to March, 1986, it sold 281,555,000 fitting parts of the Butler combination, and 6,306,-000 coupler parts. Over half of the latter were sold with the associate compressors to automobile manufacturers, to be put in the tool kits at the factory. Within eight months after its introduction, the Butler system had been adopted as the factory inbricating equipment of every automobile and truck made in the United States with one exception.

\* "The mechanism embodied in the means by which the jaws are compressed about the nipple of \* \* (appellee's) system is identical in its mechanical principles with that disclosed in the Butler patent. It is a simple equivalent involving a mere reversal of parts."

10. Appeller's system comprises a combination of elements, as set forth in claim 2 of the Butler patent.

11. Prior to 1933, appellant was engaged in the business of making and selling automobile lubricating eqquipment to appellee. In 1933, it began selling lubricating apparatus to others. It made and sold couplers and nossles with the expectation that they would be used with appellee's apparatus. Its nipples were sold with the knowledge that they could, and would, be used as part of appellee's combination. The dimensions of appellant's fittings are exactly such as to fit appellee's coupler. If they did not select exact dimensions such cooperation would have been impossible. Appellant's "Lincoln Kleenseal Fittings" were sold to be used in combination with the compressor and coupler parts of the Butler combination as made and sold by appellee. Appellee sold its compressor and coupler parts of the combination to public garages and service stations in the United States, and appellant offered its fitting parts to be used by the said garages in connection with the Butler combination. Appellant duplicated fitting for fitting all of the arbitrary dimensions of the entire line of appellee's fittings.

12. The Butler patent does not require the use of spring fingers which can yield a substantial amount.

18. Appellant's model of Figure 2 of the Butler patent does not accurately or fairly represent the invention of Butler.

14. Claim 2 of the Butler patent describes both a "Lincoln Kleenseal" fitting, aspellant's product, and "Alemite Hydraulie" fitting, appellee's product. As conclusions, the court found:

That claim 2 of the patent is valid, and defendant contributorily infringed it by the sale of "Kleenseal" nipples or fittings, exemplified in plaintiff's Exhibits 27a and 27b; and that appellee is entitled to an injunction and to an accounting.

Appellant challenges the decree on three separate, distinct grounds, stating each with commendable frankness, brevity, and clarity:

- (1) Butler's hose coupler can not be validly claimed in combination with a non-patented lubricant receiving nipple or an old compressor, particularly where his conceded purpose is not merely to monopolize the hose coupler, but to include in the monopoly the admittedly old device which is used with it. To support this position appellant relies upon Bassick Manufacturing Co. v. R. M. Hollingshead Co. (Rogers v. Alemite Corp.), 298 U.S. 415, 56 S.Ct. 787, 791, 80 L.Ed. 1251.
- (2) The coupler of the Butler patent shown in Figure 2 is not the so-called "Alemite Hydraulic" coupler. Supporting this position, appellant relies upon the facta brought out by the evidence and the holding in Stewart-Warner v. Jiffy Lubricator Co. (C.C.A.) 81 F. (2d) 786.
- (3) The Butler multi-jaw chuck type hose coupler is not a patentable improvement over the multi-type hose coupler of the prior art. As bearing upon this issue, it contends that the evidence does not support the findings of validity because the Butler hose coupler as described by Butler both in Figure 2 and in his claim never went into commercial use. It likewise argues that extensive use where the trade was so dominated by Stewart-Warner is not persuasive of validity.

The importance of the suit and the effect of the Bassick opinion upon the whole field of patent law make it impossible for us to dispose of the case in an opinion of desirable and satisfactory brevity.

While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that Bassick Mfg. Co. v. R. M. Hollingshead, supra, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. This revolutionary concept was accepted and applied by the District Court' (in

Pennsylvania) in Stewart-Warner v. Universal Co., 15 F.Supp. 410.

The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the Bassick Mfg. Co. v. R. M. Hollingshead opinion.

The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling.

The uppermost question in this case is the controlling effect of the Bassick Mfg. Co. v. R. M. Hollingshead opinion, supra. We are not disposed to limit it in order to bring about an avoidance of any new principle it may announce. Nor are we inclined to give it an effect which was not intended, if it does not follow from a fair construction of its language.

The novel proposition which appellant seeks to apply to the present case is to be found in the language on pages 424, 425, of 298 U.S., 56 S.Ct. 787, 791, 80 L.Ed. 1251. There it was said:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such. No. 1,307,783. Secondly, he invented an improved form of coupler to be attached to the end of the lose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. No. 1,307,734, the patent in suit; claims 1-6, 8, and 10. He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. Claims 14 and 15. The question then is whether, by this

method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts."

The paragraph of the opinion which follows the quotation serves as a modifier of the strict letter of the rule thus announced. There, the court says:

"Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 301, 325, 29 S.Ct. 495, 53 L.Ed. 805, on which the respondent relies, is not in point. There the patent was a pioneer patent and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination."

If the court announced a rule in the Bassick Case as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the validity of patents then Leeds & Catiin Co. v. Victor Talking Machine Co., 218 U. 8. 301, 29 S.Ct. 495, 53 L.Ed. 805, is overruled. However, instead of stating that the Leeds & Catlin opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

Until and unless there is an express repudiation of the Leeds & Catlin Co. v. Victor Talking Machine Co. Case, we can not accept the Bassick Mfg. Co. v. R. M. Hollingshead opinion as being inconsistent with the views stated in the former opinion. In other words, we must apply to the instant case the rules of law which govern and apply the tests which have long been applied to determine whether the Butler combination is a patentable invention.

[1] In dealing with product patents and their validity it might be observed that the word "combination" is somewhat unfertunate. A combination contemplates a piurality of units, yet patentable invention can only reside in a combination when it (the combination) is considered as a smit. For convenience's sake, courts speak of elements in a combination as units in and of them-

It is only for the sake of convenience that reference is made to such ments as 1, 2, 8, 4, and 5. Each and every valid claim of a patent covers a unit, although in a combination claim the unit may have five parts or elements. When we so consider a claim it is clear that one unit must differ from another unit if one element, my element three in one combination is different from element three in another combination. To illustrate: If one mixes five different colored paints in stated proportions, he would have a product which might be denominated X. X must be viewed as a unit. If the same individual mixed in the same proportions five different colored paints, four of which were similar to the ones in the first combination but one was different, the final product would not be the same. In testing the validity of any machine or product patent, then, whether it be what is commonly called a combination, or a single, a noncomposite substance, the following propositions may be accepted as sound:

- [2] 1. All the elements may be old but if they have never appeared together in combination and they co-act so as to avoid the charge of aggregation, the unit may constitute a valid claim of a patent.
- [8] 2. Where a combination consists of five elements—1, 2, 3, 4, and 5—and the inventor uses four old elements—1, 2, 3, and 5,—in the same way and for same purpose as in the previous combination, but substitutes a new element 4 for old element 4 of the old combination and obtains desirable results, the new combination may be the subject of a valid claim. It is not anticipated by the previous combination.
- [4] 3. Likewise, one may substitute for element 4 an old and well-known element but which has never been used in combination with elements 1, 2, 3, and 5, and these elements being presented in the new combination for the first time may be the subject of a valid patent.

In stating these propositions, we have used the word "may" for there are other factors to be considered in determining patentability. For instance, the novelty may not be patentable. The advance may represent the skill of the artisan or the mechanic, not the genius of the inventor. Perhaps it would be better to say that the objection that the combination is lacking in movely is not sound under the conditions assumerated.

- [5] Equally clear is the law which denies to anyone the right to repatent an old combination.
- [6] Accepting the foregoing principles as sound and applying them to the instant case, we have no difficulty in distinguishing any of the prior art. Nor are we troubled by the decision in the Bassick Case. The Butter coupling member and his nipple head are novel. Their structures are clearly distinguishable from the prior art. Whether the other mentioned elements are old is immaterial.
- [7] The only validity questions left relation to combination as distinguished from aggregation and the character of the discovery—whether it marks patentable novelty at mechanical skill. In passing, it might be observed that if a new product is found to be patentably novel, it is immaterial whether said patentable novelty is of the pioneer type or "the mere improvement type" of investion.

Appellant also relies upon the Bassice Case as authority for its contention that contributory infringement is not disclosed upon a showing that it furnished nipples and grease guns, even though made in such a way as to be used as an element in the Butler combination.

The last paragraph of the Bassick opinion is cited in support of appellant's position. It reads as follows:

"We are of the opinion that the owner of the patents cannot extend the monopoly of its patent for a pin fitting to precluda the use therewith of any grease gun not embodying the improvement in the coupling device avidenced by the patent in suit; and cannot extend the monopoly of the combination patent in suit to prevent the use of a pin fitting which does not infringe the fitting patent, 1,807,783, with a gun having a coupler such as that claimed in the patent in suit."

We accept, of course, without question this opinion as applied to the facts in the case that was before the Supreme Court.

In the instant case, Butler does not seek to extend the monopoly of a patent for a pin fitting or to preclude the use of a great gun in any apparatus not embodying the improvement described in the patent.

Two questions are determinative: First, did Butler set forth a valid patentable combination when he wrote his claim No. 21 Second, did the sale of a headed nipple or a

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91 F. (24) 707

lubricant compressor made for the sole purpose of being used in connection with the apparatus made according to the Butler patent, constitute infringement?

[8, 9] Combination or Appregation, As we view claim 2 of the Butler patent, it pells combination, not aggregation. It is act the names of the various parts that determine this question. If there be coaction of elements so as to make a single unitary tructure, we have a combination. The nipde head may be a non-composite apparatus. It may be the subject of a valid patent claim. tikewise, it may be part of a combination. [10] In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that was old. Nevertheless, if it is an element in an otherwise valid combination (due to the novel coupling method), it is a unit of mid combination and a third party supplying It, if other necessary facts are shown, may thereby infringe.

Whether the supplier of headed nipples or other elements of the combination set forth in claim 2 is a contributory infringer depends first on whether the element supplied is a part of a valid combination (as distinguished from an aggregation), and second, on whether the producer so contructs it that it can be said that it was knowingly made with the intention that it would be used in connection with the patented combination.

[11] There is an exception to this statement—If an element of a patented combination in the very nature of its use wears sut and a new one is supplied, it may be furnished without the producer's infringing. Heyer v. Duplicator Mfg. Co., 263 U.S. 100, 44 S.Ct. 31, 68 L.Ed. 189; Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 325, 29 S.Ct. 503, 53 L.Ed. 816. But, where the intent is present, as here, to supply separate units of a patented combination and not as a renewal of a worn out part, contributory infringement is disclosed.

The findings of the District Court on this question respecting the dimensions of appellant's headed nipple clearly show an intention to make parts which could only be used in connection with the patented combination. If, then, the Butler claim No. 2 disclosed a valid combination, infringement was shown.

[12] In dealing with this subject of contributory infringement, it might be observed that we are dealing with a phase of the general subject of torts. An infringer is a tort feasor. A contributory infringer is one whose action contributes to the infringement.

[18] Because of the statute, the owner of a patent is entitled to exclude others from making, selling, or using the patented product. Violation of any of these rights makes the violator a tort feasor, an infringer. Making, buying or selling a non-patented article is not of itself infringement. It only becomes so when said maker, seller or user does so knowing that the non-patented element is to be used in connection with other elements in a valid combination covered by a valid patent. This is the doctrine of contributory infringement.

In the instant case, the court has made findings, and the facts leave no doubt as to the soundness of such findings, to the effect that the non-patented parts made by appellant were not only intended for use in connection with Butler's patented combination but they could hardly be used otherwise. The size and dimensions of the fittings most conclusively demonstrate this fact.

It might be asserted that appellant did not infringe when it manufactured one element of the product for it could have been sold to one who would use it other than in the Butler patent combination. However, when it appears that such products were made by the appellant and sold to garages and it further appears that the fittings were of such measurement as to preclude their use except on appellee's patented apparatus, contributory infringement both in selling and in using is established.

To establish contributory infringement the following facts must appear: (1) a valid patent; (2) ordinarily in the case of a product patent covering a combination; (3) the alleged infringer must make or supply one or more of the elements of the combination with the knowledge and intention that the same is to be used in the patented combination.

Contributory infringement is the outgrowth or result of the application of the following legal propositions:

- (1) A patentable combination is a unit in the contemplation of the law.
- (2) Some elements of the combination may be old and others new, or all old, or all new.
- (3) One who makes, sells or uses the combination without permission of the patentee is an infringer,

- (4). One may be a contributory infringer although he makes, salts or uses an expect that is old and not covered or coverable by a patent.
- (5) When the manufacturer makes, uses or sells an unpatented (an old) element, he becomes a contributory infringer only when the element is knowingly made, sold or to be used as a part of a patentable combination without patentee's express or insolied consent.
- (6) Implied consent exists when in the ordinary use of the patentable combination one element constantly and frequently wears out and must be replaced. Heyer v. Duplicator Mfg. Co., supra. Whether there is a consent is often a fact.issue, but not involved in the instant suit.
- [14] In the last analysis this question of contributory infringement in the instant suit must be determined by the existence or absence of a valid combination wherein one of the essential elements was a product made by appellant. If the elements do not spell a combination, but are merely an aggregation, there is of course no contributory infringement.

For obviously, infringement can exist only when there is a valid patent. No valid patent can cover a group of elements which are correctly termed an aggregation and which do not conform to the correct legal definition of a combination. There is a valid combination only when the element—headed nipple—co-acts with the lubricant compressor and the coupling member. If two of these elements do not co-act and the third element does not likewise co-act with one of the other two members, we do not have a case of valid combination.

Doubt over this issue can only arise when one of the elements may in itself serve a multiple of purposes. It may be used outside the combination of the patent. If so its use is valid and legitimate. The determining fact issue is the intent and the purpose it serves, and was intended to serve when made or sold. If made, sold or used as an intended element in the combination which is the basis of the patent claim, it is a case of contributory infringement, otherwise not.

In disposing of the defense of aggregation, we have accepted the rather common meaning of that word and, for the purpose of the argument only, assumed it to be a valid defense in patent cases when established. We have adopted this meaning for the purpose of the argument only, for otherwise we would hesitate before accepting it.

In our opinion the defense of aggregation is considerably overworked. The term "aggregation" is usually preceded by the word "mere" and describes a group of elements which fall far short of invention in the user's opinion. It is a generic term used quite loosely to define various structures which fail to embody patentable discoveries.

To illustrate, it is used when a mechanism with a series of independent units which perform their functions separately and uninfluenced by the action of any other unit is being considered. In other cases, it may be adopted when a mechanism is composed of numerous units, but their selection did not call for the exercise of the invantive faculty. In such a case, the discovery may approach but does not attain the high status of invention.

[15] We believe the better view is to accept the term "aggregation," if used at all, as defining a phase of the general term "non-invention." When claims are considered which are composed of a plurality of eisments and their individual or collective selection fails to evidence the exercise of inyentive faculty, it is of course not a patentable discovery regardless of whether coaction of elements is present or absent. On the other hand, an inventive concept may reside in the selection of a part or parts of numerous old elements. If the selection is unusual and a hitherto pressing unsolved problem is thereby overcome, it answers the tests of the statute.

[16] Invention may be evidenced by the modifying coaction of the elements. That is, the coaction may furnish the satisfactory evidence of the patentability of the discovery. It is hardly logical, however, to say, without it (coaction) there can be no invention.

It is one who "has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvements thereof, etc.," who is, under the statute, entitled to the name inventor, and under prescribed circumstances is entitled to a patent which will protect his invention. The term "aggregation" is not used. It has been adopted by the legal profession as descriptive of a machine, or composition of matter, etc., that falls short of invention usually because the elements of the composition do not cossol.

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Courts, too, have recognized it as applicable when the machine or composition of matter falls short of invention, because it manifests the skill of the mechanic rather than the genius of the inventor. This has led to emphasis on the term "coaction" of elements when applied to said composition or machine.

When among the group of elements there is correlation or co-ordination of elements which mutually contribute to the same result, there may be invention, notwithstanding there are many decisions which have arbitrarily announced that patentable discoveries are not present unless there is coaction of elements which results in a new or better product.

We are convinced that where there is correlation, cooperation, or co-ordination resulting in mutuality of achievement of a common purpose and contributing to accomplish a desired result, a patentable combination may well be present. Nor is it proper to say that the correlation or cooperation depends on each element's affecting each of the other elements.

[171] In short, in attempting to restrict aggregation to its proper field, it might be said that a combination is present if there be correlation or co-ordination of elements which mutually contributes to the accomplishment of some result and there need be no interdependency in the sense of one element being dependent on the others for functioning.

We are inclined to go still further and question the wisdom of necessitating the presence of a coaction of parts to constitute a valid combination. True, absence or presence of coaction may bear upon the character of the skill required to solve the problem. It is entirely possible to conceive of a case where the selection of the elements which are to act together to produce a desirable or advantageous result, would invoke the exercise of the inventive faculty. While this view may not harmonize with many of the decisions, and it is not applied in the instant case, it seems to us the more logical one. For when we attempt to distinguish between inventive faculty and the skill of the mechanic, we must admit that the former often finds expression in the selection of the particular element and it is the selection of elements that solved the problem, improved the product, or brought about the desired economies in production costs. Its cooperations with the other elements may be very limited, -in fact, limited to mutuality of effect or functioning to a common purpose.

Patentable Movelty of the Butler Apparatus. Appellant argues as one of its three major grounds for reversal of the decree that the advance or improvement which Butler made over the prior art did not constitute invention, but merely evidenced the skill of a mechanic confronted by an ordinary mechanical problem.

Upon this issue the District Court found squarely against the appellant and in its opinion pointed to the differences between the prior art structures and the Butler apparatus.

We are not convinced that the discovery belongs to the pioneer class. It was an improvement, but not an outstanding advance. Whether that improvement was such as to justify the issuance of a patent may well be and is seriously debated.

[18] We are not impressed by the evidence of wide and popular acceptance of the patented apparatus which is so controlling in doubtful cases. Wahl Clipper Corp. v. Andis Clipper Co. (C.C.A.) 66 F. (2d) 162.

Appellee occupies such a position in this lubricating field that any lubricating system it might offer to the garages and automobile manufacturers would result in enormous sales of parts. There is no doubt but that the figures appearing in the court's findings, standing alone, are impressive. A sale of 280,000,000 fitting parts in three years, by any company at any time, is quite startling. They would be more impressive if we knew how many parts were sold under the Zerk patent or under the Gullborg patent, both owned by appellee. The number of automobiles in the United States and the number of parts necessary to supply all of them are both enormous. A company, like the appellee, is apparently able to have its product made part of the standard equipment of most automobile companies, and therefor would naturally sell millions of parts of lubricating system throughout the entire United States. It is for this reason that we have not allowed the sale figures to infinence our judgment on this issue of validity of the patent.

It is only after observation of the various lubricating systems that we have some to the same conclusion as was reached by the District Court. If the advance which Butler made was merely the solution of a mechanical problem, we are at a loss to understand why that solution was so long delayed. Holding one part of the lubricating system against another while pressure was applied and grease equirted in all directions, or mak-

ing the connection by the pin and slot or bapaset type while crawline under cars and reaching between spokes of a wheel, was so unsatisfactory as compared to the Butler method that the delay in producing this new method of connection is explainable only upon the theory that the problem was beyond the solution of the mechanic skilled in the art.

What was the problem which confronted the maker of lubricating systems? First and foremost was the need of high pressure apparatus. The pressure had increased in the passing years. First 500 to 750 pounds was considered high, then 1500 to 2000 pounds. The Butler system permits of pressure up to 7500 pounds. It is apparent that high pressure was extremely desirable. The difficulty to be overcome in the making of a high pressure system was in the connection between the coupler and the pin head. Butler's solution was most satisfactory because the higher the pressure, the tighter the connection—the better the fitting.

Another problem which confronted the manufacturer was easy connection. Crawling under the car or reaching points rather inaccessible was unsatisfactory.

[19] The trial judge found, and there is testimony to support this position, that in the lubricating field the method adopted had never been used before. It was novel in the lubricating field. It may not have been wholly new in the entire field of mechanics, but it was novel in this particular field. Its conception or its selection, under all the circumstances, we conclude was invention and entitled to the protection of a patent.

Appellant argues, as an additional ground for reversal, that claim 2 of the Butier patent and Fig. 2 of the drawings accompanying the same do not cover its accused nipple. It likewise argues that appellee's "Alemite Hydraulic" coupler is not the coupler of the Butler patent.

The District Court found squarely against appellant on this issue.

The question has been elaborately argued both on the oral argument and in the brief. To reproduce the drawings and set forth the positions of the two sides would almost double the length of this opinion, and we fear we would not add much to the statement of our conclusions respecting these conflicting positions.

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The question is not whether Fig. 2 of the drawings fully represents the concept of the inventor. Figures which accompany the patents are often presented merely to elucidate the thought expressed in the specifications. Their study is decidedly helpful i most cases, but it can hardly be expecte that all of the possible variations in stre tures will be set forth in specifications drawings. Frequently the improved type described in detail. True, there are stances where specificity is necessary in der to distinguish the invention from the prior art. More frequently however, it the principle of operation which is bel illustrated rather than an effort to confi the invention to the exact figures shown drawings.

This seems to have been the thought Judge Lindley when he said:

"The Alemite Hydraulic System (applee's) comprises the combination of elements set forth in claim 2 of the Butler pater.

There is nothing in the Butler pater at the set of springers which can yield a substantial amount of the Alemite Hydraulic couple will grip and form a sealed combination with a Lincoln Kleenseal fitting as well as will an Alemite Hydraulic fitting and claim 2 of the Butler patent described one combination as well as the other."

He further stated:

"The mechanism embodied in the mean by which the jaws are compressed about it nipple of the Alemite Hydraulic system, identical in its mechanical principles with that disclosed in the Butler patent. It is simple equivalent involving a mere revers of parts. The Alemite Hydraulic system comprises the combination of elements a forth in claim 2 of the Butler patent."

[20] Our conclusion is that such departures from the Butler patent as were main the commercial structures were nevertheless the equivalent of the Butler claim and they embodied the mechanical principle which were described in the Butler pater in other words, we agree with the Distriction that appellee's Alemite Hydrau system was an embodiment of claim 2 of the Butler patent.

The decree is

Affirmed.



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Excerpts from the Opinions in the 12 Cases Cited in Footnote 4 to the Opinion of the United States Supreme Court in Bassick v. Hollingshead and Rogers v. Alemite, 298 U. S. 415, 80 L. Ed. 1251.

The opinion of the Supreme Court in the cases of Bassick v. Hollingshead and Rogers v. Alemite, 298 U. S. 415, 80 L. Ed. 1251, cites twelve decisions in support of its statement that "as shown by numerous cases in this and other federal courts" one cannot, "in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element" where the "construction and operation is otherwise unchanged."

It will be found that these cited cases were decided against the plaintiffs upon nine different grounds, namely:

- (1) Double patenting: Underwood v. Gerber, 149 U. S. 224, 227, 229;
- (2) Lack of Invention: Wall Pump & Compressor Co. v. Gardner Governor Co., 28 Fed. (2d) 334, 338, 339; General Electric Co. v. Ohio Brass Co., 277 Fed. 917; Troy Wagon Works Co. v. Ohio Trailer Co., 274 Fed. 612;
- (3) Anticipation by prior art: Heald v. Rice, 104 U. S. 737, 753; Troy Wagon Works Co. v. Ohio Trailer Co., 274 Fed. 612;
- (4) That a reissue patent was for a different invention from that of the original patent; Langan v. Warren Aze & Tool Co., 184 Fed. 720; Heald v. Rice, 104 U. S. 737, 753;
- (5) Non-infringement because defendant did not sell any part of the thing claimed in the patent in suit: Harvey Hubbell, Inc. v. General Electric Co., 267 Fed. 564;
- (6) That the patentee and purchaser and user of the patentee's machine contemplated that the purchaser might

replace quickly perishable and periodically renewed parts or supplies: Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co., 152 U. S. 425, 431, 432; Wagner Typewriter Co. v. Webster Co., 144 Fed. 405, 409;

- (7) That the defendant had been impliedly licensed by the patentee: Edison Electric Light Co. v. Peninsular Light, P. & H. Co., 101 Fed. 831;
- (8) That a patentee may not exact as the condition of a license, that unpatented materials used in connection with the invention shall be purchased only from the licensor: Carbice Corporation v. American Patents Development Corporation, 283 U. S. 27, 31, 32. (Upon a rehearing the patent in suit was held to be invalid because anticipated, 283 U. S. 420.)
- (9) That it was a violation of the Clayton Act for the Radio Corporation to require its licensees to purchase radio tubes from it alone for inclusion in sets licensed under Radio Corporation circuit patents as initial equipment: Radio Corporation v. Lord, 28 Fed. (2d) 257.

### CASE NO. 1 .- CITED BY THE SUPREME COURT.

John T. Underwood, et al v. Henry Gerber, et al., 149 U. S. 224—Decided May 1, 1893—Opinion by Mr. Justice Blatchford.

In this case the patent in suit was held void on the ground of double patenting.

Suit was brought on patent No. 348,073 for Carbon Paper consisting of a sheet of material coated with a specific composition. Carbon paper consisting of a sheet of material coated with various compositions was old and well known. The specific composition was separately claimed in patent No. 348,072, also owned by the plaintiffs but not in suit.

The court indicated that the specific composition claimed in patent No. 348,072 was new and that if suit had been brought on this patent, a different result would have been reached. The court, however, held that the specific composition claimed in the earlier patent must be considered prior art, and held the patent in suit to be void thereover. The court said, at page 331:

"As No. 348,073 does not claim the composition of matter, although it describes it, that composition must be regarded as disclaimed, and as being public property, and there was no invention in applying it to paper, as claimed in the patent sued on."

### CASE NO. 2-CITED BY THE SUPREME COURT.

Wall Pump & Compressor Co. v. Gardner Governor Co., 28 Fed. (2d) 334, 338, 339. (C. C. A. 7—Sept. 13, 1928—Alschuler, C. J.)

This case involved a patent on a two stage air compressor for use in supplying air for automobile tires. The court found the patent to be invalid, citing numerous anticipations. It was argued that none of the citations constituted anticipations, because they did not possess radiating flanges of the patent in suit. As to this, the court said:

"What we have said sufficiently indicates our view that invention is not involved in so equipping such a conduit or receptacle. The presence or absence of such well known radiating expedients, or the number or depth of such fins, involves engineering or mechanical judgment and skill, but to no degree invention."

The gist of the decision, however, is contained in the following excerpt from the opinion, appearing on page 339:

"It is of much significance here that about the same time several important builders of such machines—without relation to each other, and, so far as the evidence discloses, without knowledge of what Gardner or the others were doing—designed and built machines which s betantially embody the elements of the patent, without themselves claiming to be inventors. Such a situation is instructively dealt with in section 25 of Walker on Patents, where it is stated:

"The absence of invention may be established in some cases, by evidence that a considerable number of persons who were not inventors, acting independently of each other, and without receiving any information from the patentee or his patent, did in fact contrive the improvement claimed therein, not long after he produced it."

"Also, in Concrete Appliances Co. et al. v. Gomery,

et al., 269 U. S. 177, at page 185, 46 S. Ct. 42, 45 (70 L. Ed. 222), the court said:

"The adaptation independently made by engineers and builders of these familiar appliances to the movement and distribution of wet concrete in building operations and the independent patent applications, within a comparatively short space of time, for devices for that purpose are in themselves persuasive evidence that this use in combination of well known mechanical elements was the product only of ordinary mechanical or engineering skill and not of inventive genius. Atlantic Works v. Brady, 107 U. S. 192 (2 S. Ct. 225, 27 L. Ed. 438).

"We believe that the circumstances of the instant case invoke the application here of the principle thus stated, and give yet another reason for concluding, as we do, that the bringing together of the various elements of the claims manifests not invention, but only the exercise of such mechanical and engineering skill as might reasonably be expected in those versed in this department of endeavor."

### CASE NO. 3-CITED BY THE SUPREME COURT.

General Electric Co. v. Ohio Brass Co., 277 Fed. 917. (C. C. A. 3, Jan. 6, 1922—Woolley, C. J.)

The Buck and Hewlett patent in suit was for a system of electrical transmission. Claims 2, 3, and 4 covered the combination of poles, electrical conductors, and insulators supporting the electrical conductors and flexibly connected to the poles. The court found that this combination was anticipated by a prior use in Indianapolis, and that these claims were accordingly void.

Claim 6 covered the same combination, but required that the insulator be of the specific type disclosed in a patent taken out by Hewlett alone. The Hewlett patent was not in suit.

The court found that claim 6 of the Buck and Hewlett patent in suit described nothing more than the usual and necessary combination in which the insulator of the Hewlett patent was designed to be used, and that the claim was accordingly void for lack of invention. The court said, pages 923-926:

"On this issue (of invention) the complainant concedes that, with qualifications, all elements of the combinations of the claims in suit are old. Therefore, it is certain that invention, if any, must be found in the combinations alone. Leeds & Catlin v. Victor, 213 U. S. 325, 332, 333, 29 Sup. Ct. 503, 53 L. Ed. 816. We understand that the complainant does not deny that the combinations themselves were, in their essentials, found in systems of lower potentials and in systems of higher potentials, the formers exemplified by railways and the latter by wireless telegraphy."

"But the complainant says the Indianapolis system was of low potential. It was, relatively so. Yet its

problems, electrical and mechanical, were different only in degree from those in a system of high potential. That difference is cared for by insulators and their related expedients. But if it were not, still we fail to discern invention in the mere adaptation of this Indianapolis system of low potential to the complainant's system of high potential.

"We are of opinion, therefore, that within the general description of the element of an insulator, the invention of the patent in suit was anticipated. On this ground, as well as on the ground which will control our decision on claim 6, we hold claims 2, 3 and 4 invalid. It follows on the same evidence that claim 1 is

invalid.

"As the insulator in the combination of claim 6, particularly described in the specification and displayed in the diagrams, is the insulator of the Hewlett patent, or an insulator distinctively of its type, we have the question whether the Hewlett insulator, or one falling within its description, can in combination with common expedients of the art be the subject of invention.

"Turning to claim 6, we find, as we have said before. the invention to be a combination of three elements: First, towers provided with cross-arms; second, an electric conductor; and, third, disc insulators flexibly connected in series supporting the conductor, thereby producing as a result its free suspension. 'Towers provided with cross-arms' were not new. At any rate they are the equivalent of poles with cross-arms. Poles with cross-arms are an expedient of the art as old as the art itself. Current conductors, of course, are an expedient as old as poles. The only other element is the insulator, and that insulator is intended for use only in suspended connection between cross-arm and conductor. Thus there is a combination which embodies a specific element of suspended insulator in assemblage with expedients of the prior art, which together produce no function other than that which the suspended insulator would itself produce when in operation with these ordinary expedients of the art.

"The insulator described in claim 6, whether specifically the insulator of the Hewlett patent or generally an insulator of the Hewlett type, is adapted for both horizontal dead-ending insulation and for suspension insulation. Whether used for one purpose or the

other, or for both purposes, such an insulator in overhead suspension can be used—so far as we have been shown or can imagine only in connection with the very expedients of the art named as elements of the patent combination. At least, claim 6 discloses use of the insulator only with these expedients. There must be a tower or pole with a cross-arm from which to suspend the flexible insulator at one end and a current conductor to be appended to the insulator at its other end. Without these two expedients the insulator cannot work. This being true, can there be invention in a combination of three elements, when two of them, separately free to everyone, are indispensable to the functioning of the third? Or, stated differently, is there invention in a combination which produces no result other than that produced by one of its elements operating in the only way possible for it to operate—that way being through expedients common to the art? Reading claims 6, 2, 3 and 4,—all combinations,—we find, described as an element in each, an insulator of a specific type (claim 6), and an insulator of a more general type (claims 2, 3 and 4), in combination with expedients appropriated from the art without which insulators of neither type can function. The complainant says here is invention. With this we cannot agree because: First, we do not find a combination which in the patent sense is new. Nor can we find such a combination useful beyond that of the insulator itself with the expedients of the art open to it-expedients without which the insulator is useless. If such a combination constitutes invention, then, if patented, use of the common expedients of the art-poles and conductors-would be foreclosed to every one seeking lawfully to use insulators of their own which happen to fall within the class of the insulator elements of the claims. Of such insulators there are numbers patented and extensively used in the art.

"As drawn, the patent to Buck and Hewlett grants them not merely a monopoly of a system of electrical transmission, but, in effect, expands the Hewlett patent for an insulator and permits it to embrace and monopolize, the named expedients of the art, thereby bringing about infringement whenever these expedients are used in combination with insulators of others, which, though not infringing the Hewlett insulator,

fall within its broad description. The Buck and Hewlett-patent for a system, built around the Hewlett insulator, pretty nearly, if not entirely, covers the whole art, present and perspective, of insulators in series flexibly connected, whether the insulating members be discs, globes, or other shapes.

"We are constrained to hold the claims of the patent in suit invalid and direct that the decree below dis-

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missing the bill be affirmed."

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### CASE NO. 4-CITED BY THE SUPREME COURT.

Troy Wagon Works Co. v. Ohio Trailer Co., 274 Fed. 612 (C. C. A. 6—July 27, 1921—Donahue, C. J.).

This suit involved two patents, one a patent to Hudson for improvement in steering mechanism adapted to trailer trucks, and the other a patent to Eccard & Smith, relating to an improvement in reversible trucks or dump wagons, and claiming a combination of draft bar and automatic locking device. Both patents were held to be invalid for want of invention.

The Hudson patent for steering device was held to be anticipated by various steering mechanisms in the automobile art. The chief argument apparently on appeal was that the automobile art was not analogous to the trailer art. The court held, however, that if it was not in the same art, it was at least in a closely analogous art, and held the patents in the automobile are to be good anticipations.

The court likewise held the Eccard & Smith patent to be anticipated by prior patents in the automobile and agricultural implement arts.

The court further held that the automatic lock of the Eccard & Smith patent performed precisely the same function that automatic locks had performed long prior thereto, and that there was therefore no new result from combining an automatic lock with the old steering elements of vehicles, and that consequently the patent did not involve invention. The court, on pages 618-621 of the opinion, said:

"The Eccard & Smith patent, No. 1,117,816, relates to improvements in reversible trucks or dump wagons of the type which employ a pivoted draft bar at each end thereof, which draft bar is connected to the wheels for steering purposes, and also may be locked to the wagon

bed or frame in a central position when the truck is being drawn from the opposite end. Claims 6, 7, and 8 are relied upon by the appellant. These claims are similar in their nature; claim 8 being, perhaps, a little more comprehensive than either of the other two. This

claim reads as follows:

'8. In a vehicle of the character described, a main frame, a draft bar pivotally connected to said main frame at its rear end, an automatic latch for locking said draft bar to said frame near its front end in a central position with respect to said main frame, said draft bar having connections with the steering wheels of said vehicle, and means for holding said latch in inoperative position to permit said draft bar to steer said wheels.'

"There are other claims describing this automatic locking device in detail, but it is not seriously contended that the automatic locking device used by the defendant is an infringement of appellant's automatic locking device, separate and apart from the combination in which it is found. On the contrary, it is the specific claim of the appellant that the invention lies in the combination and not in the lock per se, and that therefore the introduction of any automatic locking device into this combination described in the specifications and claims, co-ordinating in like manner as appellant's automatic lock with the other elements of the

combination, would constitute infringement.

"In reply to this it is insisted upon the part of the appellee that there is nothing new or novel in appellant's combination, for the reason that automatic locks for locking the draft bar of vehicles of the character named in the patent in suit and other wheeled vehicles of a similar nature are old in the prior patent art. In support of this contention a large number of patents relied upon by appellee are cited. The steering mechanism of a trailer truck or dump wagon, that is associated in this combination with appellant's automatic locking device, is admittedly old in the art. Nor is there anything new or novel in the idea of locking the rear draft bar to the wagon bed or frame in a central . position when the truck or wagon is being drawn from the opposite end. On the contrary, this is absolutely essential to its successful operation. Nelson, 793,799; Geiger, Eccard & Southerland, 903,185; Chrestenson, 1,068,737.

"However, in these patents no automatic lock is used; but the locking is accomplished, as stated in the application for this patent, by the insertion of a pin or other means through suitable apertures through the draft bar and some parts connected with the vehicle body.

"Souther, 207,453, relates to a reversible trailer truck for street cars. It appears from the evidence of the expert witness Browne, and also from an examination of this patent itself, that it contains fundamentally the same character of locking mechanism used by the defendant, which consists of two latches, which co-operate directly with a hump or boss on the drawbar. Souther has two pivoted latches, which, when released by pressure of the foot of the driver, permits the drawbar to swing free, but when it comes back to a central position

it is again automatically locked.

"The expert witness called on behalf of the appellant testifies in reference to this patent that the action is automatic in closing, but there are no means for holding the lock out of operation except the foot of the motorman; that, because this feature is lacking, Souther's automatic lock would not be suited for use in a trailer. It is clear, however, that the idea of the automatic lock as applied to the steering mechanism of a trailer truck is fully disclosed by Souther, and that the mechanical means for holding this lock out of operation was not used, because an operator was always present on these trailers, and for that reason no such device Therefore the most that Eccard & was necessary. Smith could claim over. Souther is this means for holding the automatic locking device out of operation when it is desired that the draft bar should swing free, but this is also old in the art.

"In the Eccard & Smith patent it is also necessary for the operator to use his hands in placing the means provided for fastening their automatic lock in such

position that it will not function.

"Knupfer, 410,692, is for a seed-drilling machine, having an automatic locking device, which consists of a bolt actuated by a spring, which corresponds with a notch carried by the drawbar, so that when the spring bolt is free to move, and the notch is brought into register with the bolt, the tongue or drawbar will be

automatically locked in central position. It is also provided with means for holding this automatic locking device out of operation. While this machine is being used in the field in the drilling of grain, it is desirable that the tongue or draft bar should swing freely, and therefore the lock is not released or used in the actual operation of the machine, except in turning a corner, or in moving the machine on the road, or from one field to another. It then becomes necessary that the tongue should be so locked to the body as to provide a steering means other than the mere draft. To that end the automatic locking device is released, and functions as in Eccard & Smith, to lock the tongue or draft bar in rigid relation to the frame or body.

"In any event, it is clear that Souther and Hurd are within the identical art, although Hurd is not of the reversible type, or of a type that requires the rear wheels to be rigidly locked to the frame or body of the vehicle when drawn from the opposite end. Nevertheless the Hurd invention relates to substantially the same problem in the same art as Eccard & Smith. It is also apparent that agricultural implements, including a frame mounted upon wheels, with tongue or draft bar connected with and used as part of its steering mechanism, if not in the same art, are at least in such a closely allied art that prior patents in relation thereto must necessarily be held as anticipatory of similar inventions in relation to reversible vehicles described in Eccard & Smith, whether motor-drawn or horsedrawn trucks or dump wagons.

"It is further insisted, however, that, even though these patents were in the same or an analogous art, they have no application, for the reason that the automatic locks shown in the earlier patents are not found in the same combination as in Eccard & Smith, and that the Eccard & Smith patent is for a combination, and not for an automatic lock per se. The mere adaptation of an old element to a specific use is not invention, unless the combination of such old elements produce 'a new result, or an old result in a new and materially better way." Frey et al. v. Marvel Auto Supply Co. (C. C. A. 6) 236 Fed. 916, 150 C. C. A. 178. It is clear from the evidence in this case that the auto-

matic locking device of Eccard & Smith functions in identically the same way as the automatic locking devices in the prior patent art, and that the other elements of this combination produce no new or different result in combination with this automatic locking device than produced by these elements when locked by any other means. It necessarily follows that the combination of an automatic lock with the old steering elements of vehicles of the character described in this patent does not constitute invention. Heald v. Rice, 104 U. S. 737-755, 26 L. Ed. 910; Huebner-Toledo Breweries Co. v. Mathews, 253 Fed. 435-447, 165 C. C. A. 177; Turner v. Lauter Piano Co., 248 Fed. 930, 161 C. C. A. 48; Robinson v. Fabric Co. (D. C.) 248 Fed. 526; Overweight Counter-balance Elevator Co. v. Machine Co., 102 Fed. 957, 43 C. C. A. 80; Self Sealing Can Co. v. Hocker (C. C.) 136 Fed. 418; Warren Webster & Co. v. Dunham, 181 Fed. 836, 104 C. C. A. 346.

"Therefore, even if Knupfer were to be entirely disregarded, the combination of these old elements including adequate means for holding the automatic locking device out of operative engagement, does not amount to invention, even though that means may be in and of itself new and novel, and entitled to separate and distinct patent protection or protection in combination with these old elements as to that peculiar or novel means employed for that purpose but certainly not as a monopoly covering such combination with any and all forms of automatic locks.

"For the reasons above stated, the decree of the

District Court as to both patents is affirmed."

### CASE NO. 5-CITED BY THE SUPREME COURT.

Heald v. Rice, 104 U. S. 737, 753. (October, 1881-Opinion by Mr. Justice Matthews.)

This suit was brought upon a reissue patent to Rice, which the Supreme Court held void because it was not for the same invention as the original patent, and also because it was anticipated by earlier patents.

"It appears, then, from the mere reading of the two specifications, that the invention described in the first is for the return-flue boiler; while that described in the second, abandoning the claim for the boiler itself, is for a particular mode of using it, with straw as a fuel, by means of an attachment to the furnace door for that purpose. It might well be that Rice was entitled to patents for both, separately, or to one for both inventions. But it is too plain for argument that they are perfectly distinct. A patent, consequently, originally issued for one, cannot lawfully be surrendered as the basis for a re-issue for the other. \* • •

"The second principal objection to the validity of the Rice re-issued patent is, that it is anticipated by the Morey patents. We are of opinion that it also is well taken."

### CASE NO. 6-CITED BY THE SUPREME COURT.

Langan v. Warren Axe & Tool Co., 184 Fed. 720 (C. C. A. 3, Feb. 2, 1911—Lanning, C. J.)

The patent in suit involved an alleged improvement in grab hooks employed in skidding logs, and claimed a combination of the grab hooks with draft appliances.

The patent as originally filed and as issued, described in the specification only the grab hooks themselves, and stated that in use they were connected by links or chains to the usual draft appliance. The specification expressly stated that the invention consisted in the particular and peculiar form of hook described therein.

The six claims contained in the application as filed, were all limited to the particular grab hook itself. These claims were all rejected and the patentee acquiesced therein, and substituted a single claim claiming a combination of the particular grab hooks with a draft appliance.

The suit was not one for contributory infringement, but charged direct infringement. At the trial, counsel for plaintiff conceded that the real invention lay in the grab hooks themselves, and attempted to have the patent so interpreted. The court, however, held that there was a Patent Office estoppel because of the patentee's acquiescence in the rejection of the claims for the grab hooks themselves, and that the claim was therefore one for a combination, and that so read, it lacked invention. The opinion reads in part, pages 721-722:

"It will be observed that in this specification, which, except as to one or two verbal corrections, is in the same form as when the application was first filed in the Patent Office, there is no suggestion that any part of the patentee's invention resides in a combination of the grab-hooks and the draft appliance. The connection between the grab-hook and the draft appliance by

means of links or chains is mentioned, but such connection was as old as grab-hooks themselves, and the patentee expressly states that his invention consists, not in any such combination, but 'in the particular and peculiar form of hook herein described and pointed out in the claim.'

"Not only is the claim for a combination foreign to what is set forth in the specification, but there is no new coaction or co-operation of the elements of the combination. The grab-hooks and draft appliance of the patent, in combination, coact as grab-hooks and draft appliances have always done. The grab-hook of the patent, by reason of its peculiar construction and form, is very probably an improvement of no little utility. But the patentee cannot, merely because of that fact, have a patent for a combination which shall have, as one of its elements, a pair of such grab-hooks. He did not invent the combination. He invented, if he invented anything, an improved grab-hook. Indeed, this is conceded by the patentee's counsel, and he argues that because the patent examiner, when the original claims were before him, said 'claim 6 is incomplete without the links, and the eye in the end of the shank is useless without the other elements, the claim as it now stands should be construed as one describing. as the real invention, a specific form of grab-hook. Manifestly, we cannot so construe it. The claim is for a combination of grab-hooks, of a peculiar form, and a draft device. We are not at liberty to distort its plain language. It may be, as the patentee's counsel declares, that the criticisms of the examiner led to the present form of the claim. But if the examiner's criticisms were unsound, the patentee could have had them reviewed by an appropriate appeal. This is not a case where there was a mere change of phraseology to suit the views of an examiner. The structure of the claim was remodeled in a fundamental respect. It was changed from a claim for an improved grab-hook to a claim for a combination of an improved grab-hook and a draft device. We are therefore compelled to read the claim as one for a combination, and not for an improved grab-hook. So read, it is clear that there is no error in the decree of the Circuit Court.

"The decree is affirmed, with costs."

### CASE NO. 7-CITED BY THE SUPREME COURT.

Harvey Hubbell, Inc. v. General Electric Co., 267 Fed. 564. (C. C. A. 2—May 26, 1920—Hough, C. J.)

This suit involved two patents, one covering a plug for an electrical connection comprising a combination of specific elements, and the other a combination of the plug with a cap of specific construction. Both patents were found to be not infringed, as necessarily limited by the prior art and their prosecution in the Patent Office. With reference to the first patent, the court said, at page 570:

"The applicant was compelled to redraft the claim, so that it reads as at present, and plainly requires the contact posts to pass through guide holes before engaging the contact locking springs in the recesses. It was this provision of an approach through insulated material that was required by the Office and yielded to by the applicant, and that acquiescence procured the allowance of the patent.

"There is not a single one of the above enumerated alleged infringing articles of which this is true.

"It follows that there is no infringement of claim 1 of the senior patent, and it becomes unnecessary to determine whether that claim is invalid, if confined, as it must be, to the exact device described and depicted."

As to the second patent in suit, the court also found non-infringement, saying, at page 572:

"There was no novelty per se in the use of knife blade contacts. They had been commercially used in the Ft. Wayne-Jenney construction, and known at least since 1886. Nor was there inventive thought in securing a locking, as distinct from a frictional, engagement between contact post and current carrying spring. That was old, and is found in the senior patent, if nowhere else. The field of invention left open and occupied by Hubbell was to secure a notched or recessed blade by a supplementary spring, and this he did. That is the only idea validating the locking spring claims, and defendants do not employ that means."

The court further held in this case that in any event there would have been no contributory infringement of these patents by defendant, because it did not sell its caps with the intent that they be used with the plaintiff's plug.

### CASE NO. 8-CITED BY THE SUPREME COURT.

Morgan Envelope Co. v. Albany Perforated Wrapper. Paper Co., 152 U. S. 425. (Mar. 19, 1894-Opinion by Mr. Justice Brown.)

This case involved two patents; one covering a package of toilet paper of particular form, and the other involving the combination of the paper roll with a mechanism for delivering it in an economical manner. The paper rolls patent was held to be so limited by the prior art that it was not infringed by the paper roll sold by the defendant. The court further held that the combination patent was not contributorily infringed by defendant's sale of paper rolls for use with plaintiff's delivery mechanism inasmuch as the paper element of the combination was perishable in its nature and intended by the manufacturer to be renewed periodically. The court said, pages 432-433:

"The real question in this case is, whether, conceding the combination of the oval roll with the fixture to be a valid combination, the sale of one element of such combination, with the intent that it shall be used with the other element, is an infringement. We are of opinion that it is not. There are doubtless many cases to the effect that the manufacture and sale of a single element of a combination, with intent that it shall be united to the other elements and so complete the combination, is an infringement. Saxe v. Hammond, Holmes, 456; Wallace v. Holmes, 9 Blatchf. 65; Barnes v. Straus, 9 Blatchf. 553; Schneider v. Pountney, 21 Fed. Rep. 399. But we think these cases have no application to one where the element made by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver, and which must be renewed, periodically. whenever the device is put to use."

### CASE NO. 9-CITED BY THE SUPREME COURT.

Wagner Typewriter Co. et al. v. F. S. Webster Co., 144 Fed. 405. (C. C. S. D. N. Y., March 28, 1906—Ray, D. J.)

In this case, the plaintiffs owned a patent for a ribbon mechanism for typewriters. There was a single combination claim including a pair of disconnected ribbon spools. The Court found that such ribbon spools needed frequent replacement in the normal life of the typewriter, and that the defendant might make and sell ribbons wound on spools which would fit any typewriter on the market.

The basis for the decision is clearly set forth in the following excerpt taken from page 416 of the printed decision:

I hold with Judge Thomas that an unpatented element of a patented combination may be replaced by the purchaser of his own authority when its use upon external objects must work its early destruction (and such is this case as to a spool with a ribbon); when in the arangement of an element, not the chief element, it is so fashioned and placed as to be specially subject to external forces that make it peculiarly liable to breakage or wear; when it is not the chief part of the combination (and that is this case); when it is an ordinary working part (and such is this case); and I will add when it is not a vital element of the combination, or a chief part of it, and is easily removable and replaced without affecting the identity of the machine, and it is a natural inference that it was contemplated by the patentee and purchaser and user that such part should be removed and replaced from time to time, and the part is in general use and extensively made and sold by others."

This case falls, therefore, in the same category with Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425.

### CASE NO. 10-CITED BY THE SUPREME COURT.

Edison Electric Light Co. et al. v. Peninsular Light, Power & Heat Co. et al., 101 Fed. 831 (C. C. A. 6, May 8, 1900—Lurton, C. J.)

The decision in this case rested squarely upon a finding by the Court of an implied license resulting from the conduct of plaintiffs. One of the plaintiffs, a licensee of the Edison company, in order to introduce electric service, had wired at cost a hotel which was under construction. type of installation, a three-wire system, was covered by a patent owned by the Edison company. The wiring was permanently installed in the building. The hotel bought electricity for six years from the licensee-plaintiff; then later bought current from the defendant, Peninsular Light Co., which installed transformers in the hotel, and after an unsuccessful attempt to use its own noninfringing threewire system, used the wiring peculiar to the Edison system for its outside connections. The plaintiffs brought suit against the Peninsular Co. and another power company, alleging contributory infringement of the Edison patent. Dismissal of the bill by the trial court was affirmed. the Court of Appeals saying, at pages 836 and 837:

"It is evident that the extent of an implied license must depend upon the peculiar facts of each case. The question in each case is whether or not the circumstances are such as to estop the vendor from asserting infringement. \* \* The circumstances in this record plainly indicate that the vendors of the house apparatus installed in the Livingston Hotel intended that the vendees should enjoy the advantages of the Edison system of electrical distribution. The machine it constructed was peculiarly adapted for the use of Edison's inventions, and, as we interpret the

facts and circumstances of the record, is not capable of safe use under any other plan or system. If it was intended that so expensive an apparatus could be utilized according to the methods of the patents under which the vendor was operating only so long as the vendor should supply the current, good faith required that the vendees should be plainly so informed. It cannot be doubted but that the vendees understood they were securing a permanent wiring system, which might be used in combination with a current obtained from any source, delivered to the house wires in such manner as to utilize them to the best advantage. It would be most unreasonable to suppose that in order to continue the use of this, the very essence of the Edison inventions, they must continue to take current from a particular source."

### CASE NO. 11-CITED BY THE SUPREME COURT.

Carbice Corporation of America v. American Patents Development Corporation et al., 283 U. S. 27. (Mar. 9, 1931—Opinion by Mr. Justice Brandeis.)

This case involved a patent on a refrigerating transportation package employing solid carbon dioxid as the refrigerating medium. The carbon dioxid was itself unpatented. The plaintiff neither sold nor licensed others to sell the complete transportation package of the patent in suit, but sold merely the carbon dioxid as did also the defendant. In this suit to enjoin defendant's sale of unpatented carbon dioxid, the court denied relief to the plaintiff. The gist of the whole decision is stated at pages 30 and 31, as follows:

"The Carbice Corporation challenges the validity of the patent and denies infringement. Whether the transportation package described is a patentable invention we need not determine. For, even if it is,

no relief can be granted.

A'The invention claimed is for a particular kind of package employing solid carbon dioxid in a new combination. If the patent is valid the owner can, of course, prohibit entirely the manufacture, sale, or use of such packages. Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 52 L. ed. 1122, 28 S. Ct. 748. Or it can grant licenses upon terms consistent with the limited scope of the patent monopoly. United States v. General Electric Co., 272 U. S. 476, 489, 71 L. ed. 362, 370, 47 S. Ct. 192. It may charge a royalty or license fee. But it may not exact as the condition of a license that unpatented materials used in connection with the invention shall be purchased only from the licensor; and if it does so, relief against one who supplied such unpatented materials will be denied."

### CASE NO. 12-CITED BY THE SUPREME COURT.

Radio Corporation of America v. Lord et al., 28 Fed. (2d) 257. (C. C. A. 3, Sept. 11, 1928—Opinion by Davis, C. J.)

This case was a suit under the anti-trust laws charging defendant with having caused damage to plaintiff by violation of the anti-trust laws as a result of its license contract with various radio manufacturers. No question of patent infringement was involved. Plaintiff charged, and the court held, that Radio Corporation, by requiring its licensees to purchase radio tubes from it alone for inclusion in sets licensed under Radio Corporation circuit patents as initial equipment, had made a contract for a sale of goods on a condition or understanding that the purchaser would not use or deal in the goods of a competitor and, therefore, violated the Third Section of the Clayton Act. The defendant asserted in defense that the license was not a violation of the anti-trust laws but was merely an exercise of its lawful rights of monopoly granted it under the patent laws. The court held, however, that there was no patent protection on radio tubes per se, as the patents upon the tubes had expired, and as the tubes constituted only one element of a combination patent, there was, therefore, no lawful monopoly in the tubes separate and apart from the combination itself. There is no finding or intimation in the opinion of the majority that an unlicensed seller of radio tubes with the intent that they be included in the patented combinations could not be sued as a contributory infringer by Radio Corporation. Circuit Judge Buffington dissented.

The part of the opinion dealing with the patent phase of the case reads as follows, page 260:

"A patentee, the defendant says, has the exclusive right to make and sell to licensees, for their use in completing the licensed apparatus manufactured by it, any element of the patented combination, even though that element is old and free from patent monopoly. The learned District Judge, on the authority of the case of United Shoe Machinery Corp. v. United States, supra, overruled this contention. A licensed combination need not consist of separate patented elements, each of which is entitled to individual patent monopoly. It is the new combination that the law protects. Someof the elements may be new, and patented, and others old, on which patents have expired, or never patented. Of course, the law protects the individual patented elements, as well as the new combination composed of new and old elements. In such cases the patentable novelty consists in bringing together these new and old elements into a new combination, and not in the patentability of each element. Goss Printing-Press v. Scott (C. C. A. 3) 108 F. 253; United States v. American Bell Tel. Co., 167 U. S. 224, 249, 17 S. Ct. 809, 42 L. ed. 144; Leeds & Catlin v. Victor Talking Machine Co., 213 U. S. 325, 29 S. Ct. 503, 53 L. Ed. 816.

"A single old element, whose patent monopoly has expired, cannot be put into a new patented combination as a constituent element, and thus have its individual monopoly revived for 17 years more. would be a new method of securing a patent, or a means of evading the patent law, by doubling the length of the life of a patent. A patent may not be secured on a single element by inclusion. The vacuum tubes are an element in the electrical circuits licensed under the contracts. It is these circuits, as such, and not/the single unpatented elements, that are protected. While the defendant has the exclusive right to manufacture, lease, and sell the combination, it does not have the right to withhold from the manufacture, use, and sale by others a single one of the elements, composing the circuits, which is no longer protected by a patent. In other words, a patentee may not prevent the individual manufacture, use, and sale of a single unpatented element, which the world is free to make,

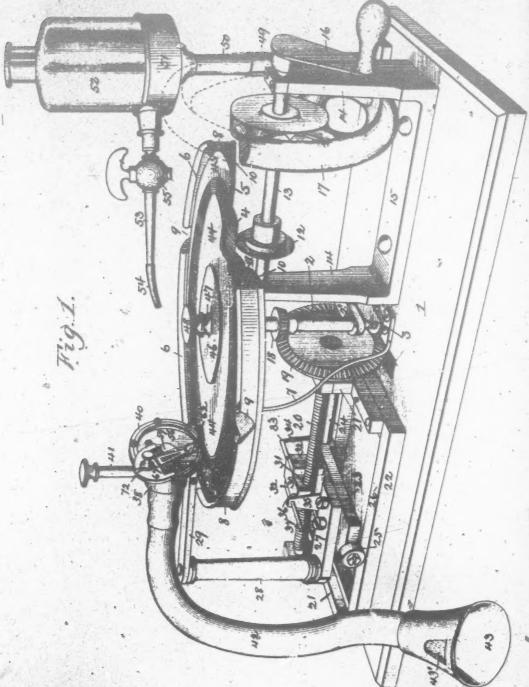
use, and sell, by simply including it as an element in a new patented combination. To put it differently, the inclusion in a patented combination of an unpatented element does not give the patentee of the combination a monopoly of each element, and the exclusive right to make, use, and sell that element, independent of the combination. So long as the patent covering vacuum tubes was in existence, the patentee of this element of the combination was protected, and it could not be included in the combination without a license to do so; but, when the patent on this tube element expired, the rights, which were theretofore vested in the patentee, became the property of the public, and not of the patentee of the combination." (Emphasis ours.)



### E. BERLINER. GRAMOPHONE.

No. 534,543.

Patented Feb. 19, 1895.



Witnesses;
Rey Cl Bowen;

Inventor:

Himile Berliner,

By Joseph Lory

Attorney.

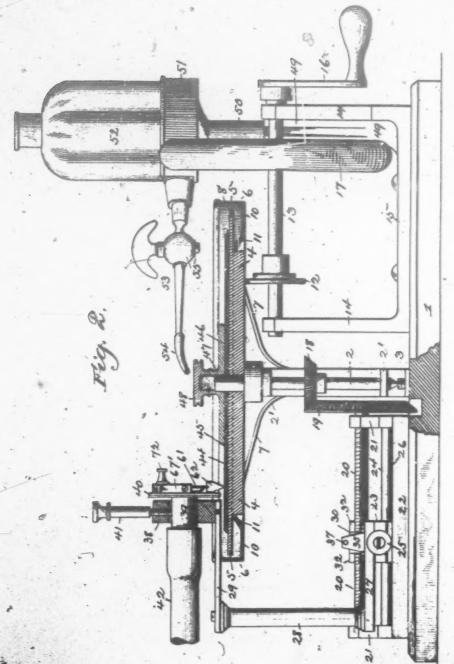
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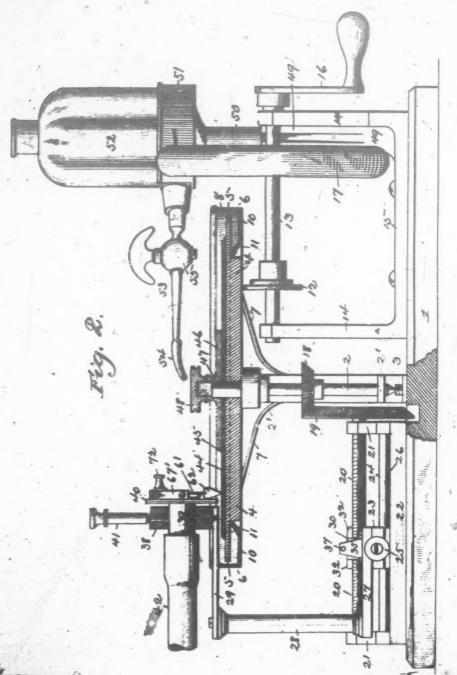
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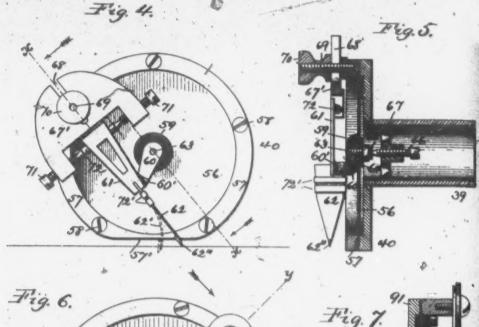
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### E. BERLINER. GRAMOPHONE.

Na. 534,543.

Patented Feb. 19, 1895.



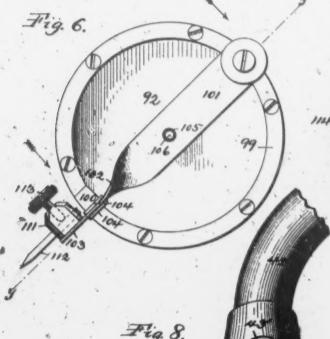


Fig. 8.

Witnesses;

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Inventor Emile Berline

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#### UNITED STATES PATENT OFFICE.

EMILE BERLINER, OF WASHINGTON, DISTRICT OF COLUMBIA, ASSIGNOR TO THE UNITED STATES GRAMOPHONE COMPANY, OF SAME PLACE.

#### GRAMOPHONE.

SPECIFICATION forming part of Letters Patent No. 534,543, dated February 19, 1895. Application filed March 30, 1892. Berial No. 427,060. (No model.)

To all whom it may concern:

Be it known that I, EMILE BERLINER, a citizen of the United States, and a resident of Washington, District of Columbia, have invented certain new and useful Improvements in Gramophones, of which the following is a

specification.

My invention has reference to improvements in the method of and apparatus for recording and reproducing sounds, the improvements being more particularly directed to the construction of that kind of sound recording and reproducing apparatus which I have called "gramophone," and for which Letters Patent of the United States No. 382,790, dated May 15, 1888, have been granted to me.

One feature of my invention has reference to improvements in the method of recording sound by tracing upon a fatty film deposited upon a metallic surface, undulatory lines, corresponding to sound waves, and then etching such lines in the metal base, or as it is now commonly called, the record tablet; while the other features of my invention have reference to the construction of the details of both the recorder and the reproducer of the gramophone. Each of these features of improvement are designed to overcome certain difficultiss, and to avoid certain imperfections heretofore met with in the operation of the pramophone. These difficulties and imperfeetions, and the manner in which they are avoided, will be particularly pointed out in the following detailed descript on with reference to the accompanying a awings, in

Figure 1, is a perspective view of my improved gramophone recorder. Fig. 2 is a side levation, partly in section, of the recorder. o Fig. 3 is a perspective view of a gramophone reproducer. Fig. 4, is an elevation of a rereproducer. Fig. 3, is an elevation of a recording diaphragm and stylus. Fig. 5, is a section of the same on the line x—x of Fig. 4.

5. is an elevation of the gramophone reproduced diaphragm and stylus. Fig. 7, is a section of the same on line y—y of Fig. 6, and Fig. 8, is a perspective view of an improved mouth-piem for the recorder.

Like numerals of reference indicate like parts throughout the drawings.

My improved gramophone recorded is shown.

My improved gramophone recorder is shown

as a whole in Figs. 1 and 2, mounted upon a suitable base 1. About midway of the length of this base there is an upright shaft 2, journaled in brackets 2', 2', stepped at its lower 55 end in a suitable bearing 3. This shaft carries at its upper end a circular disk 4, the outer or peripheral portion of which is reduced in thickness as shown at 5, and this reduced portion extends over a ring shaped pan Sc 6, supported by stays or brackets 7, from which it may be lifted and removed, when required. The outer edge or wall 8, of the pan is of sufficient height to project for a distance above the disk 4, and is provided with pour- 65 ing lips 9, for a purpose bereinafter described. The bottom 10 of the pan extends under the reduced portion 5, of the disk 4, and its inner edge 11, is upturned close to the under side of the reduced portion of the disk, as shown. 70

Bearing against the under side of the disk 4, is a friction wheel 12, secured to a horizontal shaft 13, which latter is journaled in the upper ends of posts or uprights 14 constituting the ends of a frame, the base 15, of which 75 is secured to the base 1 of the apparatus. The position of shaft 13, and the diameter of the friction wheel 12, are such, that a portion of the weight of the disk 4, and of its shaft 2, is supported by the friction wheel; where! y 80 the bearing 3, is relieved from a portion of that weight, and whereby frictional gearing between the disk 4 and wheel 12 is insured, without requiring special adjustment. The shaft 13, carries at its outer end a crank 10, 85 by means of which it is rotated, and between the two uprights 14, there is secured to the shaft a heavy fly or balance wheel 17. Secured to the upright shaft 2, below the disk 4, there is a beveled pinion 18, meshing with 90 4, there is a beveled pinion 18, menhing with go a large bevel goar 19, on one end of a hori-sputal screw-thressled shaft 20, which is arranged radial to the disk 4, and journaled adjacent to the said goar 19, and also at the other end, in pillow-blocks 21, imported on 95 the end piece of a rectangular frame 22, which in turn is fast on the base 1. Mounted upon the frame 22, so as to be movable thorous in the direction of the length of the shaft 20, there is a carriage 22, supported at one end too by a guide rod 24, on which it is free to slide, and at the other end by a roller 25 movable. and at the other end by a roller 95, movable

along the upper surface 26, of one of the side pieces of the frame 22. The carriage 23, has firmly secured to it a projecting arm 27, on the outer end of which is an upright post 28, 5 carrying at its upper end an arm 29, parallel with the arm 27, and of such length as to overhang the disk 4, when the carriage moved to the right, as represented in the drawings; the construction being such, that 10 when the carriage 23 is moved in the manner to be described, the arm 20, will be carried radially over the disk 4, and any object carried thereby will participate in said movement.

The carriage 23, is moved in one direction by means of the screw-threaded shaft 20, and in order to effect this operation, there is provided a block 30, in one side of which, near one end, is formed a half nut 31, constructed to engage the threads on the shaft 20; and 20 this block 30, is pivotally supported between ears 32, erected on the carriage 23. Projecting from the other end of the block 30, there is a pin 33, to which one end of a spring 34, is attached, the other end of said spring being as secured to the carriage 23, and the tendency of the spring is to maintain the block 30, in a tilted position with the nut portion raised out of engagement with the shaft 20. In order to lock the block 30, in engagement ,o with the shaft 20 there is provided a leaf spring 35, mounted on the carriage 20, opposite the free end of the block 30, and having on its free end a tooth 36, which passes over the top of the hinged block 30, when the nut formed in the same is in engagement with the screw threads on the shaft 20, the tendency of the leaf apring 35, being to move inwardly of the leaf spring 35, being to move inwardly toward the black 30. This enteh spring 35, is also provided with a pin 37, which serves as a handle for withdrawing the catch so as to unlock the block 30, and thereby allow the

to unlock the block 30, and thereby allow the carriage 23 with its appurtenances to be freely moved to any position upon the frame 22.

To the free everhanging arm 30, is secured a ring sleave 35 which receives the neck 39, projecting on one side from the frame 40, in which latter the recording disphragm and stylus are mounted, and this neck 39, with its appurtenances is fixed in any desired position in the ring frame 38, by a clamp screw 41. The free end of the neck 39, projects beyond the ring frame 36, and receives the sound conthe ring frame II, and receives the sound conveying tuite II, which is preferably made flexible, and which has at its free end a mouth-piece II, the particular construction of which will hereinafter be more fully de-

The disk 4, which is in the nature of a re-tary table, has bereinbefore been described and is above in the drawings as reduced in thickness on that portion of the periphery which overings the inner wall of the panel, and if this senstruction is used, the disk 4, must be removable from the shaft 2. It is, however, also practicable to make the disk or revolving lable, in two parts, the lower part of which extending only to within a short distance of the upper edge of the inner wall 11, of the pan, while the upper part extends over that edge to within a short distance of the 70 outer wall of the part. This is indicated by a dotted line in Fig. 2, and if this construction is adopted, only the upper thinner part of the table is removable from the upright shaft 2, while the lower thicker part of the table may 75 be fixed to that shaft.

When a sound record is to be made, a record tablet of the kind described in my aforesaid Letters Patent, is placed upon the rotary table 4, and this record tablet is represented in the 80 drawings as a circular disk 44, which has a central perforation passing over the upper end of the shaft 2. Some..mes it is convenient to interpose between the record tablet and the rotary supporting table a thin disk %5 45, of felt, or of some other non-resonant material. This, however, is not essential. Upon the record tablet is placed a clamping plate 46, which by preference is provided with a hub 47, which is slipped over the upper end 90 of the shaft 2. This upper end of the shaft 2, is screw-threaded as shown, and a thumbnut 48, is then screwed down upon the hub of the clamping plate, whereby the record tablet is securely fastened in position.

At one end of the base plate 1, there is mounted a standard 49, which may be a split tube as shown, and in which is supported by friction a stem 50, projecting from the bottom of a shelf 51, and which in turn supports a 100 ressel 53, containing alcohol. From the bottom of this vessel extends a tube 53, preferably provided at its free end with a flexible nozzle 54; and a stop-cock 56, with which the tube is provided permits the operator to regu- 105 late the flow of alcohol from the nossle. With my present improvement it is necessary that during the whole process of tracing the record, the record tablet be covered with a film of alcohol, and for this purpose a thin stream 110 of alcohol is directed upon the center of the tablet, or rather upon the clamping plate 46, from which the alcohol spreads in all directions by centulings! force and flows over into tions by centrifugal force, and flows over into the pan 6. When the tracing of the record 115 has been completed, the clamping plate is removed and the record tablet also is lifted from its support by the insertion between the same of a sharp edge, such as a knife blade, or even by the finger nails of the operator, and is re-moved for further manipulation as described in my aforesaid Letters Patent, and also for the manipulation which will be described bereinaftår.

Only a very small quantity of alcohol is 125 used for producing a single record, but after amount of alcohol accumulates in the pan, and this is removed by removing the table 4, or the upper, thinner part thereof, as the case may be, by inserting a finger in each of the pouring lips 8, and thus lifting the disk or table 4, from the shaft 2. The pan is then removed from the bracket 7, and the alcohol

is poured out and preferably back into the vessel 52, by one of the pouring lips.

The recording diaphragm 56, is mounted in the circular/frame 40; between a ledge formed 5 on said frame and an annulus 57, screwed down upon the same by screws 58, as shown, or in any other suitable manner. On the rear side of that diaphragm there is applied a small block 59, of hard rubber from which to extends radially an arm 60, which at its free end is turned up at right angles, outwardly and into contact with the lever 61, which carries the recording stylus 62.

The block 59, is fastened to the center of 15 the diaphragm by a serew 63, passing through the diaphragm and through a washer 64, applied to the front side of the disphragm. The head of this screw is faced with a disk 65, of soft rubber, and against the same bears the to point of an adjusting screw 66, which is mounted in a perforated disk or spider 67,

fixed in the neck 39:

The lever 61 is mounted on a plate 67' formed with a slot 68, through which a set 15 screw 69, fixed in the annulus 57, passes. The plate 67', can thus be adjusted to various positions on the annulus, and is clamped in the adjusted position by a thumb-nut 70. One end of the plate 67' is bifurcated, and screws 10 71, 71, passing through the legs of the fork, are formed at their ends with bearings for the pivot points of the arbor 72, which is fixed to the lever 61. This lever, is made as light as practicable and as is consistent with rigidity, 35 and the plate 67', together with the lever 61. which it carries, is so adjusted that the upturned end of the arm 60, bears upon the lever at the greatest practicable distance from the axis of the spindle 72, viz: at the free end of the lever. The connection between the lever and the upturned end of the arm 60 is made by a small quantity of pitch, 60', which acts as an efficient cement, and which is applied after the lever has been adjusted to its proper 45 position. This mode of connecting the lever with the arm 60, and theraby with the diaphragm, I have found to be of great advantage for a variety of reasons, but more espe-cially on account of the ease with which the so connection is made, and unmade in case of repair, and on account of the damping effect it has upon the lever.

To the end of the lever GI, is secured the recording stylus 62, by soldering or other-15 wise, with its plane at right angles to the plane of the lever, as shown. The stylus is composed of a flat, and rather thin plate of spring steel, pointed at its free end, and provided with a tracing point 62", of iridium.

60 The broad portion of the stylus is damped by e or two bands 72', of soft rubber, which simply slipped over the same.

By reference to Fig. 4, it will be seen that lever 61, with the recording stylus 62 exacross the diaphragm upon a line which circle of the diaphragm. They are, therefore,

eccentrically mounted with reference to the center of the disphragm; but notwithstanding this eccentric location, the lever is rigidly 70 connected with the center of the diaphragm and thus receives the maximum amplitude of its vibration. By thus placing the lever with the stylus eccentric with reference to the center of the diaphragm both the lever and the 75 stylus may be and are made shorter than if they were located on the line of a diameter of the diaphragm. This is an important result, since the shorter the lever and stylus, the less liability there is of lost motion, and the less 8c liability there is of extra or spontaneous vibrations of the lever and stylus, and both of these facts conspire to produce an accurate tracing of the sound waves impinging against the diaphragm.

Where the stylus passes over the edge of casing 40, the latter, together with the annulus 57, is cut away upon a straight line, as indicated at 57'. This permits a further reduction of the length of the stylus, since the record go tablet may be located close to the straight

edge 57'

The body of the stylus is normally curved downwardly, as shown in dotted lines at 62', but when the diaphragm holder or frame 40, 95 is turned to cause the stylus to impinge upon the record tablet, which is the preparatory step for making a record, the stylus is unbent and becomes straight, as shown in solid lines in Fig. 4, and I have found that the best re- 100 sults are obtained when the stylus is at an angle of about forty-five degrees with the plane The maximum pressure of the of the tablet. stylus upon the record surface is therefore equal to the force required to unbend the 103 stylus. It is very small, because the stylus is made as thin as practicable, and it is uniform for different records and for all parts of the same record

The mouth piece, into which vocal sounds 110 are uttered for recording, is shown at 43, in Figs. 1 and 8, and it consists of a bell shaped structure, the small end of which is secured to the sound conveying tube, while the wide, flaring end is turned toward the speaker who 115 applies his mouth to the opening. Near the edge of the mouth opening there is a perforation 43', cut into the wall of the mouth-piece, and this perforation is of such shape and size, and at such distance from the edge of the 120 mouth-piece, as to fit approximately the edge of the nose of the speaker; so that when the mouth-piece is applied, the sounds attered by the mouth enter the wide, flaring opening, while the sounds attered by the gose enter 125 the perforation 43'.

In making a record of vocal sounds, it is necessary that all sound waves composing the words or the song be conveyed to the diaphragm, and it has, therefore, been proposed 130 to make mouth-pieces of such size and shape as to admit within the opening both the mouth and the nose of the speaker or singer, and to fit against the face of the user around the

mouth and nose. Mouth pieces of this character are necessarily large and clumsy, and do not readily and comfortably at different persons, while with my construction the size of 5 the mouth-piece is reduced, and will comfort-

ably fit different speakers. By means of the apparatus so far described, a record of sound waves is made in the following manner: The spring catch 35, 36, is 10 drawn back, which permits the spring 31, to lift the block 30, from the screw 20, so that the carriage 23, may be freely moved to the left, whereby the stylus 62, is carried beyond the edge of the rotary table 4. A record tab-15 let prepared in the manner described in my aforesaid Letters Patent is then placed upon the table 4, and clamped to the same, as hereinbefore described, and the carriage 23, is moved toward the right until the point of the record-10 ing stylus is above the tablet but within the edge of the same. The casing 40, is then turned in its bearing 38, until the point of the stylus impinges upon the tablet and is unbent, as shown in Fig. 4. In this position the casing 25 40, is clamped by means of the screw 41. stop-cock 55, is then opened and a thin stream of alcohol is directed upon the clamping disk The wheel 17, is now rotated by means of the crank and handle 16, whereby, by 30 means of the gearing described, the record tablet is rotated, while the stylus is carried across the face of the tablet in a radial line, removing from the tablet a fine spiral line of the fatty etching ground with which it had 15 been covered. Sound waves are now directed against the diaphragm in any desired manner, and if vocal sounds are to be recorded, the sound conveying tube 42, with the mouth piece 43, will be used. The vibrations of the 40 diaphragm thus produced will cause the stylus to make a tracing of an undulatory line, corresponding to the sound waves directed against the diaphragm; all as described in my aforesaid Letters Patent. During this whole 45 time a thin stream of alcohol is delivered upon the plate 46, and the alcohol spreading out in all directions is maintained as a uniform and constantly renewed film upon the

my present invention differs from the pro-cess set for in my aforesaid Letters Patent. In accordance with the said patent, alcohol is poured once for all over the tablet, and is 55 allowed to evaporate during the process of recording. I have found that in this manner it often happens that the alcohol has entirely evaporated before the record is completed, so that a portion of the latter is made upon a 50 dry tablet; whereby the accumulation of file-mentary particles of dust on the point of the stylus, which the slockol is designed to avoid, ortion of the latter is made upon a takes place during the production of a por-tion of the record. With my present im-53 provement this defect is cured, since it main-tains the record tablet moist with alcohol from the beginning to the end of the operation.

tablet. In this manner every part of the rec-

After the tracing of the record has been completed, the tablet is speedily removed and before the record is fixed by etching as de- 70 scribed in my aforesaid patent, the alcohol adhering to the record surface is quickly washed off with water. This is an important step in my improved process and greatly improves the definition of the record by etching. 75 The reason for this is, that the alcohol slightly attacks and dissolves the fatty etching ground, so that the thin film of alcohol remaining upon the tablet, contains a slight quantity of that ground in solution. If now, the film of alco- 80 hol is allowed to evaporate an exceedingly small quantity of the dissolved ground is deosited upon the metal which has been laid bare by the stylus. This small deposit of ground sufficiently resists the action of the \$5 etching fluid to impair the definition of the final record. By simply pouring water over the record surface immediately after the tablet has been removed from the recording apparatus the film of alcohol and the ground 90 held in solution by the same is removed, and the tracings of the stylus present a clean metallic surface, which is properly attacked by the etching fluid.

The reproducing apparatus as a whole is 95

represented in Fig. 3.

Upon a base board 73, in standards 74, is journaled a shaft 75, upon which are mounted a driven pulley 76, a fly-wheel 77, and a friction disk 78. The latter is in frictional engagement with a rotary table 79, which is mounted upon a vertical shaft substantially in the manner described with reference to the rotary table 4, of the recording apparatus. Fig. 3, being a perspective view, the mounting of the table 79, is not visible, but is easily understood from the foregoing description. The upper surface of the table is preferably covered with a sheet of felt or other elastic and non-resonant material, as indicated by 110

appropriate shading. Upon the felt covered table 79, the record tablet 44, is placed and is clamped thereon substantially in the manner in which this is done in the transmitting apparatus, i. e., by 115 means of a clamping plate 46, and a thumbngt 48. A driving wheel 80, mounted on a shaft 81, which is journaled in standards 82, is rotated by means of a crank 83, and handle 84, and gives motion to the table 79, by means 120 of a crossed belt or cord 85. The relation of the table 79, to the friction disk 78, is the same as the relation of the table 4, to the friction disk 12; that is to say, the table rests with the greater part of its weight upon the 12 friction disk, so that the frictional gearing is automatically maintained. A post 86, mounted upon the base-board 78, has swiveled upon its upper end a fork 87, between the prongs of which is pivoted the swinging arm 88, 13 which extends over the table 79, and has at its free end a clasp 89, which receives the neck 90, which projects from the center on one side of the casing 91, of the reproducing

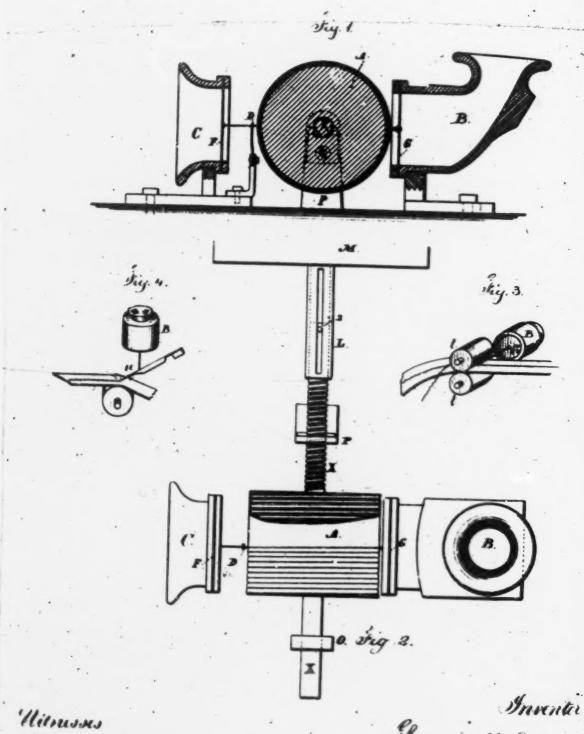
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#### A. EDISON. Phonograph or Speaking Machine.

No. 200,521.

Patented Feb. 19, 1878.



Charold Stirrel

Thomas U. Edison.

per Lemuil W. Serel

its diaphragm, styles and appurtenances, which will presently be described, can be thus turned in the clasp, and can be fixed in any adjusted

5 position by a clamp screw 93.

Upon the end of the neck 90, which projects beyond the clasp 89, is slipped a flexible tube 94, which in turn receives the small end of a sound conveying trumpet 95, the flaring 10 end 96 of which is turned toward the listener. A bracket 97, secured to the swinging arm 88, carries at its free end an elastic fork 98, which receives and supports the trumpet, and the parts are so proportioned that the free end of 15 the swinging arm preponderates, so that the point of the reproducing stylus, which will presently be described, presses rather firmly upon the record tablet.

It will now be understood, that when a recso ord tablet, having a record of sound waves upon its surface, produced in accordance with my invention, is mounted upon the table 79, and when the point of the stylus is adjusted in engagement with the record groove, and 15 the wheel 80, is rotated, the rotating record groove will guide the stylus across the face of the tablet, and will at the same time vibrate the stylus and diaphragm in accordance with the undulations of the record groove. The 30 sound waves thus produced by the diaphragm will issue from the flaring opening of the trumpet, and the sounds will be heard by a listener in front of the trumpet, or in its vicinity.

The reproducing diaphragm is mounted in 35 the casing 91, in the usual manner, being held against a ledge by means of an annulus 99. On this annulus is formed a swelling or block 100, and diametrically opposite to the same the stylus carrying spring 101, is fastened to 40 the annulus, and extends across the face of the diaphragm and beyond the edge of the annulus. This spring 101, is a leaf spring which faces with its flat side the face of the diaphragm up to a point beyond the center 45 of the latter, and is then twisted at right angles, as indicated at 102, and crosses the annulus edgewise as shown at 103. The tendency of the part 101, of the spring is to press toward the diaphragm, whereby the edge of 50 the part 103, is made to bear with some force upon the annulus 99; and the tendency of the part 103, is to press against the swelling or block 100. The spring is therefore elastic in two directions at right angles to each other.

In order to prevent grinding of the spring against the aunulus and against the block 100, a U-shaped piece 104, of soft rubber embraces the outer portion 103, where it bears upon the annulus and against the block. This oft rubber cushion also serves as a dampener for the spring. At the point where the spring asses over the center of the diaphragm, it as a perforation 105, and a screw pin 106, seenred to the center of the diaphragm by 65 two nuts 107, 108, extends loosely through the Perforation. A thumb-nut 109, also placed

110 between the thumb-nut and the spring serve to regulate the tension of the latter and of the diaphragm, as will be readily un- 70

derstood.

On the free end of the spring 101, 103, there is secured a binding post 111, in which the stylus 112, is held by the set screw 113, and may be adjusted to project to the required 75 distance beyond the end of the spring. This stylus is preferably made of hard steel. It has a slender point, but the point should not be so sharp as to cut the bottom of the record groove which it engages.

In the operation of reproducing the sounds recorded on a tablet, the stylus is guided by the walls of the record groove, and not by the bottom of the same. Consequently is is not essential that the point of the stylus be in 85 contact with the bottom of the groove. In fact it is preferably not in contact with the same, so that this point may be made rather

The sounds emitted by the reproducing dia- 90 phragm are very powerful and ordinarily too loud to be received with comfort by a listener in front of the trumpet or other receiving tube. For this reason I have found it sometimes necessary to reduce the volume of the 95 emitted sound before it reaches the ear, and this I accomplish by one or more perforated. and exchangeable disphragms 114, placed in the neck 90. These disphragms should be made of some non-resonant material like soft 100 rubber, or cork, as indicated by appropriate shading.

Having now fully described my invention, I claim and desire to secure by Letters Pat-

1. The method of recording vocal and other sounds which consists in removing from a record tablet covered with a fatty film, undulatory lines of said film by, and in accordance with the sound waves and maintaining at the 110 same time a layer of a fluid over the film, sub-

stantially as described.

2. The method of recording vocal and other sounds upon a rotating disk covered with a fatty film which consists in spreading over 115 said film and continuously renewing over the same a layer of a fluid and at the same time removing from said tablet undulatory lines of the fatty film by and in accordance with the sound waves, substantially as described. 120

3. The improvement in the art of making a ramophone record which consists in immersing and maintaining the tablet and the point of the recording stylus in alcohol during the process of recording, substantially as de- 125

4. The improvement in the art of making and fixing a gramophone record which consists in removing from a tablet covered with a fatty film undulatory lines of said film by 130 and in accordance with sound waves while said film is covered with a layer of alcohol; then immediately removing the alcohol with on the screw-pin 108, and a soft rubber washer | water and then subjecting the tablet to the

action of an etching fluid, substantially as described.

5. The method of reproducing sounds from a record of the same which consists in vibrat-5 ing a stylus and propelling the same along the record hy and in accordance with the said record, substantially as described.

6. In a gramophone, a recording stylus coming by its own elasticity upon the recso ord tablet at right angles to the plane of its vibratory movements and consisting of a leaf apring terminating in a point of narder ma-terial than that of the body of the stylus, sub-

stantially as described.

7. In a gramophone, the combination of a sound receiving diaphragm and an clastic re-cording styles controlled by the diaphragm and adjustable with reference to a record tablet so as to press by its own elasticity upon so the same at right angles to the plane of its vibratory movements, substantially as deacribed

8. In a gramophone a recording stylus pressing by its own elasticity upon the recbratory movements, and consisting of a leaf apring terminating in an iridium point, substantially as described.

9. In a gramophone, a recording stylus 30 composed of a leaf spring terminating in a tracing point in combination with one or more elastic non-concrous dampers, substan-

tially as described. 10. In a gramophone a recording stylus 35 formed of a leaf spring terminating in a tracing point in combination with one or more alcoves of soft rubber upon the leaf

more sleeves of soft rubber upon the leaf apring for damping the same, substantially as described.

10. In a gramophone, the combination of a sound receiving diaphragm, a lever and a recording styles carried by the same, both extending parallel but eccentrically over the diaphragm; with a connection between the diaphragm; with a connection between the stantially as described.

12. In a gramophone, the combination of a sound receiving diaphragm a lever and a recording styles carried by the same, both extending over the face of the diaphragm but occuntrically therete, with a rigid connection between the senter of the diaphragm and the between the center of the disphragm and the free end of the lever, substantially as desoribe

13. In a gramophone, the combination of a circular sound receiving disphragm, a lever and an elastic recording stylus both extending parallel with the disphragm on the line of a chord, with a rigid connection between the center of the disphragm and the free end of the lover, assumptions, the combination of a sound receiving disphragm, a lever and an clastic stylus carried by the same, both extending parallel, but eccentrically thereto;

65 tending parallel, but eccentrically thereto; with a bracket rigidly connected with the center of the diaphragm and removably cemented to the lever, substantially as described.

15. In a gramophone, the combination of a 70 sound receiving diaphragm mounted in suitable frame, a bracket adjustably mounted on said frame, a lever pivoted in said frame extending parallel to and eccentrically with reference to the center of the disphragm, and 75 an elastic recording stylus carried by the lever; with a mechanical connection between the center of the diaphragm and the free end of the lever, substantially as described.

 In a gramophone a sound receiving dia- to phragm and a tube for conveying sound waves thereto in combination with a recording stylus receiving motion from the diaphragm, and a screw mounted in the sound conveying tube bearing centrally upon the 85 disphragm for adjusting the tension of the latter, substantially as described.

17. In a gramophone, the combination of a horizontal rotary table adapted to support a record tablet, and a vertical shaft free to move oo longitudinally, carrying the table; with a friction disk engaged by the under side of the table for rotating the latter, substantially as described.

18. In a gramophone the combination of a ge horizontal rotary table mounted upon a vertical shaft and adapted to support a record tablet; with a friction disk engaging the under side of the table and partly sustaining the weight of the table, whereby the latter is au- 100 tomatically maintained in frictional gear with

said disk, substantially as described.

19. In a gramophone, the combination of a rotary horizontal table adapted to receive and support a flat record tablet; with a reservoir 105 of a suitable fluid, such as alcohol, discharging upon the center of the table and tablet, and an annular pan disposed underneath the table for receiving the overflow of alcohol, sub-

stantially as described.

30. In a gramophone the combination of a horizontal rotatable table adapted to receive and support a record tablet; with a reservoir of alcohol discharging upon the center of the table and tablet, an annular pen disposed un-der the edge of the table for receiving the overflow of alcohol, and a friction disk bearing upon the under side of the table between the center of the same and the inner wall of the pan, substantially as described.

31. In a gramophone, the combination of a horizontal rotary table adapted to receive and support a record tablet, a recording dia-phragm and stylus connected by gearing with the table to move radially over and with the 115 stylus in operative relation to the same, sub-

stantially as described.

borizontal rotating table adapted to receive and sustain a flat record tablet, with a car 130 riage movable in a line parallel to a radius of the table, a recording diaphragm and stylus carried by the carriage with the stylus in operative contact with the record tablet, and

gearing connecting the table with exid car-

riage, substantially as described

23. In a gramophone, a sound conveying tube provided with a mouth piece having a s flaring opening for the application of the mouth of the speaker and a perforation in the side wall of the mouth piece separated from and spaced with reference to the mouth opening and shaped to correspond to the shape of to the nostrils of the speaker, substantially as described.

24. In a gramophone a sound reproducing diaphragm in combination with a stylus lever extending diametrically across the same, and 15 elastic in two directions at right angles to each

other, substantially as described.

25. In a gramophone, the combination of a diaphragm and a stylus carrier composed of a leaf spring twisted at one point so as to bring so the edge of one portion at right angles to the face of the other portion, whereby it is elastic in two directions, substantially as described.

26. In a gramophone the combination of a reproducing diaphragm and stylus; with a 25 stylus carrier composed of a leaf spring extending flat-wise over the face of the diaphragm and edgewise over the edge of the dia-

phragm, substantially as described.

27. In a gramophone the combination of a 30 reproducing disphragm mounted in a suitable frame the latter being provided at one point with a boss or stop; with a double elastic styins carrier composed of a twisted leaf-spring tending toward the diaphragm and against 35 the boss or stop, substantially as described.

28. In a gramophone, a reproducing diaphragm and stylus in combination with an elastic stylus carrier extending over the Inc of the diaphragm and tending toward the same, of an adjustable connection between the diaphragm and stylus carrier and adjustable for varying the pressure between diaphragm and style carrier, substantially as described.

20. In a gramophone the combination of a 45 reproducing disphragm mounted in asuitable frame provided with a buss or stop; with a double elastic stylus carrier tending toward the diaphragm and toward the stop, and elastic non-resonant dampers interposed between the style carrier and the disphragm and be- 50 tween the style carrier and the frame and stop, substantially as described.

80. In a gramophone a sound reproducing diaphragm and a sound conveying tube for the same, with one or more non-resonant per- 55 forated diaphragms in the said tube for reducing the volume of sound conveyed to the ear substantially as described

31. In a gramophone a recording stylus pivoted to move in response to the vibrations of 60 a diaphragm and elastic in a plane at right angles to such motions, substantially as de-

scribed.

32. In a gramophone, a reproducing stylus having a wedge-shaped point engaging the 65 walls of the record groove, substantially as described.

33. In a gramophone reproducer, a stylus carried or formed by a spring fixed at one end to the diaphragm holder and freely extending 70 across and beyond the same and operatively connected with the center of the diaphragm, substantially as described.

84. In a gramophone reproducer, a spring constituting or carrying a stylus, fixed at one 75 end to the diaphragm holder and extending across and beyond the periphery of the same and freely pressing against the diaphragm, substantially as described.

85. In a sound reproducing apparatus con- 80 sisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same, substantially as described.

In testimony whereof I have signed my name to this specification in the presence of

two subscribing witnesse

EMILE BERLINER.

Witnessee:

HENRY E. COOPER, F. T. CHAPMAN.

### NITED STATES PATENT OFFICE.

THOMAS A. EDISON, OF MENLO PARK, NEW JERSEY.

#### MPROVEMENT IN PHONOGRAPH OR SPEAKING MACHINES.

Specification forming part of Letters Patent No. 200,521, dated February 19, 1878; application filed December 24, 1877.

all sohom it may concern:

he it known that I, THOMAS A. EDISON, of allo Park, in the county of Middlesex and to of New Jersey, have invented an Imvement in Phonograph or Speaking Manes, of which the following is a specifica-

the object of this invention is to record in manent characters the human voice and er sounds, from which characters such ands may be reproduced and rendered andi-

representation and thus reproduce the motion of the sufficient to cause a section with a material capable registering the movements of such vibrations and the such a manner that such gister-marks will be sufficient to cause a section of them, and thus reproduce the motions of effect vibrating plate or body to be set in motion them, and thus reproduce the motions of effect vibrating body.

The invention further consists in the various mbinations of mechanism to carry out my

I have discovered, after a long series of exriments, that a disphragm or other body puble of being set in motion by the human nee does not give, except in rare instances, perimposed vibrations, as has heretofore been apposed, but that each vibration is separate ad distinct, and therefore it becomes possible record and reproduce the sounds of the huan voice.

In the drawings, Figure 1 is a vertical secon, illustrating my invention, and Fig. 2 is plan of the same.

A is a cylinder having a helical indentingreove cut from end to end—say, ten grooves the inch. Upon this is placed the material be indented, preferably metallic foil. This rum or cylinder is secured to a shaft, X, having at one end a thread cut with ten threads to the inch, the bearing P also having a thread

L is a tube, provided with a longitudinal slot, and it is rotated by the clock-work at M, or other source of power.

The shaft X passes into the tube L, and it is rotated by a pin, 2, secured to the shaft,

the object of the long slot being to allow the shaft X to pass endwise through the center or support P by the action of the screw on X. At the same time that the cylinder is rotated it passes toward the support O.

B is the speaking-tube or mouth-piece, which may be of any desired character, so long as proper slots or holes are provided to re-enforce the hissing consonants. Devices to effect this object are shown in my application, No. 143, filed August 28, 1877. Hence they are not shown or further described herein.

Upon the end of the tube or mouth-piece is a disphragm, having an indenting point of hard material secured to its center, and so arranged in relation to the cylinder A that the point will be exactly opposite the groove in the cylinder at any position the cylinder may occupy in its forward rotary movement.

The speaking-tube is arranged upon a standard, which, in practice, I provide with devices for causing the tube to approach and recede from the cylinder.

The operation of recording is as follows:
The cylinder is, by the action of the screw in X, placed adjacent to the pillar P, which brings the indenting-point of the diaphragm G opposite the first groove on the cylinder, over which is placed a sheet of thick metallic foil, paper, or other yielding material. The tube B is then adjusted toward the cylinder until the indenting-point touches the material and indents it slightly. The clock-work is then set running, and words spoken in the tube B will cause the diaphragm to take up every vibration, and these movements will be recorded with surprising accuracy by indentations in the foil.

After the foil on the cylinder has received the required indentations, or passed to its full limit toward O, it is made to return to P by proper means, and the indented material is brought to a position for reproducing and rendening andible the sounds that had been made by the person speaking into the tube B.

O is a tube similar to B, except that the diaphragm is somewhat lighter and more sensitive, although this is not actually necessary. In front of this diaphragm is a light spring, D, having a small point shorter and finer than

the indenting-point on the diaphragm of B. This spring and point are so arranged as to fall exactly into the path of all the indentations. This spring is connected to the diaphragm F of C by a thread or other substance capable of conveying the movements of D. when the cylinder is allowed to rotate, the spring D is set in motion by each indentation corresponding to its depth and length. motion is conveyed to the diaphragm either by vibrations through a thread or directly by connecting the spring to the diaphragm F and these motions being due to the indentations, which are an exact record of every movement of the first diaphragm, the voice of the speaker is reproduced exactly and clearly, and with sufficient volume to be heard at some distauce.

The indented material may be detached from the machine and preserved for any length of time, and by replacing the foil in a proper manner the original speaker's voice can be reproduced, and the same may be repeated frequently, as the foil is not changed in shape if

the apparatus is properly adjusted.

The record, if it be upon tin-foil, may be stereotyped by means of the plaster-of-paris process, and from the stereotype multiple copies may be made expeditiously and cheaply by casting or by pressing tin-foil or other material upon it. This is valuable when musical compositions are required for numerous machines.

It is obvious that many forms of mechanism may be used to give motion to the material to be indented. For instance, a revolving plate may have a volute spiral cut both on its upper and lower surfaces, on the top of which the foil or indenting material is laid and secured in a proper manner. A two-part arm is used with this disk, the portion beneath the disk having a point in the lower groove, and the portion above the disk carrying the speaking and receiving diaphragmic devices, which arm is caused, by the volute spiral groove upon the lower surface, to swing gradually from near the center to the outer circumference of the plate as it is revolved, or vice versa.

An apparatus of this general character adapted to a magnet that indents the paper is shown in my application for a patent, No. 128, filed March 26, 1877; hence no claim is made herein to such apparatus, and further description of the same is unnecessary.

A wide continuous roll of material may be

A wide continuous roll of material may be used, the diaphragmic devices being reciprocated by proper mechanical devices backward and forward over the roll as it passes forward; or a narrow strip like that in a Morse register may be moved in contact with the indenting-point, and from this the sounds may be reproduced. The material employed for this purpose may be soft paper saturated or coated with paraffine or similar material, with a sheet of metal foil on the surface thereof to receive the impression from the indenting-point.

I do not wish to confine myself to reproduc-

ing sound by indentations only, as the trans mitting or recording device may be in a sing ous form, resulting from the use of a three passing with paper beneath the pressure rollers t, (see Fig. 3,) such thread being move laterally by a fork or eye adjacent to th roller t, and receiving its motion from the dis phragm G, with which such fork or eye is con nected, and thus record the movement of the diaphragm by the impression of the thread in the paper to the right and left of a straigh from which indentation the receiving diaphragm may receive its motion and the so and be reproduced, substantially in the man ner I have already shown; or the diaphrage may, by its motion, give more or less pressur to an inking-pen, u, Fig. 4, the point of which rests upon paper or other material moved along regularly beneath the point of the pen thus causing more or less ink to be deposited upon the material, according to the greater lesser movement of the diaphragm. The ink-marks serve to give motion to a second diaphragm when the paper containing such marks is drawn along beneath the end of a lever resting upon them and connected to such disphragm, the lever and diaphragm being moved by the friction between the point being great est, or the thickness of the ink being greater where there is a large quantity of ink than where there is a small quantity. Thus the original sound-vibrations are reproduced upon the second diaphragm.

I claim as my invention-

1. The method herein specified of reproducing the human voice or other sounds by causing the sound-vibrations to be recorded, substantially as specified, and obtaining motion from that record, substantially as set forth, for the reproduction of the sound-vibrations.

2. The combination, with a diaphragm exposed to sound-vibrations, of a moving surface of yielding material—such as metallic foil—upon which marks are made corresponding to the sound-vibrations, and of a character adapted to use in the reproduction of the sound, substantially as set forth.

3. The combination, with a surface having marks thereon corresponding to sound-vibrations, of a point receiving motion from such marks, and a disphragm connected to said point, and responding to the motion of the

point, substantially as set forth.

4. In an instrument for making a record a sound-vibrations, the combination, with the diaphragm and point, of a cylinder having the helical groove and means for revolving the cylinder and communicating an end movement corresponding to the inclination of the helical groove, substantially as set forth.

Signed by me this 15th day of December

A. D. 1877.

THOS. A. EDISON.

Witnesses:

GEO. T. PINCKNEY, CHAR. H. SMITH.

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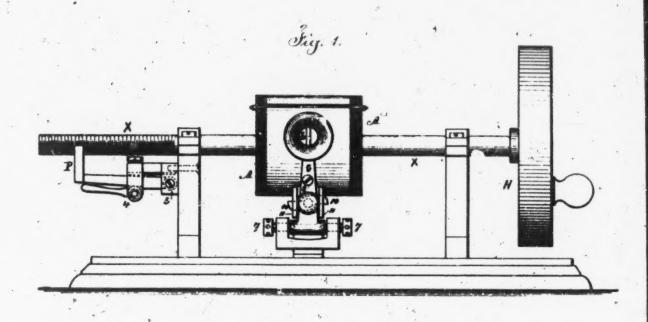
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2 Sheets-Sheet 1.

#### T. A. EDISON. Phonograph.

No. 227,679.

Patented May 18, 1880.









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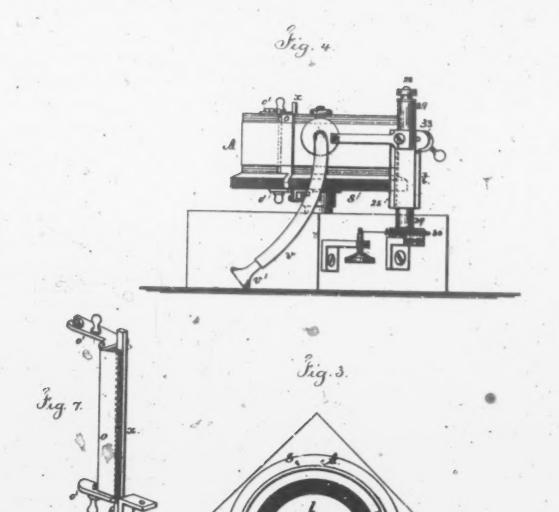
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T. A. EDISON. Phonograph.

No. 227,679.

Patented May 18, 1880.



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### UNITED STATES PATENT OFFICE.

THOMAS A. EDISON, OF MENLO PARK, NEW JERSEY.

#### PHONOGRAPH.

SPECIFICATION forming part of Letters Patent No. 297,679, dated May 18, 1880.

Application filed March 39, 1879.

To all whom it may concern:

Be it known that I, THOMATALVA EDISON, of Menlo Park, in the State of New Jersey, have invented an Improvement in Phonographs, (Case No. 174,) of which the following

is a specification.

In Letters Patent No. 200,521, granted to me, a cylinder with a belical-grooved surface is revolved with its screw-shaft and moved along endwise. Upon this cylinder there is a sheet of foil or similar material, and the same is indented by the action of a point moved by a diaphragm, and this foil forms a phonogram that can be used to reproduce the original sounds when moved in contact with a point and diaphragm. In the said patent one of the points is shown as connected directly to the diaphragm, and the other point is upon a spring.

My present invention relates to improvements upon the phonograph patented as aforesaid, and the features of such improvement are hereinafter specially pointed out.

In the drawings, Figure 1 is an elevation of the phonograph. Fig. 2 is a section of the diaphragm. Fig. 3 is an end view of the cylinder containing the foil. Fig. 4 is a side view of the diaphragm and the device for moving the same.

The cylinder A has a grooved surface, as in aforesaid patent, and it receives the fin-foil or other material that is to be indented by the action of the diaphragm b and point to produce the record of the sound, which I term the "phonogram," and the diaphragm E and point D are adapted to form a phonet and reproduce the sound; but it is to be understood that the same point and diaphragm may be employed to record and to reproduce the sound.

In my present invention, as in my former patent, the motion of the recording surface may be derived from clock-work, hand, or other

honet.

In order to insure great uniformity of speed and prevent irregularity in the movement by inaccuracies of work, dast, lack of oil, or any other source of local friction or resistance, I make use of an abnormally heavy fly wheel, H, upon the shaft of the phonograph, so as to 50 prevent any trembling movement and to resist any tendency to increase or lessen the speed, for upon uniformity of speed of the phonet with the phonograph depends the accuracy of reproduction, especially in musical sounds, 55 that depend for their tone upon the number of vibrations per second.

The nut P is upon a lever pivoted at 3 and kept in contact by a cam, 4. When this lever and nut P are lowered the shaft X and cylin- 60

der A can be slipped endwise.

The arm 5, carrying the diaphragm b, should be pivoted at 7.7 by pointed screws, so as to adjust the position of the recording-point of the diaphragm b relatively to the grooves of 65 the cylinder. The screw 8 determines the position to which the diaphragm and recording-point may approach to the cylinder. The spring 9 serves to move the arm 5 away from the cylinder, and the double-ended locking-70 piece 10, entering slots in the frame 11, holds the arm in place when in use.

One of the peculiarities of the present invention over the aforesaid patent is a spring, 12, of india rubber or other suitable material, 75 placed between the cross-bar or bridge 13 and the diaphragm, that serves as a damper to prevent false vibrations of the diaphragm, and cause it to respond only to the actual movement given by the phonogram through the 80 point D. It is also usually preferable to employ a spring, 14, between the point and the diaphragm. This is useful, in both the phonograph and the phonet, to prevent false sounds. This spring and diaphragm I have used in 85 connection with telephones. I do not, therefore, herein lay claim to the same, broadly. I have combined the same with the recording or phonet point and the phonogram.

Another feature of invention relates to a lever between the diaphragm and the phonogram, whereby the relative movements of the parts may be varied. This lever s has a fulcrum at 15. If the connection to the diaphragm is between the point D and fulcrum 15, as in 95 Fig. 5, then the motion of the point will be greater than the diaphragm, and when used in the phonograph will amplify the indentations

in the foil. If used in the phonet, the movement of the diaphragm would be leasened. I therefore prefer, in that instrument, to change the places of the point and diaphragm connec-5 tion, as shown in Fig. 6, so as to amplify the movement of the diaphragm and increase the sound.

Another feature of my present invention relates to the foil-holder, which I place on a reel 10 within the cylinder A, and draw the same out through a slot, as required from time to time, thus preserving the foil from injury and rendering it unnecessary to handle the same.

The reel I within the cylinder A is adapted 15 to receive the foil in a roll upon it. One head of the cylinder is removable, so as to allow of the insertion or withdrawal of the reel. There is a slot in the cylinder, through which the foil is brought out, and there is a bar, o, form-20 ing part of the periphery of the cylinder, that is connected at its ends to the alides o', (see Fig. 7,) one at each end of the cylinder, and there is a lever-bar, x, behind this slide-bar o. When the slide o' is drawn back from over the 25 lever x, such levercan be awang out of the slot in the cylinder A, and the foil can be drawn out of the alot and wrapped around the cylinder, and then the end is placed behind the bar s, and carried by it into the slot of the cylin-30 der, and then the slide o' is moved so that its edge passes over the lever z, and in so doing the foil is tightened around the cylinder and the lever x held in place. The surface of this cylinder is made with a helical groove, and 35 the rim s of the cylinder is made with a similar screw or groove, and the sliding sleeve t, that carries the diaphragm-arm, has a screwsurface at 25, that comes into contact with the BOTOW &.

With this character of instrument it is preferable to have the cylinder A upon a vertical shaft, and the sleeve t and diaphragm will be moved vertically. For this purpose the fixed stud 28 is vertical, and upon it is a tube, 29, 45 of a size to receive the sleeve t, and having a groove and key, by which the sleeve t is allowed to slide endwise of the tube 29; but the two can be turned together on the stud or shaft 28. An arm, 39, on the tube 29, and a spring, serve to turn the tube, the sleeve, and the diaphragm and arm with sufficient force to bring the point D to bear upon the foil with the required force.

It is preferable to employ with the diaphragm a tube, t, and month-piece of, such tube being flexible.

The speaking into and recording of the sounds in the phonograph will be proceeded with as usual, and the reproduction of the shaft, and the sleeve t and disphragm will be

with as usual, and the reproduction of the 60 sounds will be as before; but in case the operator wants to suspend the recording in the phonograph or the speaking in the phonet he simply has to draw upon the flexible tube, which swings the parts so as to disconnect the and so screw-rack from the flange s of the cylinder. forth.

This at the same time moves away the recording or the phonet point. The cylinder A can continue to revolve, and when the operator is ready he releases the pull upon the flexible tube, and the parts commence to act again at the exact place where the operation was suspended, because the screw-threads will only drop together when the proper part of the thread s comes to the corresponding part on the rack 25.

I employ the cam 33 and its lever upon the sleeve t to act upon the tube 20 and prevent the sleeve falling when the screw-threads are disconnected. This cam-lever 33 is self-acting, and it has to be raised when the sleeve t is to be lowered, so as to recommence at one end of the cylinder A.

By simply turning the sleeve and moving the diaphragm and the screw-surface back, the sleeve and diaphragm can be slipped endwise to any desired place upon the cylinder A to receive or deliver sounds.

I am aware that fly-wheels are employed in namerous ways for equalizing the speed of machinery. I do not claim the same, broadly. In experimenting with my phonograph I discovered that the reproduction of the sound was imperfect if the slightest variation occurred in the speed; hence the combination with the cylinder of a very heavy fly-wheel in proportion to the cylinder rendered perfect and reliable the action of the instrument in receiving and reproducing the sound by equalizing the speed.

I claim as my invention-

1. The combination, with the phonograph cylinder, shaft, and screw-surface, of a swinging nut or screw-surface, to connect or disconnect the parts that keep the recording or phonet point in position relative to the groove of the cylinder, substantially as set forth.

2. In combination with foil or a sound-recording surface, a point, a diaphragm, and a spring or damper acting to press the diaphragm toward the point, substantially as set

3. In combination with a foil or sound-recording surface, a point, a diaphragm, and a spring between the point and the diaphragm, substantially as set forth.

4. The combination, in a phonograph or phenet, of a diaphragm, a point, and a lever intervening between the diaphragm and the

point, substantially as set forth.

5. The combination, with the spirally-grooved cylinder in a phonograph, of a reel within the cylinder carrying the foil or similar recording material, a slot in the cylinder, through which the foil is led out, and means for clamping the foil, substantially as set forth.

6. The combination, with the cylinder A, of the sliding bar o and lever x, to clamp the foil and stretch the same, substantially as set 7. The swinging sleeve t, having an arm that carries the diaphragm, in combination with the cylinder A, and rim s, having a screw-thread surface, substantially as set

8. The tube 29 upon the fixed stud 28, in combination with the sliding sleeve t, the dia-

phragm, and the cylinder A. substantially as described and shown.

Signed by me this 19th day of March, 1879.

THOMAS A. EDISON.

Witnesses:

S. L. GRIFFIN, WM. CARMAN.

(No Model.)

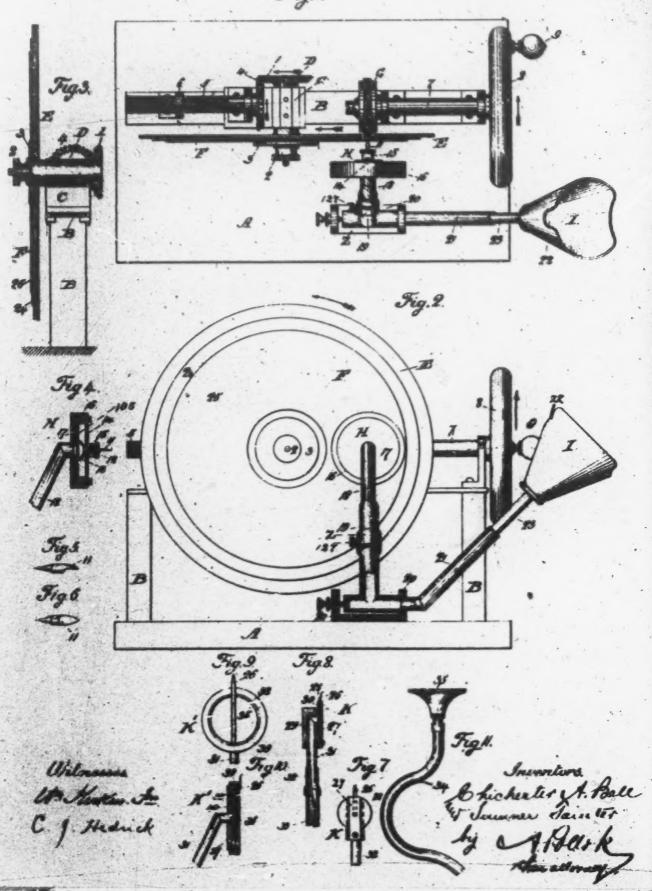
C. A. BELL & S. TAINTER.

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RECORDING AND REPRODUCING SPEECH AND OTHER SOUNDS.

No. 341,214. Patented May 4, 1886.

Fig. 1.



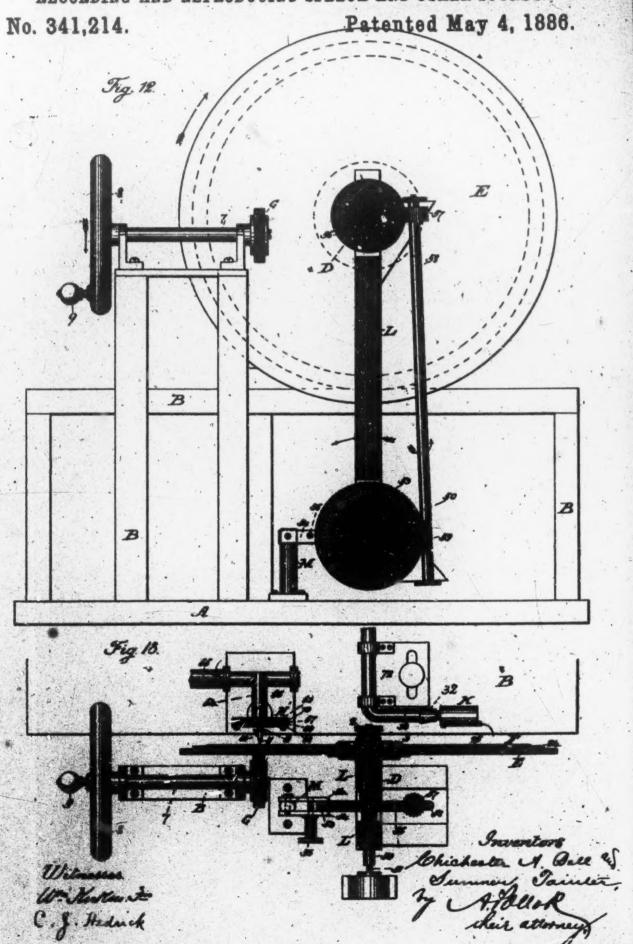
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RECORDING AND REPRODUCING SPEECH AND OTHER SOUNDS.



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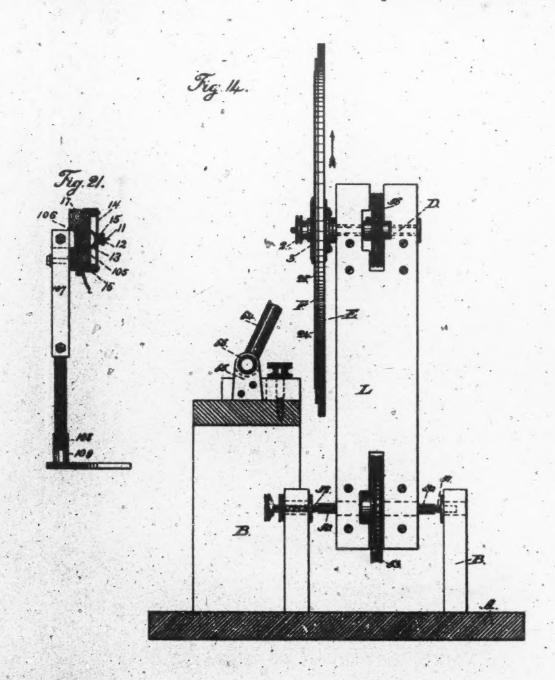
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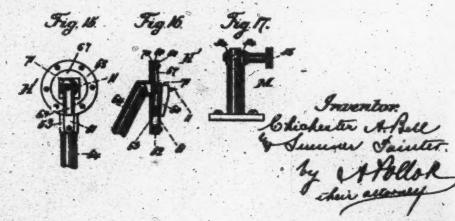
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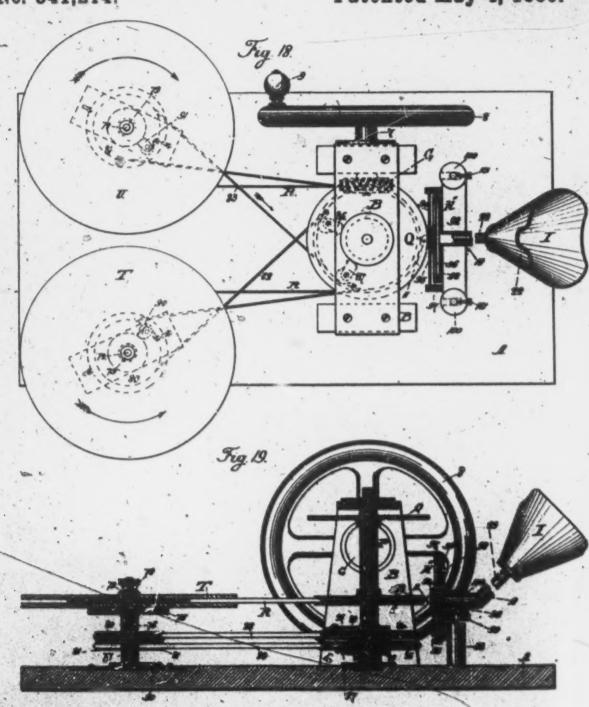
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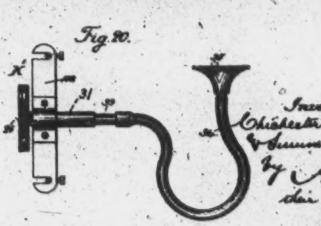
C. A. BELL & S. TAINTER.

RECORDING AND REPRODUCING SPEECH AND OTHER SOUNDS.

No. 341,214.

Patented May 4, 1886.





### UNITED STATES PATENT O

#### OHIOHEET PROPERTY AND THE PARTY OF THE PARTY

#### RECORDING AND REPRODUCING SPEECH AND OTHER BOUNDS.

SPECIFICATION forming part of Letters Papent Mt. Sal, 216, dened 10.

Application fied June 27, 1888. Beried No. 179,848. (No me

To all whom it may concerns

Be it known that we, Calculating A. Bell. and SUMMER TAINTER, both of Washington, in the District of Columbia, have invented a new and useful Improvement in Recording and Reproducing Speech and other Sounds, which improvement is fully set forth in the following specification.

This invention relates to the formation, in a solid substance, of elevations and depressions, or other inequalities corresponding more or less perfectly to the forms of sound-vibrations, and the reproduction, by means of such inequalities, of the sounds represented by them.

The invention consists, first, in the formation of the record or "phonogram," as it has been called, by means of a cutting style which is vibrated by the sound-waves or sonorous vibraand Summer Tainter, both of Washington,

brated by the sound-waves or sonorous vibra-tions to be recorded. The vibrations may be im-so pressed upon the style directly by the impact of the sound-waves upon some device mechanically connected with or carried by the cuttingstyle or its support, or indirectly through the action of an electric current or other suitable 25 vibratory medium. Heretofore a large number of contrivances have been devised for converting electrical impulses into mechanical vibrations, and they could, of course, be used for vibrating the entting style. Otherwise so they have no relation to this part of the present invention, the genential new feature of which is the removal of material to form the record by a cutting, gouging, or graving action of the vibrating style. Heretofore the vibrating style has, as in Edison's well-known phonograph, simply indented the recording material. It has been proposed to cut the record in the edge of astrip of metal or other solid material by vibrating the strip in contact with the entting edge of a rotary disk entter; but this proposal is essentially different from this invention, the new mode being applicable to cutting
the record upon all sorts of surfaces, and not
upon strips only, and is, besides, believed to be
the interest of the than this invention. Under this part of the invention are included the vibratory cutting style as a new device in a sound-re-corder, and the combination of the same with other devices; also the cut or engraved record to itself. In this new or improved form of record only may a larger number of words or bunds be recorded in a given surface than has

heen practicable with the indented records heretofere in use, but the recorded vibrations are also sharper and better defined. It is found that at indenting myle smooths over the treats of the larger citevations, and also rubs out some of the finer case.

The invention consists, assembly, in engraving or cutting the record is a waxy or amorphous, and alightly colossive substance. Preferably, a compound of bearrax and paraffine (the latter in excess) is employed. This compound has no tendency to dog the style, but a readily removed thereby in chips or shavings. This part of the invention also consists in a recording material composed of a wax or waxy surface on a paper or pasteboard foundation. Heretofore it has been proposed to use soft paper esturated or posted with paraffine as the material for recording by the indenting method; but its use does not appear to have been successful, and an outer layer of tin-foil was therefore employed to receive the indentations.

The inventions

The invention consists, thirdly, in cutting or engraving the record is the form of a groove with sloping walls, the sound-waves being represented by elevations and depressions at the bottom of the groupe or otherwise. 80 The advantage of this form of record is that it forms an efficient guide to the reproducingstyle.

The invention consists, fourthly, in loosely mounting the reproducing tyle so that it can 85 readily be guided by the record. Preferably the reproducing style, or ather what may be called the "head" of the reproducing instrument is mounted on an universal joint, and the style is pressed against the record by 90 the yielding pressure of a spring or weight. Practically in the instruments made by us the pressure is due to the weight of the instrument, modified by the disticity of a section of soft-rubber tube, which supports the os strument, modified by the disticity of a section of soft-rubber tube, which supports the 95 same and constitutes a universal joint; but evidently there are many devices which can be used to mount the reproducer, so that it is free to follow the sound record or phonogram, and which, therefore, would be within the 100 spirit of the invention. The reproducing style, mounted as just explained; in specially adapted for use in connection with a record in the form of a groove with sloping walls, and this form of a groove with sloping walls, and this

combination is specially claimed; but it may also be usefully employed in connection with

other forms of record.

The invention consists, fifthly, in reproduc-5 ing directly from the wax record. It is found that such a record has sufficient strength to withstand the rubbing action of the reproducing style, so that a considerable number of reproductions can be obtained from it. The smoothness of the wax gives it a great advantage in this regard. So far as we are aware, no one has reproduced sounds from a wax record by rubbing a style or reproducer over it.

The invention consists, sixthly, in a reproducer or reproducing instrument in which the reproducing style, instead of being placed behind its support, projects at the point beyond the edge thereof. One practical advantage of this is that it enables the position of the style on the record or phonogram readily to be ob-

The invention consists, seventhly, in cutting the sound-record in a fusible material, (the waxy compound before referred to, for example,) and then melting the surface alightly, so as to remove any roughness left by the cutting-style. These roughnessesses altogether outside of the sound-vibrations, and give rise in reproducing to scraping noises, which interfere with the intelligibility of the sounds reproduced. These scraping noises are greater with some other modes of reproducing which we have devised, and which will form the subject of other patents, than they are with a rubbing other patents, than they are with a rubbing style; but even with the latter the additional smoothness given to the surface by the partial fusion has a

fusion has some advantage.

The invention consists aighthly, in a sound-recorder having a cutting or graving style o which is held by clustin or yielding pressure against the surface on which the record is to be made. The object is to enable the vibratory graver or cutting style to ride over in stead of plowing through any elevations on the recording surface. The depth to which the point of the cutting style is embedded in the record affects the map litude of the style's vibration. By this improvement the depth is kept uniform, notwithstanding any slight unng any alight onkept uniform, not with small jo evenues of the restanting on

singly to having The inve

hollow sound conveying standard, the same s explained with respect to the recorder, au in similarly connecting the hollow standard 70 of the reproducer with an exterior sound

conveying tube.

The invention consists, eleventhly, in com-bining with the recorder a mouth piece so shaped as to include the nose of the user. It 75 is found desirable to concentrate the soundwaves as much as possible upon the recording instrument or style, and if an ordinary mouthpiece be used the sound reproduced from the record is imperfect in the usual elements, and 80 sounds somewhat like the speech of a person with a cold in his head. By the use of the improved mouth piece this disagreeable quality of the reproduced sound is avoided.

The invention consists, twelfthly, in a re- 8; producer in which the sonorous vibrations impressed by the record upon the style are by the latter communicated to a block, plate, or other body of hard rubber, and through mid body are transmitted to the air or to other vi- 90 bratory medium. It is found that this material (hard rubber) gives much purer sounds than metal and other substances heretofore It appears to absorb minute viemployed. brations which give rise to scrutching noises, 95 and also to communicate sonorous vibrations without at the same time adding any foreign vibrations due to the movements of its own particles among themselves. The result is probably due to the high elasticity and the 100

omogeneity of hard rubber.

The invention consists, thirteenthly, in combining with the disk of a recording and reproducing apparatus, in which the record is formed on the face of said disk in a volute or 105 spiral by entting or otherwise by any known or sultable means mechanism for giving to said disk a uniform surface-speed under the recorder. Herstofore when the record was formed on the face of a disk the latter has me been given a uniform rotation, so that the same number of words were recorded in the outermost circles, as in the smaller inner ones.
By giving to the disk a uniform surface speed under the recorder, or by making the times 115 of each rotation inversely proportional to the distance of the recorder from the center of the sk, the record of any given word or sound will be of the same length at whatever part of the disk it may be, and in this way it is 120 possible considerably to increase the number

possible considerably to increase the number of words or sounds on a given area.

The invention further comprises certain special constructions, combinations, and arrangements of parts, as hereinalter set forth. Having now explained the principle of the invention, the manner in which the same is or may be applied will now be explained with reference to the accompanying drawings, which make part of this specification.

Figure 1 is a plan view of an apparatus constructed in accordance with the invention, arranged for recording; Figs. 2 and 3, respectively, a front elevation and cross-section of

ively, a front elevation and cross-section of

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the same; Fig. 4. The in section and cleve. The by invaling the color of the secondary state of of the secondar

er yn Grandens, referenderskap fan er fan en en fa

tion; Fig. 15, a plan party in section; Fig. 15 as edge view, partly in section; Figs. 15 and 16, views involvention and section of the recorder, and Fig. 17 as dge view of a free recorder, and 19 are plan and longitudinal sections.

Figs. 18 and 19 are plan and longitudinal sections.

tions, respectively, of a form of apparatus also constructed in accordance with the inven-

tion, or with parts thereof in which the record
is made on a strip, and Fig. 20 a plan, partly
in section, of the reproducer for use with such
apparatus. Fig. 21 is a view of a recorder in
which the style is operated electrically.

Referring to Figs. 1 to 11, A is the base or 25 bed of the apparatus, and Ban upright frame, which carries the mechanism for supporting and moving the tablet F, (shown as a disk,) on which the record is to be or has been formed. In the slide C, movable in ways of the frame B, is journaled an arbor, D, on which are fixed a metal disk, E, at one end and a bevelgear, 1, at the other. The arbor projects be-yond the metal disk E, so as to form a support for the recording-tablet F, which is retained thereon by the nut 2 and washer 3. The metal disk E performs the double function of

a friction-wheel and of a backing to the recording-tablet F. The bevel-gear 1 engages a similar gear, 4, on the end of the screw 5, which is 40 journaled in a bearing to the slide C, and is tapped through a stationary lug, 6, on the frame B. As the arbor D is revolved, the screw 5 is turned also, and in consequence of

its engagement with the lug 6 it moves the 45 slide C lengthwise of the frame B. The rotation is communicated to the arbor from the shaft 7, journaled in bearings of the frame B, and provided at one end with a, fly-wheel, 8, and provided at one end with a hy-wheel, and crank-handle 9, and at the other with a friction-pinion, G. This pinion is formed, as shown, of rubber disks clamped together botween metal washers. It bears against the back of metal disk R, and communicates moback of metal disk R, and communicates moback of metal disk R.

tion to it. As the slide C is moved by the 55 action of the screw 5, the metal disk E is carried past the friction-pinion, so that it touches the metal disk in aspiral line, and serves to give a uniform surface speed to each part of the disk

a uniform surface spiced to each part of the disk
as it in turn comes opposite said pinion. The
for recorder H in placed on the opposite side of
the metal disk E, preferably as shown, with
the point of the graver or cutting style 11
directly opposite the point where the pinion G touches the disk H. The said pinion
thus acts as a support to the disk against
the action of the cutting or recording style.
The latter is preferably formed of a round

ple. A sound convey in the late of the back place, 17 the many bind the cop 12. A discharge quitable material, whose signs are behind the cup 18, which is present against oc mid diaphragm by the sharking of cross piece 14. The cup 13 and block is serve to com-municate the vibrations from the diaphragm to the recording style.

The tabe 18 forms part of a bollow standard. 95 upon which the recorder is mounted. The lower part, 19, of this standard is hinged in the bracket 20, as clearly shown in Fig. 2, so that it can be recked to bring the recorder into or put it out of action.

On the tube or standard 18 is a ring weight,

Z, which is retained in position by a set-acrew,

127. It therefore can be situated up or down,
in order to increase or diminish the pressure
of the style 11 against the tablet F. The use
of this weight is desirable, but not necessary.

The tube 21 communicates with the interior
of the hollow standard through the hinge, and
does not therefore interfers with its freedom
of motion. This tube 21 case he fixed in the 110
bracket or can be allowed to lurn, as may be
preferred.

The mouth-piece I is shaped to fit the face of the user, and is provided with a notch, 22, to receive the nose. It is attached to the tube 115
23, which at its lower end fits snugly in the tube 21 and communicates through the series of tubes 25, 21, 19, and 18 with the space inside

of tubes \$3, 31. 19, and 18 with the space inside and back of the cup 13.

In operation the recorder mets by its own 120 weight, assisted by the pressure of weight Z, or by its own weight alone, if preferred, against the recording-tablet F, said weight causing the style to embed itself to the proper extent in the recording material. The sonorous vibrations impressed upon the style are so rapid, as well as so minute, that the record is made as perfectly as if the recorder were held positively, while at the same time the recorder can be moved hodily to conform to the unevenness 130 of the surface of the tablet, and thus keep uniof the surface of the tablet, and thus keep uni-

form the depth at which the style operates.

The tablet F consists of a paper or pasteboard foundation, 24, with a coating, 25, of wax. A composition excellently adapted to the purpose, and according to our experience the best, consists of one part, by weight, of white becawax and two parts of paraffine. The two bodies are meited together, and if not perfectly free from dirt and grit should be fittered. A filtration through cotton-wool will answer. The coating is or may be about one-twentieth of an inch in thickness, (the paper being one-tenth of an inch, more or icm.) and can be made by flowing the melted composition over the paper disk or foundation. The surface is preferably turned off flat on a lather

can be made by flowing the melted composition over the paper disk or foundation. The
surface is preferably turned off flat on a lathe.
In order to place the tablet in the machine,
the recorder H is turned back out of the way.
When the tablet has been secured in place, the
recorder is turned forward into the position
shown, the style resting against and slightly
penetrating the wax coating. Apenetration
of one one-hundr with of an inch has been found
very effective, the style being formed of No.
16 wire-shaped at the cutting end as in Figs.
5 and 6. Upon turning the fly-wheel 8 the
disk E and tablet F will be turned, and the
style 11 will cut or engrave a spiral line in
the wax coating of the tablet. If one talks
into the mouth-piece I, the style will be
thrown into vibrations corresponding to the
spoken words, and the engraved line will be
of varying character, the inequalities or variations from uniformity representing the forms
of the sound-waves.

The reproducer K, (shows in Figs. 7 and 8,) for reproducing from the engraved tablet, or from other satisable record the sounds which formed said records, has a reproducing style, 20, formed of a marrow metal strip bent near the end, as shown in Fig. 8, and pointed, as shown in Fig. 7. This style is held by contrip 27 and the circular plate 28, both preferably of hard rabber. The strip 27 is hetered at the bottom to an other on the block 20, in which a passage formed for the cound-the plate 28. There is a fixed disk, 20, of the mans slot us the werealds plate 28. It is computed or otherwise factoried on the face of the block, and is perfected at the species. The plate 28 is always to be the act in contact with the disk. The tabout, fixed at the upper end to the block 20, is jointed at the overcond to the tabout 20 perfected at the upper end to the block. The tabout, fixed at the upper end to the block 20, is jointed at the lower and to the tabout this tabout. The face of all facilities in the tabout of the tabout with the tabout 20 perfected at the overcond to the tabout the tabout 10 in the measure shows for the min the tabout 10 in the measure shows for the min the tabout 10 in the measure shows for the min the tabout 10 in the measure shows for the min the tabout 10 in the measure shows for the min the tabout 10 in the measure.

This regarded to the style will of their grant

There exists always a liability to disarrangement in some part of the machine either in the recorder or the support therefor is the recording tablet or its support, or if there be no disarrangement it would be difficult to insure that the reproducing type should touch the reproducer be held rigidly. Difficulties on these accounts are avoided by the loose or flexible mounting of the reproducer, the style automatically adjusting itself to the proper place on the record. It will be seen that the reproducer is mounted on a universal joint, so that it can move in any direction. The movement parallel with the face of the tablet would, however, by itself allow the style to follow and adjust itself to the record to a useful extent.

In operation the reproducer K is placed against the record, and on turning the whoel 8 in the same direction and at about the same speed that it was turned in recording, the rec-ord will move the style 26 and plate 28, so as to throw the air in the hollow standard into vibrations, and produce sound-waves similar to those which originally acted upon the rec-ording style to make the record. The reproduced sounds are audible by placing the car in proximity to the mouth-piece I; but it is preferred to withdraw said mouth-piece, and to connect the flexible tube 34 (see Fig. 11) rith the tube 21 and listen at the ear-piece 35. After the record has been out it will of course be understood that the machine is turned back to the starting point for reproducing. The surface of the cut record can be rendered more smooth by removing the engraved tables from the marking and arrested the marking arrested to the mar ot from the machine and exposing the surface o heat—as, for example, by rotating the tab-st-face downward over an alcohol-lamp until ce begins to glisten. Of course a too mare would destroy the record. It ce action that is required. mild for reproducing with-this operation and withrd can be m ting it to this operation and the ting it to the machine. It may, ving it from the machine. It may, be removed, and at any time there-laced on the same or a similar mai be m ade to reproduce the original

The reproducer K' (shown in Figs. 9 and 16) has the style 26 attached to the outer of two light plates. 25 and 37, which are attached to a disphragm, 28, of this shoot rubber clamped at the edges between the ring 39 and the border of the back plate, 40. The tube 21 is featured in the back plate.

Is will be observed that in both forms of reproducer the style 26 projects beyond the edge or end of the instrument, so that the position of he point on the record can be easily seen.

Believing cow to Pigs. 12 to 17, A is the bad. B as appright frame, D as arbor, B a material disk, F the inbiet, and G a friction-pinion, as in Pigs. 1 to 11. The nut 2 and washer 3, the shaft f, wheel 5, and crunk 9, and the paper disk 24 and wax coating 25 are identical with the parts similarly numbered in Pigs. 1,

2, and 3. The arbor D. ins

shaft is rotated. As the tablet F are rotated, the shaft 58, and consequences being held stationary

being held stationary by the clamp L is swung gradually to one side, a corder engraves a spiral line on s of the tablet. When the record is it is only necessary, in order to tablet to the station. 25 tablet to the starting point for repredraw back the recorder and to loo M, when arm L can be moved at on

proper position.

A recorder constructed and mounted prein this machine; but, as abown, the recordinginstrument H' is modified to some extent.

The outling-style 11 (which is the same as that of Figs. 4 to 6) is set into a block, 60, carri 35 a metal strip, 61. This is fastened to a 62, at the lower end of a back pie

is attached to the upper end of the tube 6 which forms the hollow standard for the recorder, and which is mounted on the brack 40 65, so as to be capable of being turned to pe the record into or out of action. The sound conveying tabe 66 corresponding to tabe Figs. 1 and 2 communicates through the b with the interior of the tabe 64. In fre

45 the opening at the upper end of stretched a disphragus, 67, of this a or it may be of other membrane o d of tube 64 or it may be of other membrane or me its edges being clamped between the r and hage piece, 65, and rubber rings 6 70 being interposed one on such side

and hage present one on man and the street of the street of the street of the street of metal cupped in the center, is held as of metal cupped in the pressure of the street of metal cupped in the pressure of the street of the the displaying by the pressure of the strip 61, a projection on the back of said strip bearing against the said plate 71.

In this mor shine the reproducer K, instead of being mounted on the same bracket as the recorder when the latter has been removed, is entried by a separate bracket, 72, the tube 83 being hinged thereto, so that the recorder and reproducer remain, or may remain, always at-tached to the machine, it only being necessary to turn one or the other into position, as may 65 be required.

ed. Thus when left the real U is isdicated by the ars stretched at all 105 on depending upon a 76. The recorder H" is cal-a 76. The recorder H" is cal-a piece, 92, supported by posts a 11 is carried by a cross-piece, 110 is is attached by means of the 4 rubber, which forms a nut on ard rubber, which forms a nut on breaded shank of the style, and against a mice disphragm, 96, the back plate BS. The table 2115 ring 97 and the back plate, 98. The tube 18, sprewed into the back plate, is fastened by soldaring or otherwise to the cross-piece 92. The tube 25 of the month-piece I fits into said tube 18. The ends of the cross-piece 92 are 120 slotted to fit around the series at the top of posts 93 and rest upon puts 19, and are clamped by nuts 100. By means of these nuts the vertical position of the manufactor can be adjusted. by note 100. By means of these nuts the vertical position of the recorder can be adjusted.

After one line has been sugraved on the strip,
the recorder can be adjusted to engrave as
many additional lines parallel thereto as the
strip will receive. The state in the cross-piece
22 allow the recorder to be moved toward and away from the strip, so m to regulate the 130 depth of the engraved line. To insure a Referring to Figs. 18 to 20, A is the base or | greater nicety of adjustment, screws 101 are

that shown in Figs. 9 and 10, except that the style 26 is so placed that the point is at the center instead of projecting beyond the edge of the instrument. Its position on the record is therefore not so readily seen; but with the form of machine shown in these figures this is 'as important. The same may be said of the loose mounting of the reproducer, although in point of fact the this rubber disphragm 38 gives a certain lateral play to the style. The tube 61 is rigidly fastened to a cross-piece, 102, identical with the cross-piece 92, and with said tube 31 the bearing-tube 30 and car-piece 35 are connected.

The paper strip can be easily coated with the beeswax and paradine compound by running the same through a body of melted composition and scraping one side, leaving what adheres to the other to harden thereon.

In Fig. 21 an arrangement for operating the marred, 107 is marred, and its shown. The

25 recorder by electro-magnetism is shown. The magnet 107 is mounted on a har, 106, journaled in bearings in standards 100. It is provided with a bobbin, 106, of wire, surrounding the pole-piece, which bobbin is included in a circuit-over which electrical undulations are caused to pass, by any suitable transmitting-instrument—for example, such as commonly employed on telephone-lines. In front of the pole-piece or care of the bobbin is a diaphragm, 106, of magnetic material, whose edges are clamped between the ring 16 and back plate, 17. The cap 18 should always be in contact with diaphragm 106, and is pressed against it by the spring of piece 14. This cup, as well as the style 11, block 12, but 16, and cross-piece 14, is the same as in the recorder H of Figs. 1 and 4.

It is evident that various modifications other than those indicated can be made and the in-

and one to made and the in-maligned in whole or in part, and to invention may be

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tapped through the metal at the crossed and of the slots, and bear at the point against the phragus, for example.)

The reproducer K', Fig. 20, is similar to that shows in Pice A.

to indicate an action in which the material is recoved in chips, shavings, or other small places—as in engreving, turning, and the like—and not simply displaced.

The displacement of the material is not only 75 a different operation from the cutting contemplated by this invention, but is not calculated to accomplish the objects for which cutting or graving is employed.

Having now fully described our said invention and the manner in which the same is or

Having now fully described our said invention and the manner in which the same is or
may be carried into effect, what we claim is—

1. The method of forming a record of sounds
by impressing sonorous vibrations upon a
style, and thereby cutting in a solid body the 85
record corresponding in form to the soundwaves, in contradictinction to the formation
of sound-records by indenting a foll with a vihystory style, or entities a style by vibrating

of sound-records by indenting a foll with a vibratory style, or entting a strip by vibrating it against a revolving disk outer, substantially as described.

2. The method of forming a sound-record by impressing the sonorous vibrations upon a style in a direction at right angles to the recording-surface, and thereby cutting in a solid body a series of elevations and depressions of varying depth, corresponding in form to the sound-waves, substantially as described.

3. The vibratory cutting-style of a sound-recorder, substantially as described.

4. The cutting-style, in combination with a support permitting the same to be vibrated, and means for impressing sonorous vibrations thereon, substantially as described.

5. A vibratory cutting style, in combination with a sound-conveying tube for concentrating the sound-waves upon the style, substantially as described.

se described.

6. A vibratory outling style, in combination with a tablet or other solid body in which the 110 record is to be out, and mechanism for supporting the same and moving it with reference to the said style, substantially as described.

7. A nound-record consisting of a tablet or

aving its surface out or on- 115 wing its surface out or on- 115 witnes of irregular or va-ading to sound waves, sub-

nelating of a tablet or oe cut or angraved 120 or veriations corre-sound-waves, scholar-

forming around or speech into in origraving or culting or a wax-like composition, eh 125

special record out or en-na like composition, sub- 130

ng-tables of a phonograph or mockine, having as the me-

the same and pared

tions the composition of bearwax and parafine, substantially at described.

12. The sound or speech record out or sa graved in a wax like composition, such as the compound of belowax and parafine, as below.

5 compound of belowax and paraffine, anhatantially as described.

13. A tablet or body for recording nound-vibrations, consisting of a paper or parabhased foundation and a surface conting of beeswax no and paraffine compound, substantially as described.

14. The sound of speech record out or engraved in a wax-like composition, such as the described compound of beawax and paraffine, constituting a surface-coating to a paper or panteboard foundation, substantially as described. soribed.

scribed.

15. The method of making a sound or speech record which consists in engraving or cutting in the recording material an irregular groove with sloping walls, the shape of the groove representing the sound-vibrations, substantially as described.

16. The method of making a sound or speech record which consists in cutting in the recording material a groove with sloping walls and of variable cross-section, the variations corresponding in form to sound-waves, substantially as described.

30 17. The sound-record in the form of an irregular groove with sloping walls cut in solid material, substantially as described.

18. The sound-record cut in war or warlike composition in the form of an irregular groove with sloping walls, substantially as described.

ieribon.

19. The combination, with a reproducing tyle, of a mounting therefor, which leaves mid tyle-face to move interally, and thereby adjust itself automatically to a nound-record, substantially as described.

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having a r t itself to the groove;

with the tables or o renerd formed the with eleping walk atyle for rebiting (

mation, with a sound-record c a wax-like material, of a re-probbing style for receiving out from said record, substanmaterial, of a re-

30. The sound-recorder buring a vibratory enting-style hold against the recording moto-rial by yielding pressure, substantially at de-. Th and the stelly as de-

need having a vi- 95

The o be music, of I on a hinged at the tablet,

a hollow arm

105

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apen a hollow actroyer, sub-

ted on a hinged conveyer exarm, substantially

sould-conveyor ex-arm and conveyed 125

with a sound-record-laped to surround the nor, and to succentrate coording devices, subcentrate 130

abiantion, with the tablet, in the 25. A reproducer having a style projecting form of a disk, and a recorder or reproducer,

of mechanism for eausing a spiral line to be traced on the disk by the recorder or reproducer at a holform surface speed, substan-

tially as described.

41. The combination, with the tablet, in the form of a disk, the arbor, and the metal disk operating as a friction wheel, of the slide, or its equivalent, such as herein shown, in which said arbor is journaled, and the friction-pinion 10 for revolving said disk, substantially as de-

42. The combination, with the recogler or the reproducer, the disk, the arbor, and the laterally movable support to the arbor, of the fric-15 tion-plnion placed behind and bearing against the disk at a point opposite the recorder or reproducer, substantially as described.

43. The combination, with a recording style and the support therefor, of a cup on the back 20 of said support, and the sound-conveying tube terminating just behind the cup, substantially

as described.

44. In combination with the style of a sound reproducer, a vibratory body or plate of hard rubber, upon which vibrations are impressed by said style, and through which they are transmitted, substantially as described.

45. A tablet provided with a wax or wax. like coating, and having engraved in said cost ing a spiral line with inequalities or irregularities corresponding in form to sound waves

substantially as described.

46. A tablet provided with a coating of war or wax-like composition, and baving a sound record engraved in said coating, said engraved? coating having the glazed surface which results from an incipient fusion of the wax after cutting or engraving the record, substantially as described.

47. In combination with a sound-recorder, a flaring mouth piece shaped to fit over the face of the user and to include his nose, and communicating through a tube or contracted opening with the space behind the diaphragm of said recorder, substantially as described.

In testimony whereof we have signed this specification in presence of two subscribing

witnesses.

CHICHESTER A. BELL. SUMNER TAINTER.

Witnesses:

PHILIP MAURO, C. J. HEDRICK.

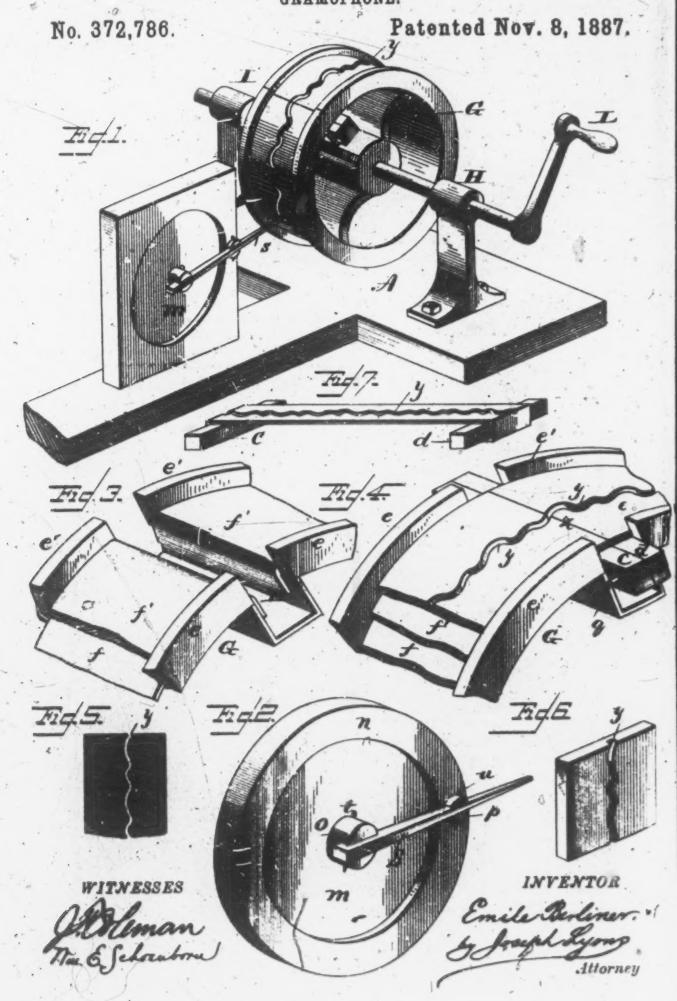
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PAGE

(No Model.)

### E. BERLINER.

GRAMOPHONE.



### UNITED STATES PATENT OFFICE.

EMILE BERLINER, OF WASHINGTON, DISTRICT OF COLUMBIA.

#### GRAMOPHONE.

SPECIPICATION forming part of Letters Patent No. 372,786, dated November 8, 1867.

Original application filed May 4, 1697, Serial No. 227,588. Divided and this application filed September 25, 1687. Serial No. 250,721, (No model.)

To all whom it may concerns

Be it known that I, RMILE BERLINEE, a citizen of the United States, residing at Washington, in the District of Columbia, have invented certain new and useful Improvements in Gramophones, of which the following is a specification.

This invention has reference to a novel method of and apparatus for recording and reproducing all kinds of sounds, including spoken words, and is designed to overcome the defects inherent in that art as now practiced and in the apparatus used therefor.

By the ordinary method of recording spoken words or other sounds for reproduction it is attempted to cause a stylus attached to a victory displacement industry.

bratory diaphragm to indent's traveling sheet of tin fell or other like substance to a depth varying in accordance with the amplitudes of the sound-waves to be recorded. This attempt is necessarily more or less ineffective, for the reason that the force of a disphragm vibrating under the impact of sound-waves is very week, and that in the act of overcoming the resistance of the tin-foil or other material the vibrations of the diaphragm are not only weakened, but are also modified. Thus while the record contains as many undulations as the sounds which produce it, and in the same order of auccession, the character of the recorded undulations is more or less different from those of the sounds uttered against the diaphragm.
There is, then, a true record of the pitch, but a distorted record of the quality of the sounds obtained. The simple statement that the material upon which the record is made resists the movement of the disphragm is not sufficient to explain the distortion of the character of the undulations, for if that resistance were uniform, or even proportional to the displacement of the stylus, the record would be simply weakened, but not distorted; but it is a fact that the resistance of any material to indentation increases faster than the depth of indentation, so that a vibration of greater amplitude of the stylus meets with a disproportionately greater resistance than a vibration of smaller amplitude. For this reason lond sounds are even less accurately recorded than faint sounds, and the individual voice of a loud speaker recorded and then reproduced by the phonograph cannot be recognized. With a view of

overcoming this defect it has been attempted to engrave instead of indent a record of the vibrations of the diaphragm by employing a stylus shaped and operating like a chisel upon a suitably-prepared surface; but even in this case the disturbing causes above referred to are still present. In addition to this, if in the apparatus of the phonograph or graphophone 6 type it is attempted to avoid the disturbing influence of the increase of resistance of the record-surface with the depth of indentation or cut as much as possible by primarily adjusting the stylus so as to touch the record-6 surface only lightly, then another disturbing influence is brought into existence by the fact that with such adjustment, when the diaphragm moves outwardly, the stylus will leave the record-surface entirely, so that part of each 7 vibration will not be recorded at all. This is more particularly the case when loud sounds are recorded, and it manifests itself in the reproduction, which then yields quite unintelligible sounds.

It is the object of my invention to overcome these difficulties by recording spoken words or other sounds without perceptible friction between the recording surface and the recording stylus, and by maintaining the unavoid- 8 sble friction uniform for all vibrations of the diaphragm. The record thus obtained, almost frictionless, I copy in a solid resisting material by any of the methods hereinafter described, and I employ such copy of the origi- 8 nal record for the reproduction of the recorded

Instead of moving the recording stylus at right angles to and against the record-surface, I cause the same to move under the influence of sound-waves parallel with and barely in contact with such surface, which latter is covered with a layer of any material that offers a minimum resistance to the action of a stylus operating to displace the same, all substantially in 9the manner of the well-known phonautograph by Leon Scott. All this will more fully appear from the following detailed description, in which reference is made to the accompanying drawings, which illustrate one of the numerous forms which my improved apparatus

may assume, and in which—
Figure 1 is a perspective view of my recording and reproducing apparatus; Fig. 2, a like

view of the recording and reproducing diaphragm with its stylns; Fig. 3, a similar view of a portion of the support for the record-surface; Fig. 4, the same view with the recordsurface applied; Fig. 5, a plan view of a phonautographic record; Fig. 6, a perspective of a phonautographic record copied in solid resisting material; and Fig. 7, the copied record mounted, ready for application to the support.

The general arrangement of the parts is best illustrated in Fig. 1, in which a T-shaped baselate, A, is shown, upon which two standards, H I, serving as journal bearings for the shaft of drum G, are mounted. The drum G may 5 be constructed with flanges e d, which project beyond the cylinder surface f, and from the edges of a gap, B, left upon the cylinder surface extend the side walk of box K, as shown. A thin layer of felt or other yielding clastic substance is placed upon the cylinder surface and is bent over the edges of the gap and se-cured to the nide walls of the box K. This layer of classic material is designed to serve as the support for the record-surface both in

as the support for the record-surface both in recording and reproducing.

For recording I employ a thin strip of paper, parchment, metal, or any other suitable substance, which is secured at both ends to bare od, in the manner shown in Fig. 7, with reference to a copy of a record, and is then placed upon the clastic support f, with the bars od entering into but projecting at both ends beyond the box K, as illustrated in Figs. 1 and 4, with reference to an engraved copy of a record. Bolts q, passing through the projecting ends of bars od, are employed to draw the record strip tightly about the drum, and the length of the strip is such that the ends of the same meet as nearly as practicable upon a straight line, s. The record-sheet is then prepared to receive the record by covering its surfaces with a this layer of any substance which nor with a thin layer of any or coasily removed by the action is easily res I may use h duck, which is lame under the deposited by plasing a manky flame of record-strip and by dowly turning the until all parts of the strip are covered it. It is well known that a layer of lamp thus deposited, while it adheres well to arrive of a solid body, is severtheless removed from thesease. It requires only ok thus dep ce to draw a plainly anch surface, owing to the less of earther of which imp-s are only loosely superimor, and are exce has long alone been recognised the production of phonoute-and I take advantage of these proved method of recording and

The disphragm as is mounted in a frame, s, with its plane at right angles to the axis of drum G. A post, O, is fixed to the center of the disphragm, and a slot in said post receive one end of stylus 8, which is pivoted in the

post by a pin, t. The stylus extends over and beyond the frame, with its free end barely in contact with the record surface, and is also pivotally supported in a slot in a post, p, secured 70 to the frame by means of a pin, u, as shown in Figs. 1 and 2. It will new be seen that the stylus is in effect a lever having its fulcrum in the pin u, and that its free end can only move in lines practically parallel to the record-sur- 75 face. 'If it is now desired to produce a record of sounds the drum is slowly and uniformly rotated by means of crank I, or by any other suitable means, and sounds are uttered or directed against the disphragm. Under the impact of the sound-waves the disphragm is set Under the im- 80 into vibrations, whereby the free end of the stylus is also caused to vibrate to the right and left of its normal position, removing at the same time an undulating line, y, of lamp-black 85 from the record-surface, as indicated, greatly exaggerated, in Fig. 5. Since in this operation the stylus only penetrates a uniform layer of loosely-heaped carbon spicules and barely touches the record-surface, it is clear that the 90 slight friction at the free end of the stylus will be uniform, whatever be the amplitude of vibration. Consequently the vibrations of the disphragm will not be modified or changed by the reaction upon the same of a sensible and 95 varying resistance, as is the case in all other mechanical sound-recorders.

Having thus obtained an accurate phonautographic record, the same may be fixed by applying a thin solution of varnish of any 100 kind which dries very rapidly and which does not obliterate or change the record.

If in this process the deposit of lamp-black

be made thick enough, the line drawn by the stylus would represent a groove of even depth, 105 preserving all the characteristics of the sounds which produced it and which may be handled and touched with impunity. The latter is then removed from the drum and may be preserved any length of time without danger of 110 its being diafigured. This record I then copy in solid resisting material, preferably metal, either by the purely mechanical process of engraving, or by chemical deposition, or by photo-engraving. I prefer the last-named 115-process, which enables me to produce the most curate copy of the original record in copper, nickel, or any other metal without in any way or manner affecting the original record. The copy thus obtained, which may be multiplied 120 to any desired extent, in a grooved wave-line upon a strip or abest of copper or other metal, as shown in Figs. 1, 4, 6, and 7, and for the reproduction of the recorded sounds it has the dvantage over the ordinary records in tin- 125 foil, wax, do., that it is not sensibly attacked by the reproducing styles, and will stand an indeficite number of reproductions without the slightest variation in the accuracy and loudness of the reproduced sounds,

The copied record is fixed at both ends to the bars od, as shown in Fig. 7, and is placed

130

372,786

upon the clastic support f' upon the drum in | the same manner as has been described with | reference to the original record strip, and as is illustrated in Figs. 1 and 4. Care must be s taken that the two ends of the undulatory groove y meet exactly, as will be readily un-derstood. This condition of the apparatus is shown in Fig. 1 with the engraven record upon the dram and the free end of the stylus o entering the undulatory groove. If, now, the drum is rotated with uniform speed, the end of the stylus will be forced to follow the undulations of the groove y, and the diaphragm will be vibrated positively in both directions is in strict accordance therewith, and will therefore reproduce the exact sounds which originally produced the record. This peculiarity of positive vibratory movement in both directions of the diaphragm is a feature which also o distinguishes my method and my apparatus

In the phonograph and graphophene the end of the reproducing stylus which bears upon the indented or engraved record has a 15 vertical upward and downward movement. It is forced upwardly in a positive manner by riding over the elevated portion of the record, but its downward movement is effected solely by the elastic force of the diaphragm, which to latter is always under tension. In my improved apparatus the stylus travels in a groove of even depth and is moved positively in both directions. It does not depend from the elas-ticity of the diaphragm for its movement in one direction. This I consider to be an advantage, since by this method the whole movement of the diaphragm is positively controlled by the record, and is not affected or modified by the physical conditions of the diaphragm, which conditions necessarily vary from time to time and constitute some of the causes of imperfect reproduction of recorded sounds.

from others beretofore used.

In practicing my method of recording and producing sounds I sim not limited to the use of the identical apparatus herein shown and described. This apparatus may be varied indefinitely without seriously impairing its utility for the purposes in view. Thus it is not absolutely necessary that a diaphragm should be used for receiving the impact of soundwaves in recording and for remitting sounds in reproducing. Any sonorous body of whatever shape and material may be used in lieu of a diaphragm proper. The recording surface need not be mounted upon a drum, but may be apported in any suitable manner upon a support of any description which is adapted to move the same under the stylus evenly and with approximately uniform speed. Nor do producing sounds I am not limited to the use with approximately uniform speed. Nor do

I confine myself to the use of lamp-black as a 60 anbetratum for the phoneutograph is record, although I have found this substance to yield excellent results. Any other substance which adheres well to the support and may at the same time be removed from the same with a 65

While I have found the process of photo-engraving to yield admirable copies of the phonautographic record, I do not mean to confine myself to this process to the exclusion of 70 other processes for copying and multiplying the original record in solid resisting material; and it will be readily understood that the details of construction of my apparatus and the manipulations of the same may be greatly 75 changed without departing from the fundamental idea of my invention.

I do not herein claim the apparatus shown and described, either generically or specifically, as a whole or in part, since the same forms 80 the subject of another application for patent previously filed by me and of which this is a

What I do claim, and desire to secure by Letters Patent, is-

1. The method or process of recording and reproducing spoken words and other sounds, which consists in first drawing an undulatory line of even depth in a traveling layer of non-resisting material by and in accordance with 90 sound-vibrations, then producing the record thus obtained in solid resisting material, and finally imparting vibrations to a sonorous body by and in accordance with the resisting record, substantially as described.

2. The method or process of reproducing sounds recorded phonautographically, which consists in copying the phonautographic record in solid resisting material, and then imparting vibrations to a sonorous body by and 100 in accordance with the copy of the original rec-ord, substantially as described.

3. The method or process of reproducing sounds recorded phonautographically, which consicts in copying the phonautographic rec- 105 ord in solid resisting material by the process of photo engraving, and then imparting positive to and fro movements to a sonorous body by and in accordance with the copy of the original record, substantially as described.

In testimony whereof I have signed my name to this specification in the presence of two sub-

scribing witnesses.

EMILE BERLINER.

Witnesses:

JULIUS SOLGER, JACOB G. COHEN.

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PAGE

### UNITED STATES PATENT OFFICE.

EMILE BERLINER, OF WASHINGTON, DISTRICT OF COLUMBIA.

#### PROCESS OF PRODUCING RECORDS OF SOUND.

SPECIFICATION forming part of Letters Patent No. 382,790, dated May 15, 1888.

Application filed March 17, 1888. Serial No. 267,563. (No model.)

To all whom it may concern:

Be it known that I, EMILE BERLINER, a citizen of the United States, residing at Washington, in the District of Columbia, have invented certain new and useful Improvements in Producing Records of Sounds, of which the

following is a specification.

In a patent granted to me November 8, 1887, No. 372,786, I have described a method of recording and reproducing spoken words and other sounds; and in connection therewith and as a part thereof I have described a process of producing a record of sound-waves in solid resisting material by photo-engraving, the phonautographic record of such sound-waves having first been produced as an undulatory line of even depth in a traveling layer

of non-resisting material.

My present invention is an improvement upon that described in my aforesaid patent; and it has for its object the production of a record of sound waves in solid resisting material, principally metal, by the process of direct etching, whereby a solid unchangeable sound-record is obtained more cheaply and more readily, either upon a flat or upon a curved surface, without the delicate and intricate manipulations incidental to the process of photo-engraving. All this will more fully appear from the following detailed description, in which I shall freely refer to what is shown and described in my aforesaid patent as a part of the now sommon knowledge of mankind.

In accordance with the rules laid down in my
35 patent, I produced a phonautographic record
upon a traveling layer of lamp-black or other
non-resisting material. Then this phonautographic record was transferred by photo-engraving upon metal, and the metallic record
to thus obtained was used for reproducing the

recorded sounds.

In the course of my experiments I have found that in place of lamp black other substances may be used as the non resisting mediam for receiving the original phonautographic record, and I have also found that among these substances are such as will resist the chemical action of acids, but which offer no perceptible mechanical resistance to the movement of the recording stylus. Upon this discovery my present invention is based, and it

consists, broadly speaking, in producing a phonautographic record through a film of a suitable etching ground deposited upon a traveling surface of resisting material, such as 55 metal or glass, and then subjecting said surface to the action of a suitable etching agent, which attacks said surface at the glaces only where the etching ground has been removed

by the recording-stylus.

The etching-ground, which is to serve as the non-resisting medium for the phonautographic record, I prepare by dissolving beeswax, paraffine, or other like substance in a suitable solv-By preference I use beeswax, and dis- 65 solve the same in benzine, so as to obtain a saturated solution. This solution is filtered, and care is taken to exclude as much as possible all dust, which is always present in the ambient air. The surface which is intended 70 to receive this ground, which may be a flat disk or a cylinder of metal or glass, should be smoothly polished, and must be cleansed and dried. The wax solution is then poured over this surface, so as to cover the same at all 75 points, and the solvent is then allowed to evaporate, which it does in one or two minutes. An exceedingly-fine film of wax then remains adhering to the surface of the metal or glass, and the consistency of this wax is such that it So offers no perceptible mechanical resistance to the action of the recording stylus, while at the same time it resists the chemical action of ordinary etching agents. In this respect the film of wax deposited from the solution is 85 quite different from a layer of wax produced The latter has such consistency by melting. and adheres to the supporting-surface with such tenacity that considerable force must be used to penetrate the same and remove it from 90 its support, while the wax film deposited in the manner described is so delicate that a camel's-hair brush will disturb it perceptibly.

Partly on account of the too great sensitiveness of a single film, and also as an additional 95 protection against the action of the acids employed in the subsequent etching, I ordinarily, but not necessarily, apply a second coating of the solution, which, when dry, leaves a film of wax of such thickness as I have found to answer all requirements. A plate or cylinder thus prepared may be preserved in

definitely, and is at all times in good condition to receive the phonautographic record. Such record is produced by moving the prepared surface under astylus actuated by soundwaves to remove an undulatory line of the non-resisting film from its support, whereby the latter is laid bare along the mid line, as in fully described in my patent above referred to, and as is now well understood by those so skilled in the art. The plate or cylinder is then subjected to the action of a suitable etchthen subjected to the action of a suitable etching agent, the nature of which varies according to the material of the support. For metals—such as size, copper, or brass—diluted nitter, hydrochleric, or other acid is used, while for glass or other like materials fluoric acid, or the fumes of the same, must be used. In either case I obtain upon the support within a few minutes an undulatory groove of even depth representing the sound waves which acted upon the recording stylus, and this groove is of sufficient depth to guide and control a reproducing stylus in the manner set forth in my Patent No. 372,786.

I do not coafine myself to any particular mode of etching, the ordinary process being followed in this respect. The same is true of

mode of etching, the orunnery
followed in this respect. The same is true of
the practice of relating, if a single exposure
to the etching agent should prove to be insufficlent to produce a groove of sufficient depth.
From a record produced in the manner deto the etching and ally if the original record is 35 however, I ha the original recylinder is ph to ninhing-tool late or cylin rotated by th pishing -

effectually against the accession of fine filamentary particles of dust to and into the body of the tracing or etching ground. These dust particles are so fine that they cannot, as a rule, 70 e detected by the must searching inspection of the prepared plate; but they become very conspicuous and a very serious source of an-noyance when the record is made. As the recording stylus passes through the wax or other 75 ground, a fine undulatory line of the latter is removed, and the removed material drops away from the stylus as soon as removed, so that the oint of the stylusalways remains cleau. This, however, is only the case when the ground is 80 free of filamentary impurities; but if filaments of dust are embedded in the ground they adhere to the stylus, and, together with a coating of the ground, are dragged through newlyformed grooves, whereby the latter become 85 uneven and receive ragged edges, which seriously impair the accuracy of the record. have discovered an effective means for overcoming this difficulty, and it consists in simply moistening the record-surface with a fluid 90 that slightly adheres to the ground and keeping it moist while the record is being made. I have found strong alcohol to be very effective for this purpose when wax is used as a tracing-ground, and it is used by pouring it 95 over the ground just before the plate or cylin-der is started to move under the recordingder is started to move under the recording-stylus. The alcohol evaporates rapidly, but not so rapidly as to disappear entirely before the record is finished, and this record now 100 shows no trace of inequality, the lines being a harp and well defined as if cut by a graver. he point of the stylus remains quite clean, and it seems as if the filamentary particles had isappeared. I have no definite theory by 105 disappeared. I have no definite theory by which to explain this surprising result. It is which to explain this surprising result. It is possible that the exceedingly-fine dust particles are forced against the walls of the grooves and are there held when the ground is in the peculiar state of dampness which it receives when alcohol is poured over the same. It is also possible that these particles of dust, being probably of organic matter, are dissolved by the alcohol, and it is also receible that ol, and it is also possible that hoti s operate to keep the point of the stylus 115, so as to make a sharp and well-defined d; but whatever be the mode of action of leobel poured over the ground its effect hly beneficial and its use constitutes over a of ground which I employ is so

y thin that it is practically color-The record is for this invisible to the naked eye. respect it is destrable to be secultains the record before of the re able to alightly color the re the record is made. I accom-seding a small quantity of ani-ther coloring-matter to the solu-I accom- 130 by a

tion of wax or other ground. The record is then plainly visible as a pale line upon a dark ground.

Having now fully described my invention, I claim and desire to secure by Letters Patent—

1. The method or process of producing a record of sound-waves in solid resisting material for reproduction of the recorded sounds, which consists in covering the surface of such material with a film of etching-ground that offers no perceptible mechanical resistance, then making a phonautographic record upon and through the etching-ground, and then exposing the record to the action of a suitable etching agent, substantially as described.

2. The method or process of producing a record of sound-waves in solid resisting material for reproduction of the recorded sounds, which consists in depositing upon the surface of such material a film of wax from a solution of the same in a suitable menstruum, then making a phonautographic record upon and through the wax film, and then exposing the record to the action of a suitable etching agent, substantially as described.

3. The method or process of producing a record of sound waves in solid resisting ma-

terial for reproduction of the recorded sounds, which consists in depositing upon the surface of such material a film of wax from a solution 30 of the same in benzine, then making a phonautographic record upon and through the wax film, and then exposing the record to the action of a suitable etching agent, substantially as described.

4. The method or process of preparing solid surfaces for the reception of a phonautographic record, which consists in depositing upon said surfaces a film of tracing or etching ground and then moistening such film with an adhering fluid, substantially as described.

5. The method or process of preparing solid surfaces for the reception of a phonantographic record, which consists in depositing upon said surfaces a film of wax and then moistening 45 the wax film with alcohol, substantially as described.

In testimony whereof I have signed my name to this specification in the presence of two subscribing witnesses.

EMILE BERLINER.

Witnesses:

JOSEPH LYONS, S. WOLF.